134-381

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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1889.

No. 1269.

CARL POHL AND CHARLES ZOLLER, APPELLANTS,

vs.

THE ANCHOR BREWING COMPANY.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE SOUTHERN DISTRICT OF NEW YORK.

FILED OCTOBER 1, 1889.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, OCTOBER 16, 1889.

1 Circuit Court of the United States, Southern District of New York.

CARL POHL and CHARLES ZOLLER
against
THE ANCHOR BREWING COMPANY.
} In Equity.

To the honorable the judges of the circuit court of the United States in and for the southern district of New York:

Carl Pohl, a citizen of Dresden, in the Empire of Germany, and Charles Zoller, a citizen of the State of New York, residing within the southern district of New York, bring this bill against the Anchor Brewing Company, a corporation organized under and pursuant to the laws of the State of New York and doing business within the jurisdiction of this court; and thereupon your orators complain and say:

I. That on and before the eighteenth day of March, 1879, your orator, Carl Pohl, was the true, original, and first inventor or discoverer of a certain new and useful improvement in barrel and cask scrubbing machines, not known or used by others before his invention or discovery thereof and not at the time of his application for letters patent of the United States therefor in public use or on sale with his consent or allowance, and said Carl Pohl, so being the inventor of said improvement, made application to the proper Department of the Government of the United States for letters

2 patent therefor, in accordance with the then existing laws of Congress, and, having duly complied in all respects with the conditions and requirements of said laws, on the eighteenth day of March, 1879, letters patent of the United States numbered 213,447, signed, sealed, and executed in due form of law, for his invention or discovery were issued to him, whereby there was secured to him, his heirs, executors, and assigns, the full and exclusive right of making, using, and vending to others to be used the said improvement, a copy of said letters patent being hereto annexed and marked Exhibit A and is made a part of this bill of complaint.

II. That it appears that the said letters patent of the United States was "subject to the limitation prescribed by section 4887 of the Revised Statutes by reason of German patent dated September 6th, 1877, and French patent dated September 3d, 1877," copies of which said patents translated into English are hereto annexed and marked Exhibits B and C, each of which is limited on its face to a term of fifteen years.

III. That on or about the seventh day of July, 1887, your orator, Carl Pohl, by an instrument in writing of that date, granted unto your orator, Charles Zoller, of the city of New York, the exclusive right to manufacture, make, sell, use, and vend barrel and cask scrubbing machines containing the invention described in said letters patent within the territory of the United States in consideration of the payment of certain royalties therein expressed, which said instrument was duly recorded in the Patent Office of the United

States in Liber Z 36, page 486, of Transfers of Patents, as by said instrument or a duly authenticated copy thereof will fully and at large appear.

IV. That said invention has been and is of great practical use and benefit to your orators, and that they have applied the said improvements to large and extensive use, and that the public and the users of said improvements have acknowledged and
3 acquiesced in the value of said invention and the aforesaid rights of your orators under said letters patent, and that your orators have been and, but for the infringement hereinafter complained of, would still be in the undisturbed possession, use, and enjoyment of the exclusive privileges secured by said letters patent and in the receipt of the profits of the same.

V. That your orators are informed and believe that the defendant, well knowing all the facts hereinbefore set forth, but contriving to injure your orators and to deprive them of the benefits and advantages which might and otherwise would accrue to them from the said invention and letters prtent, has been and now is wrongfully and unlawfully using in their business of brewers barrel and cask scrubbing machines containing substantially the improvements shown, described, and claimed in said letters patent.

And your orators charge that the said defendant, without any license or authority from either of your orators, against their will, in violation of their rights, and without any lawful authority whatever, has been and now is using and intend to continue to use barrel and cask scrubbing machines containing substantially the improvements shown, described, and claimed in said letters patent granted March 18th, 1879, No. 213,447.

VI. And your orators further show that, notwithstanding the said defendant has frequently been requested to desist from trespassing upon the exclusive rights granted by said letters patent, it has wholly refused so to do, and threatens to continue its unlawful and inequitable acts, all of which are contrary to equity and good conscience, and have been and are a manifest damage, wrong, and injury to your orators.

In consideration of the premises and forasmuch as your orators can have adequate relief only in this court, and to the end that the defendant may, if it can, show reason why your orators should not have the relief hereby prayed, and that it may make a full
4 disclosure and discovery of all the matters aforesaid, and, upon oath and according to the best and utmost of its knowledge, remembrance, information, and belief, full, true, direct, and perfect answer make to such of the several interrogatories hereinafter numbered and set forth as by the note hereunder written it is required to answer—that is to say:

(1.) Whether the said original letters patent No. 213,447 were granted and issued to Carl Pohl as hereinabove mentioned.

(2.) Whether the assignment or license thereunder, as hereinabove set forth, was granted to Charles Zoller and was recorded in the United States Patent Office, as alleged.

(3.) Whether the defendant, since the seventh day of July, 1887,

has made, sold, or used any barrel or keg scrubbing machines, and, if so, how many, like or substantially like the scrubbing machines described in the letters patent above mentioned.

(4.) Whether the defendants did not, since July 7th, 1887, purchase one or more barrel or keg scrubbing machines which have since been used in their business for the purpose of scrubbing the outside of kegs, and, if so, how many and when and from whom purchased.

(5.) Whether the keg-scrubbing machines so purchased and used by the defendants differ in construction or otherwise in any, and, if so, in what substantial and material, respect from the keg-scrubbing machines described in said letters patent No. 213,447, and describe minutely and in detail all such differences.

(6.) Whether the defendants have not purchased keg-scrubbing machines of one Nathan N. Heyman for use, and which have been and are now being used to scrub the outside of barrels or kegs, and, if so, how many were so purchased and used.

And now, to the end that the defendant may be compelled to account for and pay over the income thus unlawfully derived from the violation of the right of your orators above, together with the damages the said complainants have sustained thereby, and be restrained from any further violation of said rights, your orators pray that your honors may grant a writ of injunction during the pendency of this bill and perpetually thereafter restraining the defendant, its officers, agents, servants, and workmen, from directly or indirectly making, constructing, using, or vending or causing to be constructed, used, or vended barrel and cask scrubbing machines or other machines containing the improvements, or any of them, patented by said letters patent, and from in any way infringing said letters patent or any part thereof.

And your orators pray for such other relief as the equity of the case may require and to your honors may seem meet.

May it please your honors to grant unto your orators not only a writ of injunction conformable to the prayer of this bill, but also a writ of subpœna of the United States of America directed to said The Anchor Brewing Company, and commanding it to appear and answer unto this bill of complaint and to abide by and perform such order and decree in the premises as to the court shall seem meet and be required by the principles of equity and good conscience.

And your orators will ever pray, &c.

(NOTE.)—The defendant is required to answer each of the foregoing interrogatories numbered one to five each, inclusive.

CARL POHL.
CHARLES ZOLLER.

JOSEPH M. DEUEL,
Solicitor and of Counsel for Complainants,
11 *Pine St., New York City.*

6 EXHIBIT A.

The United States of America to all whom these presents shall come:

Whereas Carl Pohl, of Dresden, Saxony, Germany, has presented to the Commissioner of Patents a petition praying for the grant of letters patent for an alleged new and useful improvement in barrel and cask scrubbing machines, a description of which invention is contained in the specification of which a copy is hereunto annexed and made a part hereof, and has complied with the various requirements of law in such case made and provided; and

Whereas, upon due examination made, the said claimant is adjudged to be justly entitled to a patent under the law:

Now, therefore, these letters patent are to grant unto the said Carl Pohl, his heirs or assigns, for the term of seventeen years from the eighteenth day of March, one thousand eight hundred and seventy-nine, the exclusive right to make, use, and vend the said invention throughout the United States and the Territories thereof, subject to the limitation prescribed by sec. 4887, Rev. Stats., by reason of German patent dated September 6, 1877, and French patent dated September 3, 1877.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this eighteenth day of March, in the year of our Lord one thousand eight hundred and seventy-nine, and of the Independence of the United States of America the one hundred and third.

[L. S.] (S'd) A. BELL,
Acting Secretary of the Interior.

Countersigned:
H. E. PAINE,
Commissioner of Patents.

9 UNITED STATES PATENT OFFICE.

CARL POHL, of Dresden, Saxony, Germany.

Improvement in Barrel and Cask Scrubbing Machines.

Specification forming part of Letters Patent No. 213,447, dated March 18, 1879; application filed January 3, 1879; patented in Germany, September 6, 1877, and in France, September 3, 1877.

To all whom it may concern:

Be it known that I, Carl Pohl, of Dresden, in the Kingdom of Saxony and Empire of Germany, have invented a new and useful improvement in machines for scrubbing barrels and casks, which improvement is fully set forth in the following specification, reference being had to the accompanying drawings, in which—

(Here follow diagrams marked pp. 7 & 8.)

7

2 Sheets—Sheet 1.

C. POHL.

Barrel and Cask Scrubbing Machine.

No. 213,447. Patented Mar. 18, 1879.

No. 1269.
Pohl et al.
v.
Anchor Brewing Company
Ex. 4

Fig. 1.

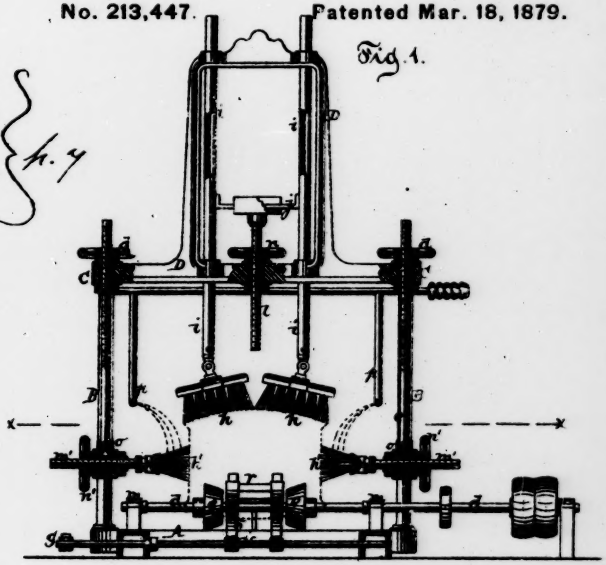
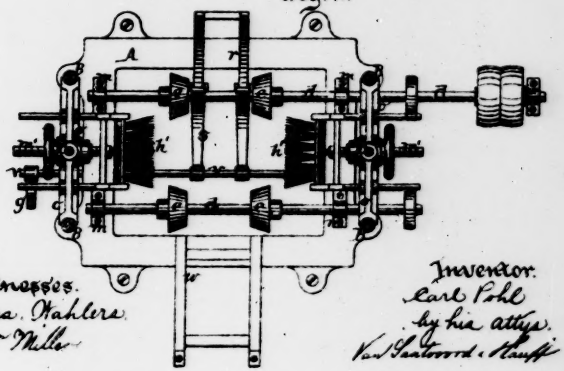


Fig. 2.



Witnesses.
Chas. Wahlers
Wm. Miller

Inventor.
Carl Pohl
by his attys.
Van Santvoord & Hauff

2 Sheets—Sheet 2.

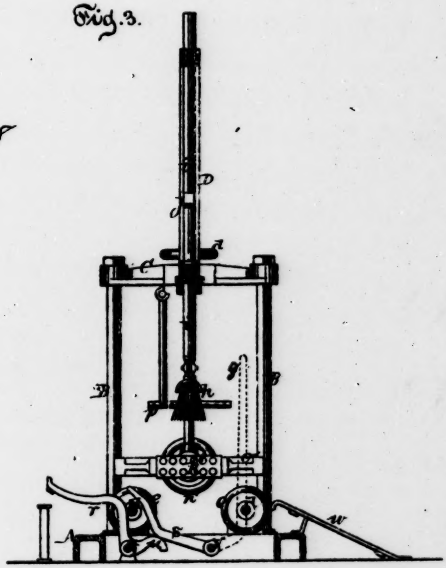
C. POHL

Barrel and Cask Scrubbing Machine.

No. 213,447. Patented Mar. 18, 1879.

No. 1269.
Pohl et al.
v.
Anchor Brewing Company
M. S

Fig. 3.



Witnesses.
Chas. Wahlers.
Wm Miller

Inventor.
Carl Pohl
by his attys.
Van Santvoord & Reiff

Figure 1 represents a longitudinal vertical section of a machine containing my invention. Fig. 2 is a horizontal section in the plane of the line *x x*, Fig. 1. Fig. 3 is a vertical cross-section thereof.

Similar letters indicate corresponding parts.

My invention relates to machines for scrubbing the outside of barrels and other cylindrical vessels; and it consists in certain combinations of the following instrumentalities, namely: a series of rollers adapted to support and impart a revolving motion to the barrel to be scrubbed; brushes for cleaning the side of the barrel; brushes to clean the ends of the same, and means for supplying the brushes with water; a pivoted frame located adjacent to the rollers, for receiving the barrel and depositing the same on the rollers, and a pivoted frame located between the rollers to remove the barrel therefrom, this last-named frame being arranged to actuate the receiving-frame, whereby one is enabled to thoroughly scrub or clean a barrel on its outer surface with little labor and in a short space of time.

In the drawings, the letter A designates the base part of the machine-frame, from which rise two pairs of standards, B B, which are each joined at the top by a cross-head, C, supporting a top frame, D. The base-frame A carries pillow-blocks *m*, forming the bearings for two parallel shafts, *d d*, on which are secured rollers *e e*. These rollers serve to support the barrel to be scrubbed, and their shafts *d d* are arranged to receive a revolving motion, so that a like motion can be imparted to the barrel.

Motion may be given to the roller-shafts *d d* either by hand or power, as may be found most expedient.

The letters *h h* designate two brushes, whose function is to clean the side of the barrel, and *h' h'* are brushes to clean the opposite ends thereof. The brushes *h h* are attached to the lower ends of rods *i i*, a swivel-joint being, preferably, used for this purpose, so that the brushes may accommodate themselves to the shape of the barrel to be washed, and said rods slide in the top frame, D, the same being connected together by a cross-piece, *j*, so that they move in unison. The cross-piece *j* rests on the head of a screw, *l*, which passes through a nut, *n*, confined in the top frame, D, and cross-head C, so that by turning this nut the rods *i i* can be raised or lowered, to adjust the brushes *h h* in the required position relatively to the diameter of the barrel. I arrange the cross-piece *j* to rest loosely on the screw *l*, so that the rods *i i* and the brushes are susceptible of being raised independently of the screw.

The rods *i i* are hollow, and constitute the means whereby the brushes *h h* are supplied with water; but this can obviously be accomplished in other ways.

The end brushes, *h' h'*, are each secured to a screw, *m'*, passing through a nut, *n'*, which is confined in a bridge or cross-head, *o*, so that by turning this nut at either or both ends of the machine either or both brushes can be moved horizontally and adjusted in the required position relatively to the length of the barrel.

In order to steady the end brushes, *h' h'*, I secure the same to rods sliding in the bridge *o*, as shown in Fig. 2.

The bridge *o* moves up and down between the standards B, and it is supported by a vertical screw-rod, *c*, engaging with a nut, *d*, so that the end brushes, *h' h'*, are rendered adjustable also in a vertical direction.

The means for supplying the end brushes, *h' h'*, with water consist in the example shown of perforated sprinkling-tubes *p*, which are connected to a suitable feed-pipe.

The letter *r* designates a frame serving to receive the barrel to be scrubbed and deposit the same on the rollers *e*, and *s* is a frame for removing the barrel from the rollers. The receiving frame *r* is situated adjacent to or in front of the rollers *e*, and is supported by pivots *t*, on which it is pivoted, while it is provided with inwardly-projecting toes *u*. (See Fig. 3.) The barrel-removing frame *s* is located between the rollers *e*, and is secured to a rock-shaft, *v*, to which is also secured a handle, *g*. When the barrel-removing frame *s* is in its normal position it is beneath the barrel resting on the rollers *e*, and rests on the toes *u* of the receiving-frame, as shown in Fig. 3.

In the operation of my machine the barrel to be scrubbed is placed on the receiving-frame *r*, and the barrel-removing frame *s* is brought to its normal position, or, in other words, it is brought in contact with the toes *u* of the receiving-frame with sufficient force to tilt the receiving-frame, whereupon the barrel rolls down on the rollers *e*. A revolving motion is then imparted to the rollers *e*, and the water is turned on, the brushes having first been properly adjusted, so that the barrel is rotated in contact with the brushes, and when the barrel reaches the proper state of cleanliness the frame *s* is tilted, whereby the barrel is removed from the rollers and ejected from the machine, rolling down an inclined plane, *w*, to the ground.

When the receiving-frame *r* is tilted by the action of the barrel-removing frame it is brought to the position shown in Fig. 3. When in this position a barrel is placed thereon, the outer end thereof sinks down, thereby causing an elevation of the inner end or toes *u*.

I am aware that machines have heretofore been constructed for keeping various kinds of vessels in rotation under the action of brushes and jets of water, and that the vessels in some of these machines have been caused to rotate by the rotation of shafts upon and partially between which they have been placed, and I do not claim, broadly, the invention of such a machine or devices.

What I claim as new, and desire to secure by letters patent, is—

1. The combination, with the supports for holding the barrel, of a frame pivoted on a rock-shaft beneath said supports, and adapted to swing up between the supports for removing the barrel from the same, substantially as and for the purpose described.

2. The combination, with the supports for holding the barrel, of a rocking frame pivoted beneath the supports and projecting in front thereof, for receiving the barrel and delivering it on the supports, and pivoted frame beneath and between the supports, adapted to swing vertically for removing the barrel from the supports after being cleaned, substantially as and for the purpose described.

3. A machine for scrubbing barrels in which are combined the

following instrumentalities, to wit: two horizontal side shafts having suitable rollers for supporting and rotating the barrel, a vertically-adjustable rod provided at its lower end with a swiveled or jointed brush, whereby it can adjust itself to the curvilinear form of the barrel, vertically and laterally adjustable end brushes, and means for supplying said brushes with the washing-fluid, the whole constructed and arranged to operate substantially as and for the purpose described.

4. The combination of swiveled and vertically-adjustable brushes *h*, for scrubbing the sides of a barrel, laterally and vertically adjustable brushes *h'*, arranged opposite each other, for scrubbing the ends of said barrel, and rotating wheels or rollers for supporting and revolving the barrel while being scrubbed, substantially as described.

In testimony whereof I have signed my name to this specification in the presence of two subscribing witnesses.

CARL POHL.

Witnesses:
LÉON KLEMPERER.
ALBERT ZOLLER.

11 EXHIBIT B.

Translation from the French.

Ministry of agriculture and commerce.

Duration, 15 years.

No. 120,164.

Law of July 5th, 1844.

Abstract.

Art. 32.

Have forfeited their right—

1st. The patentee who has not paid his annuity before the beginning of each of the years of the duration of his patent. (1.)

2nd. The patentee who has not put his discovery or invention in working order in France within a delay of two years from the signature of the patent, or who had ceased during two years consecutive such working, unless in either case he duly accounts for the causes of his inaction.

3rd. The patentee who shall have introduced in France articles manufactured in a foreign country similar to those guaranteed by his patent.

Art. 33.

Whoever, in signs, advertisements, prospectuses, posting bills, marks, or stamps, takes the qualification as patentee without being the owner of a patent delivered according to law or after the expiration of a previous patent, or whoever, being

Patent of invention without guaranty from the Government.

The minister of agriculture and of commerce,

In view of the law of July 5th, 1844,

In view of the statement made upon September 3rd, 1877, at 3.30 p. m., in the general secretary's office of the prefecture of the Department of Seine, stating the filing made by

POHL

of an application for a patent of invention for fifteen years for a machine to wash casks, decides as follows:

Article first.

A patent of invention for fifteen years, which began to run from September 3rd, 1877, for a machine to wash casks, is delivered to Mr. Pohl (Carl), represented by Mr. Brandon, at Paris, rue Lafitte No. 1, without any previous examination, at his own risks and perils, and without guaranty for the reality, the novelty, or the merits of the invention, neither for the faithfulness or the exactitude of the description.

Article second.

The present decision, which constitutes

patented, mentions his qualifications as patentee or his patent without adding these words:

"Without guarantee from the Government" shall be fined 50 to 1,000 francs. In case of a new offense the fine may be doubled.

12 (1.) The duration of the patent runs from the day when the application was filed at the prefecture in conformity with art. 8 of the law of July 5th, 1844.

The law has given to the Government no right to bestow delays for the payment of annuities, nor for the working of the discoveries or inventions, nor to lift up an incurred forfeit of right.

the patent of invention, is delivered to Mr. Pohl to serve him as a title.

To this decision there shall remain annexed one of the duplicates of the description and one of the duplicates of the drawing filed with the application.

Paris, first of December, one thousand eight hundred and seventy-seven.

For the minister and by his authority,
The director of interior or domestic commerce.

(Signed) M. A. DUMUOSTIER DE FREDILLY.

A true certified copy.
The authorized head clerk, signature illegible.
[L. S.]

Translation from the French.

Duplicate.

Descriptive memorandum in support of an application for a patent, in the name of CARL POHL, of Dresden, for a machine for washing casks.

The machine shown by the hereto-annexed drawing is for the purpose of washing and cleansing casks.

It is entirely built in iron, except the four rollers, which are in wood, in order to prevent the wear of the casks.

The machine is working in the following manner:

The cask that is to be washed is first put upon a deck disposed at the cask of the machine. Then it is placed upon the four rollers *e* by means of the lever *g*, and also simultaneously between the four brushes *h h* and *h' h'*. The lever *g* is pushed forward by hand.

In order that the two vertical brushes *h h* fit exactly to the form of the cask they are fastened by hinges to the pipes *i i*. These pipes are of iron.

On the other hand, the two brushes *h' h'* push horizontally towards the ends of the cask. The position of the brushes is

13 regulated by means of screws and of small wheels *n* in a very simple and tolerably quick way, and must be changed every time when casks of a different dimension are to be washed.

In causing the rollers to turn, by which they do about 80 rotations in a minute, the cask placed thereupon is put into rotation and at the same time sprinkled with lukewarm water through a pipe.

By the continuous rotation of the cask, combined with the sprinkling of lukewarm water, a complete cleansing of the cask is obtained in a very short time.

After the cask has been washed it is pushed out of the machine by the lever *g* and rolls down in front of the machine, while another cask already upon the deck is placed into the machine in pressing the lever backward. The work of the machine is therefore continuous and its effect quite extraordinary.

As casks of very different dimensions are to be washed by this

machine, it is necessary that the rollers each time be displaced, which is operated by the adjustable bed *m* and the small wheel *p*.

A single workingman is sufficient for the service of the machine, and can wash by himself as many casks as five men could do with their hands.

The machine for washing casks may be manufactured in sizes corresponding with the manifold purposes to which it is to be applied, to wash either depository or transportation casks.

I claim as being of my invention:

A machine to wash casks, into which the latter are put in rotation by means of turning rollers, while they are crushed continuous by brushes specially disposed for such purpose and sprinkled with lukewarm water in the manner above described.

Paris, September 3d, 1877.

For CARL POHL, by authority:

(Signed) D. H. BRANDON.

14 Seen to be annexed to the fifteen-year patent taken on September 3d, 1877, by Mr. Pohl:

Paris, December 1st, 1877.

For the minister and by authority.

The director of domestic commerce.

Signed, M. A. Dumourier De Fredilly.

A true copy certified.

The authorized head clerk, signature illegible.

[L. S.]

EXHIBIT C.

Translation from the German.

Patent record No. 975.

On the basis of the hereto annexed description and drawing—

A patent was delivered by decision of the Imperial Patent Office to

CARL POHL, Architect, at Dresden.

Law of May 25th, 1877.

Object of the patent:

Machine for Washing Casks.

Beginning of the patent, 6 September, 1877.

Longest duration of the patent, 12 December, 1891.

The rights and obligations of the patentee are determined by the law of patents of May 25th, 1877 (official journal of the empire, Reichsgesetzblatt, for 1877.)

This certificate is delivered for record of the patent.

BERLIN, *May 1st*, 1878.

IMPERIAL PATENT OFFICE.

Certified by—
[L. S.]

SCHOTT,
Secretary of the Imperial Patent Office.

15 The duration of the patent is fifteen years. It is shorter for patents of an invention which was already protected by a national patent, as upon the duration of fifteen years the time is deducted during which the oldest of the national patents has already protected the invention.

The patent is already previously forfeited when the patentee has renounced it or when the annuities were not paid at the utmost within three months of their falling due.

Moreover, the patent may be declared null and void or revoked in conformity with the sections 10 and 11 of the law of patents.

IMPERIAL PATENT OFFICE.

Certificate of Patent No. 975.

CARL POHL, of Dresden.

Machine for Washing Casks.

Class 64.

Implements for Liquids.

Berlin.

Printed at the Royal Prussian Printing of State.

Patent Certificate

1877. No. 975. Class 64.

KARL POHL, of Dresden.

Machine for Washing Casks.

Patented in the German Empire Sept. 6th, 1877.

Longest duration, December 12th, 1891.

The washing of the casks was done till now with the hand, the workingman first cleansing the inside and then brushing the outside.

16 But this manipulation is sometimes taking much time for the larger casks, and is a straining task, whereby the cost of the washing runs tolerably high. The foregoing machine works continuously, and replaces, according to the size of the casks, from

6 to 8 laborers. Besides, its construction is very simple, so that it can be worked without effort by one man.

Upon the foundation plate *a* to the uprights *m* m^1 are attached the axletrees *c* c^1.

They are provided with the conical wooden rollers *e* e^1, upon which the cask to be washed rolls, as hereinafter described.

The axletree *c* bears a tightening and loosening plate while c^1 is shifted by the uprights m^1.

The said uprights m^1 are below provided with an indented pole in which an indented wheel adapts to the axletree *z*.

The latter is turned by means of the hand wheel *p* and by the conical wheel spokes *y*, according to the needs, so that the two uprights shift simultaneously in the same direction.

The foundation plate *a* bears on four columns the frame *b*, in which are disposed two brooms, *h h*.

The latter are fastened in hinges to the iron pipes *i i*, so that they fit closely to the form of the casks.

The said pipes *i i* are conducted through corresponding holes disposed therefor in the frame *b* and are bound together by the framework *l*, which is provided with a spindle *g*. By turning the hand wheel *n*, provided with a box for the spindle, the brooms *h h* may be otherwise disposed at will, according to the dimensions of the casks.

Between the front and back rows of two columns two gliding pieces, *r r*, are moving, which are provided with brooms or brushes h^1 h^1 for the cleansing of the ends of the casks.

These brushes h^1 h^1 are fastened to the spindles *u u* in the hinges *t* t^1, and besides are also kept in the hinge by the sliding poles *v v*. By turning the hand wheels *n*, provided with latches, the brooms may be placed in front or back, by which the stopping wheel, consisting of a one-piece spindle, prevents turning back.

17 In order that, by the rolling of the casks into the machine, the brooms h^1 h^1 be in good flapping motion and the said hinges *t* t^1 be regulated, the brooms, by the turning of the handles *k k* outside, produce a motion upward and place themselves right angular at the stand shown in the drawing.

The motion up and down of the sliding pieces *r r* is operated by turning the hand wheels *a a*, by which the corresponding spindles *d d* are moved up and down. To avoid an unintentional displacement of the latter, stopping wheels *w w*, with their corresponding stopping latches, are employed.

The casks to be washed lie on a surface composed of a sloping beam. They are one after another filled up to about one-third with water and brought under the machine by the following contrivance:

The double levers J J, provided with a fore-block, move in the hinges D and bear on one side a long slit in which a peg of the levers G G is sliding.

When the lever *g* is moving to the left the levers G G, sitting on the same axletree, are lifted up, and so also the *the* inner arms of the double levers F F^1. By the same motion the outside arms of the latter and the fore-block are pushed down. Thereby the casks lying

on the sloping surface become free, and the first one rolls under the brushes. The cleansed cask is brought upon the sloping surface J by the motion to the right of the lever *g*, while the levers G G move the latter over the rollers e^1 e^1 away and upon J.

The handling of this machine is now operated as follows:

When the cask under process of operation, through pressure from the left of the lever G, is rolled between the described brushes it begins its rotation as the rollers *e e* of the axletree *c* are turned by the transmission.

Now lukewarm water is sprinkled upon the cask by means of leather pipes (which are not shown in the drawing). The cask is in a few seconds perfectly clean.

18 By a motion to the right of the lever *g* the cleansed cask is pushed on the level surface J, while by a motion of the same to the left a new cask is rolling under the brushes.

By the described rotation of the casks they are at the same time thoroughly cleansed inside by the above-mentioned partial filling with water.

Claim to patent.—The foregoing machine for washing casks is authenticated in its construction by a description and drawing.

Hereto annexed a drawing.

(Endorsed:) U. S. circuit court, so. dist. of N. Y. Carl Pohl and Charles Zoller *vs.* The Anchor Brewing Company. Bill of complaint. J. M. Deuel, sol'r for compl'ts, 11 Pine St., N. Y. city. U. S. circuit court. Filed Ap'l 16th, 1889. John A. Shields, clerk.

19 Circuit Court of the United States, Southern District of New York.

CARL POHL & CHARLES ZOLLER, Complainants,
v.
THE ANCHOR BREWING COMPANY, Defendant. } Notice of Appearance.

SIR: Please to take notice that the defendant appears in this action, and that we are retained as solicitors for it therein and demand that a copy of the complaint and all papers in this action be served on us at our office, number 206 Broadway, N. Y.

April 19th, 1889.

Yours, &c.,
HESS & TOWNSEND,
Solicitors for Defendant, 206 Broadway, N. Y.

To Jos. M. Deuel, Esq., plaintiffs' solicitor; John A. Shields, Esq., clerk.

20 (Endorsed:) U. S. circuit court. Carl Pohl *et al. vs.* The Anchor Brewing Company. Notice of appearance. Hess & Townsend, 206 Broadway, N. Y., solicitors for defendant. U. S. circuit court. Filed Ap'l 27, 1889. John A. Shields, clerk.

21 Circuit Court of the United States for the Southern District of New York.

CARL POHL and CHARLES ZOLLER
ag'st
THE ANCHOR BREWING COMPANY. } In Equity.

The Plea of The Anchor Brewing Company, the Defendant, to the Bill of Complaint of Carl Pohl and Charles Zoller, Complainants.

This defendant, by protestation, not confessing or acknowledging all or any of the matters and things in the complainants' bill mentioned to be true in such manner and form as the same are therein and thereby set forth and alleged, doth plead thereto, and for plea says that this defendant is informed and verily believes the same and charges the facts to be that the said letters patent No. 213,447 in said bill of complaint set forth were issued to the said complainant, Carl Pohl, on the 18th day of March, 1879; that the application therefor was filed January 3d, 1879; that at the time of the issuing of said letters patent and at the time of his application therefor the said complainant, Carl Pohl, was and thence hither has been and now is a citizen of the Empire of Germany; that prior to the issuing of said U. S. letters patent No. 213,447 and prior to his said application therefor the said complainant, Carl Pohl, had made application for the issue to him of letters patent of the Empire of Germany for the same alleged invention shown, described, and claimed in said U. S. letters patent No. 213,447, and thereafter and prior to his said application for said U. S. letters patent and on the 6th day of September, 1877, by a decision of the imperial patent office of the Empire of Germany, letters patent No. 975
22 were issued to the said complainant, Carl Pohl, for said alleged invention; that said German letters patent were public patents and were for the term of fifteen years, and by the terms and provisions thereof the rights and obligations of the said patentee, the said complainant, Carl Pohl, were determined by the law of patents of May 25th, 1877; that under and by the provisions of the said law of May 25th, 1877, the said patentee was required to pay certain annuities on said letters patent and to work the said invention in the Empire of Germany in the manner and for the term specified in and by said law, and in default thereof the term of the said German letters patent would expire and the rights and privileges of the patentee thereunder would become forfeited and cease, as by said laws or a duly authenticated copy thereof will more fully appear; that the said patentee, the said complainant, Carl Pohl, neglected and failed to pay the annuities and neglected and failed to work the said invention in the Empire of Germany in the manner and time required by said law, whereby and by reason whereof and under and in pursuance of the provisions of the said law of May 25th, 1877, the said German letters patent No. 975, in the year 1880, came and were forfeited and the term and time

thereof expired and the rights and privileges of the complainant, Carl Pohl, thereunder then ceased and determined.

That by reason of the premises and under and in pursuance of the provisions of section 4887 of the Revised Statutes of the United States the said U. S. letters patent No. 213,447, in the said year 1880 and prior to the time of the commencement of this suit, expired and the term thereof ended; and at the time of the commencement of this suit the said complainants, Carl Pohl and Charles Zoller, had no interest in or title to said letters patent and no exclusive or other rights or privileges thereunder and were not and are not entitled to the equitable cognizance of this court.

This defendant, The Anchor Brewing Company, doth further plead to the bill of complaint of the complainants, and for further plea says—

23 That prior to the issue of U. S. letters patent No. 213,447 and prior to his said application therefor the said complainant, Carl Pohl, had made application for the issue to him of letters patent of France for the same alleged invention shown, described, and claimed in said U. S. letters patent No. 213,447, and thereafter and still prior to his said application for said U. S. letters patent, and on the 3d day of September, 1877, letters patent No. 120,164 were by the proper authorities of the Government of France issued to the said Carl Pohl for said alleged invention; that said letters patent of France were public patents and were for the term of fifteen years, and by the terms and provisions thereof the same were issued in view of and subject to the provisions of the law of July 5th, 1844, and the rights and privileges of the patentee, the said complainant, Carl Pohl, were limited by and subject to the provisions of said law.

That under and by the provisions of said law of July 5th, 1844, the patentee who failed to pay his annuity, as required by law, before the beginning of each of the years of the duration of his patent, or who failed to put his invention in working order in France within two years from the signature of the patent, or who ceased during two years consecutive such working, would forfeit all right under such letters patent, as by said law or a duly authenticated copy thereof will more fully appear.

That the said patentee, the said complainant, Carl Pohl, neglected and failed to pay his annuities as require by said law of July 5th, 1844, and neglected and failed to put his said alleged invention in working order in France within two years from the signature of said patent, and the said patentee, the said complainant, Carl Pohl, ceased during two years consecutive such working, whereby and by reason whereof and under and in pursuance of the provisions of said law of July 5th, 1844, the said letters patent of France, No. 120,164, became and were forfeited, and the time and term thereof expired, and the rights and privileges of the complainant, Carl Pohl, thereunder ceased and determined.

24 That by reason of the premises and under and in pursuance of the provisions of section 4887 of the Revised Statutes of the United States the said letters patent No. 213,447, prior to the

time of the commencement of this suit, expired and the term thereof ended, and at the time of the commencement of this suit the said complainants, Carl Pohl and Charles Zoller, had no interest in or title to said letters patent and no exclusive or other rights or privileges thereunder.

Wherefore and by reason of the premises the said complainants have no equitable claim against this defendant, and this court of equity has no jurisdiction and ought not to take cognizance of or entertain this suit; and this defendant, The Anchor Brewing Company, pleads these facts to the whole of said bill, and demands judgment of this honorable court whether it ought to be compelled to make any answer to said bill of complaint, and prays that it be hence dismissed with its reasonable costs in this behalf most wrongfully sustained.

HESS & TOWNSEND,
Solicitors for Defendants, 206 *Broadway, N. Y. City.*

W. J. TOWNSEND,
Of Counsel for Defendant.

UNITED STATES OF AMERICA, }
Southern District of New York, } *ss:*

Edward Lauterbach, being duly sworn, deposes and says that he is the treasurer of The Anchor Brewing Company, the defendant above named; that the defendant is a corporation created by and under the laws of the State of New York; that the foregoing plea is true to the knowledge of deponent, except as to the matters therein stated to be alleged upon information and belief, and as to these matters he believes it to be true.

Deponent further says that the reason why the verification
25 is not made by the defendant is that it is a corporation, and that this deponent is an officer thereof, to wit, treasurer.

ED. LAUTERBACH.

Subscribed and sworn to before me this May 4th, 1889.

GEORGE W. VULTEE,
[L. S.] *Notary Public* (49), *City and County of New York.*

I hereby certify that I am counsel for the defendant in the foregoing cause, and that, in my opinion, the foregoing plea is well founded in point of law and is not interposed for the purpose of delay.

W. J. TOWNSEND.

(Endorsed:) U. S. circuit court. Carl Pohl & ano. *vs.* The Anchor Brewing Co., defendants. Plea. Hess & Townsend, sol'rs for def't. U. S. circuit court. Filed May 6, 1889. John A. Shields, clerk.

Circuit Court of the United States, Southern District of New York.

CARL POHL and CHARLES ZOLLER
against
THE ANCHOR BREWING COMPANY.

The defendant in the above-entitled cause having interposed and filed a plea to the bill of complaint, it is, on motion of Joseph M. Deuel, solicitor for the complainants, ordered that said plea be, and the same hereby is, set down for argument.

Dated N. Y., May 6th, 1889.

26 United States Circuit Court, Southern District of New York.

CARL POHL and CHARLES ZOLLER
against
THE ANCHOR BREWING COMPANY.

It is stipulated between the parties hereto that either party, on the trial and argument hereof and on any appeal herein, may use the volume entitled "Patent Laws of the World, collected, edited, and indexed by Alfred Carpmael, solicitor, and Edward Carpmael, B. A., patent agent, London; William Clowes & Sons, Limited, 27 Fleet street, 1885," with like force and effect as if said volume had been duly proved in the case as containing the original and translation of the laws of the several countries as therein set forth.

Dated May 8th, 1889.

J. M. DEUEL,
Sol'r for Compl'ts.
HESS & TOWNSEND,
Sol'rs for Def't.

27 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the United States court rooms, in the city of New York, on Friday, the seventh day of June, in the year of our Lord one thousand eight hundred and eighty-nine.

Present: The Honorable William J. Wallace, circuit judge.

CARL POHL & *al.*
vs.
THE ANCHOR BREWING COMPANY.

The argument of the plea to the bill in the above cause coming on this day to be heard—

Mr. W. J. Townsend and Mr. Edmund Wetmore are heard in behalf of the defendants in support of the plea.

Mr. Joseph M. Deuel, Mr. Grosvenor P. Lowrey, and Mr. Clarence A. Seward are heard, in behalf of the complainants, in opposition.

C. A. V.

28 United States Circuit Court, Southern District of New York.

POHL *et al.*
vs.
THE ANCHOR BREWING COMPANY.

WALLACE, *J.:*

The bill of complaint alleges infringement by the defendant of letters patent of the United States dated March 18, 1879, for improvement in barrel and cask scrubbing machines, granted to Carl Pohl, of Dresden, Germany, upon an application filed January 3, 1879, "subject to the limitation prescribed in section 4887 of the Revised Statutes by reason of German patent dated September 6, 1877, and French patent dated September 3, 1877." The defendant has interposed a plea averring in substance that both the German and the French patents were issued to Pohl for the same invention described in and prior to his application for the United States patent, and that the German patent lapsed and the French patent became forfeited prior to the commencement of the present suit by reason of the failure of the patentee to pay the annuities and work the invention as required by the laws of Germany and France in force when the foreign patents were granted. The plea alleges that the
29 original term of each of the foreign patents was for fifteen years. The plea has been set down for argument, and the question for determination is whether by section 4887, Revised Statutes, the United States patent expired when the foreign patent having the shortest term terminated by lapse or forfeiture, or whether it does not expire until the original term of such foreign patent expires.

By the section in question the patent in suit is to be limited "to expire at the same time with the foreign patent; or, if there be more than one, at the same time with the one having the shortest term." Until the decision of the Supreme Court in Bate Refrigerating Co. *v.* Hammond (129 U. S., 151) it was generally supposed that the time of expiration of this section was the time of expiration of the original term of the foreign patent, and that the duration of the United States patent was independent of the contingency that the foreign patent might cease to be an operative grant prior to the term specified on its face by the breach of a condition subsequent. This was so decided in several adjudged cases. Paillard *v.* Bruno (29 Fed. Rep., 864); Bate Refrigerating Co. *v.* Gillett (31 Fed. Rep., 809); Holmes Electrical Protective Co. *v.* Metropolitan Burglar Alarm Co. (21 Fed. Rep., 488). These decisions interpreted the statute upon considerations of public policy and convenience so imperaative that it was thought they could not have been disregarded
30 by Congress, and emphasized the effect to be given to the word "term" as used in the section. It was supposed that when Congress referred to the patent having the "shortest term" to define the time of expiration of the United States patent in case there should be two foreign patents the time of expiration in all cases

was the end of the term of the foreign patent; that the term of a patent meant the period of duration expressed in the patent; that in a legal sense a patent does not "expire" until the term expires, and that a construction of the section by which the duration of the United States patent should be fixed when the patent issues, by applying the rule *id certum est quod certum reddi potest*, was the more reasonable one and the one intended by Congress; and it had been pointed out that unless this was the true construction of the section neither the owner of the patent nor the public would know the duration of the grant, and that the United States patent might expire, if there were two foreign patents, at the same time with the one having the longest term, notwithstanding the language of the section that it is to expire with the one having the shortest term. The decisions of the circuit courts which have been cited were not referred to in the opinion of the Supreme Court in Bate Refrigerating Co. *v.* Hammond; but other adjudications of circuit courts in construction of the section which pro-
31 ceeded upon the same considerations were distinctly disapproved. These were Henry *v.* Providence Tool Co. (3 Ban. & A., 561); Reissner *v.* Sharp (16 Blatchf., 383); Bate Refrigerating Co. *v.* Gillett (3 Fed. Rep., 553), where it had been held that the time of expiration of the United States patent was the end of the term expressed in the foreign patent, notwithstanding the prolongation of the original term was a matter of right to the patentee and had actually been obtained by him. It is now urged for the complainants that the decision of the Supreme Court does not overrule or discredit the decisions of the circuit court which were not referred to and distinctly considered in the opinion, and is to be read as merely deciding the precise question in the case, which was whether an extension of the term of a foreign patent which by the foreign law was a matter of right to the patentee, upon complying with certain conditions, prolonged the duration of the United States patent. The opinion does not discuss the reasons for the construction given to the section, but it states that the point in controversy is whether the United States patent expires "at the same time with the term to which the foreign patent was in fact limited when the United States patent was granted," or expires "when the foreign patent expires without reference to the limitation of the term of such foreign patent in actual force at the time the United States patent was granted;"
32 and it declares that the statute means "that the United States patent shall not expire so long as the foreign patent continues to exist," and "is to be so limited by the courts as a matter to be adjudicated on evidence *in pais* as to expire at the same time with the foreign patent," and "is to be in force so long as the foreign patent is in force." The contention for the complainants would be justified if the opinion had suggested that the term of a foreign patent, within the meaning of the section, may be deemed either the original term expressed in the patent or a period of duration to which its life may be prolonged as a matter of right and law in the country of its origin; or that, although a patent expires when its term expires, Congress did not mean to limit the life of an United States

patent to the original term of the foreign patents. But in the absence of any such suggestion and by the extracts which have been given it seems plain that the Supreme Court has not acceded to the interpretation adopted in the previous adjudications, as well those not referred to in the opinion as those that were. The opinion cannot be reconciled with the view that the statute intends that the United States patent shall have a fixed term, ascertainable when it issues by reference to the term of a foreign patent. It does not attach any significance to the word "term" as defining the period of duration of the foreign patent or of expiration of the United States patent, but treats that period as
33 one to be ascertained *dehors* the foreign patent by evidence *in pais* and without reference to any supposed inconvenience or uncertainty to the public or the patentee which may ensue in consequence of their ignorance, whether the patent is or is not in life. The statute is capable of the meaning that the exclusive right to the invention here is to cease with the exclusive right of the patentee in any foreign country, or of the meaning that it shall continue to exist for such period, not exceeding 17 years, as coincides with the shortest term of any foreign patent. The Supreme Court seems to have adopted the first of these meanings. This is the view of the decision expressed in the recent case of Huber *v.* N. O. Nelson Manufacturing Co. (38 Fed. Rep., 830), and is the construction of the statute adopted by the Commissioner of Patents shortly after the passage of the act of July 8, 1870, in which the section first appears in case of Mushet, 2 Com. Dec., 106.

The conclusion thus reached is contrary to the impressions entertained at the argument of the plea, but a careful reading of the opinion of the Supreme Court constrains the conclusion that the plea must be held to be good.

(Endorsed:) United States circuit court, southern dist. of N. Y. Pohl *et al. v.* The Anchor Brewing Co. Opinion. Wallace, J. U. S. circuit court. Filed Aug. 8, 1889. John A. Shields, clerk.

34 At a stated term of the circuit court of the United States of America for the southern district of New York, in the second circuit, held at the post-office building, in the city of New York, on the 25th day of September, in the year of our Lord one thousand eight hundred and eighty-nine.

Present: Hon. William J. Wallace, judge.

CARL POHL and CHARLES ZOLLER
vs.
THE ANCHOR BREWING COMPANY. } In Equity.

This cause having come on to be heard upon the bill of complaint and the defendant's plea thereto and having been argued by
35 counsel for the respective parties, and consideration thereof having been had—

Now, therefore, on motion of Hess & Townsend, solicitors for de-

fendant, it is ordered, adjudged, and decreed that said plea of the defendant be, and the same hereby is, sustained, and that the bill of complaint herein be, and the same hereby is, dismissed, with costs to be taxed, and that the defendant have execution therefor.

WM. J. WALLACE.

(Endorsed:) U. S. circuit court. Carl Pohl & *al.* ag'st The Anchor Brewing Company. Final decree. Hess & Townsend, sol'rs for def't, 206 & 208 Broadway, New York city. U. S. circuit court. Filed Sept. 25, 1889. John A. Shields, clerk.

36 United States Circuit Court, Southern District of New York.

CARL POHL and CHARLES ZOLLER, Complainants,
against
THE ANCHOR BREWING COMPANY, Defendant.
} In Equity.

To the honorable the Supreme Court of the United States:

The appeal of Carl Pohl and Charles Zoller, the above-named complainants and appellants, respectfully showeth—

That upon the sixteenth day of April, A. D. 1889, the above-named complainants filed their bill of complaint in the circuit court of the United States for the southern district of New York against the above-named defendant, alleging that Carl Pohl was the first, original, and sole inventor of a new and useful improvement in barrel and cask scrubbing machines, for which letters patent numbered 213,447, dated March 18, 1879, were granted to him and which were made "subject to the limitation prescribed by section 4887 of the Revised Statutes by reason of German patent dated September 6th, 1877, and French patent dated September 3rd, 1877," copies of which said patents, translated into English, were annexed to said bill of complaint and each of which was

37 limited on its face to a term of fifteen years.

It further appeared in said bill of complaint that by an instrument in writing, duly recorded in the Patent Office, the said Carl Pohl, on July 7th, 1887, granted to the complainant, Charles Zoller, the exclusive right to manufacture, make, sell, use, and vend barrel and cask scrubbing machines containing the invention described in said letters patent within the territory of the United States.

The said bill of complaint charged the defendant with having infringed said letters patent owned by complainants as aforesaid, and praying for a perpetual injunction against said defendant and an accounting.

That a subpœna was duly issued on said bill and duly served.

That said defendant duly appeared, by its solicitors, Messrs. Hess & Townsend, and filed its plea to the bill of complaint, alleging that the prior patents granted to the inventor in France and Germany had each become forfeited and had lapsed by reason of the failure of the inventor to work the invention and pay the annuities

in those countries, respectively, and that by the limitations prescribed in section 4887 of the Revised Statutes of the United States the said letters patent of the United States had ceased and determined, as well — all rights and privileges thereunder.

That pursuant to the rules of practice the complainants did, on May 6th, 1887, set said plea down for argument.

38 That thereafter and during the April term, 1889, of said court this cause came on to be heard on the pleadings as aforesaid, and was argued by counsel, and thereafter his honor William J. Wallace, circuit judge, before whom the said cause was argued, rendered his decision in said cause, wherein he sustained said plea and dismissed the said bill of complaint, with costs.

That thereafter a final decision was entered herein in favor of the defendant, dismissing the said bill and awarding costs against the complainant.

Wherefore this appellant appeals from the whole of said decree of said circuit court of the United States, and respectfully prays that the decree of said circuit court and the bill, plea, and proceedings in the said cause may be sent to the Supreme Court of the United States without delay, and that the Supreme Court will proceed to hear the said cause anew, and that the said decree of the circuit court, and every part thereof, may be reversed and a decision made sustaining the said bill, and also that defendants may be required to account for and pay to a complainant the profits it has derived from said infringement, and the damages it has caused complainant by reason of said infringement, and also the costs of this complainant in this cause and on this appeal, and that the defendant may be perpetually enjoined and restrained from using said invention, and that such other and further decrees may be made as to the said Supreme Court may seem just.

39 Dated this 25th day of Sept., A. D. 1889.

J. M. DEUEL,
Solicitor & of Counsel.

The foregoing appeal allowed Sept. 25th, 1889.
E. HENRY LACOMBE.

We hereby consent that the citation on the appeal in this case may be signed without requiring the security provided for by statute, which security is hereby waived.

HESS & TOWNSEND,
Sol'rs for Def'ts.

40 By the Honorable —— ——, one of the judges of the circuit court of the United States for the southern district of New York, to the Anchor Brewing Company:

Whereas Carl Pohl and Charles Zoller have lately appealed to the Supreme Court of the United States from a decree lately rendered in the circuit court of the United States for the second circuit and southern district of New York, made in your favor, in the suit

entitled Carl Pohl and Charles Zoller against The Anchor Brewing Company, and the security required by law having been duly waived:

You are, therefore, hereby cited to appear before the said Supreme Court, at the city of Washington, D. C., on the second Monday of October, 1889, to do and receive what may appertain to justice to be done in the premises.

Given under my hand, at the city of New York, in the second circuit and southern district of New York, the 25th day of September, in the year of our Lord one thousand eight hundred and eighty-nine.

E. HENRY LACOMBE.

(Endorsed:) U. S. circuit court, southern dist. of N. Y. Carl Pohl *et al.* against The Anchor Brewing Company. Petition of appeal, waiver of security, and citation. Joseph M. Deuel, attorney
41 for complainants, 11 Pine St., New York city. Due service of the within petition of appeal and the citation is hereby admitted. N. Y., Sept. 26th, 1889. Hess & Townsend, sol'rs for def't. U. S. circuit court. Filed Sept. 27th, 1889. John A. Shields, clerk.

42 UNITED STATES OF AMERICA, } ss:
Southern District of New York, }

I, John A. Shields, clerk of the circuit court of the United States of America for the southern district of New York, in the second circuit, do hereby certify that the foregoing pages, numbered from one to forty, inclusive, contain a true and complete transcript of the record and proceedings had in said court in the case of Carl Pohl and Charles Zoller, complainants & appellants, against The Anchor Brewing Company, defendants & appellees, as the same remain of record and on file in said office.

Seal U. S. Circuit Court, South. Dist. of New York.

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the city of New York, in the southern district of New York, in the second circuit, this 30th day of September, in the year of our Lord one thousand eight hundred and eighty-nine, and of the Independence of the said United States the one hundred and fourteenth.

JOHN A. SHIELDS, *Clerk.*

Endorsed on cover: S. New York C. C. U. S. No. 1269. Carl Pohl and Charles Zoller, appellants, *vs.* The Anchor Brewing Company. Filed October 1, 1889.

SUPREME COURT OF THE UNITED STATES.

CARL POHL AND CHARLES ZOLLER,
Appellants,

vs.

THE ANCHOR BREWING COMPANY,
Respondents.

BRIEF ON APPEAL FROM THE CIRCUIT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK, ON BEHALF OF THE APPELLANTS.

GROSVENOR P. LOWREY,
B. F. THURSTON,
CLARENCE A. SEWARD,
J. M. DEUEL,
For Appellants.

NOAH DAVIS,
On Behalf of Edison Electric Light Co.

C. G. Burgoyne's Printing Business, Cor. Walker and Centre Sts., N. Y.

Supreme Court of the United States.

POHL and ZOLLER

AGAINST

THE ANCHOR BREWING COMPANY.

This is an appeal from the Circuit Court for the Southern District of New York.

Assignment of Error.

1. The Court below erred in holding that the lapse of a German patent, and the forfeiture (or liability to forfeiture by judicial decree) of a French patent, both prior in date to the United States Patent in suit, caused the latter to expire under Section 4887 R. S., notwithstanding such lapse and forfeiture ensued from a breach of condition subsequent, imposed by the foreign law, and not from the expiration of the foreign terms to which the patent was limited at the issue of the letters (Record, fols. 32-34).

2. The Court erred in sustaining the plea and dismissing the appeal (Record, fol. 35).

Facts Appearing by the Plea.

The plea sets up prior German and French patents;—

that "by the terms and provisions thereof they were for the term of fifteen years;" and that "the patentee was required to pay certain annuities * * * to work the invention" in certain times and manner, "in default of which the term of said letters patent would expire, and the rights and privileges * * * thereunder become forfeited and cease" (*fols. 22, 23*).

The plea then avers that the inventor did fail to comply with these laws; and that in consequence the German Letters Patent became and were forfeited, and the term thereof expired, and the rights and privileges of "the inventor thereunder ceased and determined" (fol. 87).

A similar averment of fact and conclusion of law as to the French patent appears at fols. 23, 24.

From these facts it is concluded by the pleader, and averred, that the patent in suit, No. 213,447, "*expired* and the term thereof ended" prior to the beginning of the suit.

The plea refers to the foreign laws (fols. *22-23*); and a stipulation (*fol. 26*) adopts Carpmael's "Patent Laws of the World" as authentic.

The material part of the German law is for convenience set out here. Enough of the French law is also quoted to call for judgment whether in the absence of averment of a French adjudication the plea can be sustained so far as it sets up a French patent.

German Law of July, 1887.

(Page 208 *et seq.*, Carpmael's Patent Laws of the World.)

§ 1. Patents are granted for new inventions which can be turned to account in trade.

The following are excepted:

1. Inventions the use of which would be incompatible with the laws of public morals.

2. Inventions of articles of food (for nourishment or luxuries), of medicines and of substances produced by chemical process * * *

§ 7. The duration of a patent is 15 years; the term commences with the day following the day of application.

* * * * * *

§ 9. A patent *lapses* if the patentee renounces the same, or if he fails to pay the fees within three months at the latest after they have become due.

§ 10. A patent will be declared *void* if it turns out:

12. That the invention was not patentable according to Sections 1 and 2. * * *

§ 11. A patent can be declared *void* after the expiration of three years.

1. If the patentee fails to work his invention in Germany to an adequate extent, or at least to do everything that is necessary to ensure its being worked.

2. Whenever the grant of license to others to use the invention appears to be demanded in the public interest, and the patentee nevertheless refuses to grant such license upon adequate compensation and good security.

§ 19. A register will be kept at the Patent Office, in which the subject and duration of patents granted will be entered. * * * The commencement, the *termination*, the *expiration*, the decree of annulment and the revocation of patents are to be entered in this register. * * *

French Law of 1844.

(Carpmael, pp. 200, 201).

ART. 32:

The following shall be deprived of their rights:

1. The patentee who has not paid his annuity before the beginning of each year of the term of his patent.

2. * * * * * *

ART. 34:

An action for annulment or an action for forfeiture may be brought by all persons interested therein.

These actions * * * shall be brought before the Civil Tribunal of first instance.

It is manifest from a comparison of the statute with the plea that the quotations from the plea above given —stating what has happened to the German patent under the German law—are largely *conclusions of law* in the guise of facts, and that the law itself may, under the stipulation, be resorted to to correct these misconstructions, *ex gr.*, the statement that the patent *expired*, when in fact it merely *lapsed*.

Question.

What, if any, legal consequences affecting the American patent will follow when the happening of these foreign events is duly alleged and proven?

The legal effect, if any, which follows depends, of course, solely on American law,—the familiar Section 4887 of the Revised Statutes of the United States, as follows:

"But every patent granted for an invention which "has been previously patented in a foreign country "shall be so limited as to expire at the same time with "the foreign patent; or, if there be more than one, at "the same time with the one having the shortest term, "and in no case shall it be in force more than seven-"teen years."

The opinion of WALLACE, J., gives clear evidence that in his judgment the true construction of Section 4887, R. S., ought to have been different from that to which his reading of the case of Bate vs. Hammond, 129 U. S., compelled him. He says:

"The statute is capable of the meaning that the exclusive right to the invention here is to cease with the exclusive right of the patentee in any foreign country, *or* the meaning that it shall continue to exist for such period not exceeding seventeen years as coincides with the shortest term of any foreign patent. The Supreme

Court seems to have adopted the first of these meanings. * * *

The conclusion thus reached is contrary to the impressions entertained at the argument of the plea, but a careful reading of the opinion of the Supreme Court constrains the conclusion that the plea must be held good" (fol. 23).

Assuming it then, to be doubtful what the law is, as a matter of mere hermaneutics,—the occasion is proper for asking what it *ought* to be, as matter of enlightened policy—for that is probably what it is.

Public Policy.

The policy of our patent legislation in its general scope and effect and in all its particulars of expression, is derived from the Constitutional expression of national policy on the subject. Congress shall pass laws:

"To *promote* the progress of science and the useful arts by *securing* for *limited times* to authors and inventors the exclusive right to rheir respective writings and discoveries." Art. 1, § 8, Subd. 8.

The promotion of science and the useful arts is therefore a public end. To advance this public end is the primary, and to advance private interests is the secondary, object of this legislation. The method of accomplishing such advancement is to give the inventor *security* for *definite* times, to be limited in the original grant. The whole scheme of legislation on the subject is, therefore, to be taken as in aid of the public object, and receive a liberal construction to that end, at the same time that it receives a strict construction when attempt is made to evolve penalties from its terms.

When different readings of patent legislation are found practicable, the tendency should be to adopt such

as aid and encourage the promotion of science and the useful arts by aiding and encouraging their promoters. This can be done only by upholding that system of inducements and rewards to inventors and discoverers, which has been adopted by our own country and by more than fifty other independent States and nations, as the best means to that end.

The inducement which our national policy offers to the inventor is *security* for a *certain* time *limited at the making of the grant* and notified to him and to the world by the terms of the grant. He has thus something definite and assured to deal with, and work under. Manifestly the reward loses a large part, and in many cases all its value unless is this security is secure—for a certain time; and unless the times over which the security extends are definitely ascertainable *ab initio*, by reference to the grant, or by the rule *id certum est quod certum reddi potest.*

There is practical pertinency in the question whether anything can be considered *secured* for a *limited time* which is liable to be lost before the expiration of that time upon the happening of an uncertain event,—uncertain not only as to when it will happen; where it will happen; or who may be in position to prevent its happening; or,—of course,—whether it will happen at all.

There is no disposition to evade the suggestion that one who takes a right or estate on condition has no ground of right to complain of the enforcement of the condition; but the question is, what was the condition?

When the American inventor is threatened with the loss of his domestic patent for something happening in foreign countries under foreign laws,—and when there are two readings of a domestic statute bearing on the subject, one of which will preserve and the other destroy the rewards of his domestic labors,—can there be no doubt which reading will be chosen and enforced

by courts of law, as being most likely, on the whole, to promote the progress of science and the useful arts.

Some further observations on the political aspect of this law will be made when we come to consider the contrary theories of construction which have been suggested.

The History of this Question prior to Bate vs. Hammond, 129 U. S., 157.

Since the case of Henry vs. The Providence Tool Co., 3 Bann. & Ard., 501; 14 Off. Gaz., 855: the law by construction has been, and we insist still is, that the limit of life of American patents for inventions, previously patented abroad, is *fixed* at the date of issue by reference to the then existing "terms" of the foreign patents; that "Congress employs the word 'the foreign' *patent*, evidently referring to the *term* of the foreign patent to define the term of the domestic patent," and that the American expiration is for certainty's sake predicated on the *expiration* of the foreign *term*, and not upon any intermediate cessation of the power or faculty of the foreign letters, to sustain a monopoly.

Henry vs. The Providence Tool Co., p. 507.

As corollary to this it was held in that case that such possible extensions of life as were not, at the issue date of the domestic patent, discernible on the face of the foreign patent, were not to be considered as part of the existing foreign "term" by which the limit of life of the domestic patent was then to be fixed.

Thus the question was, What is the term? Does it include such a prolongation?—so called.

That case was decided on a state of facts which exhibited clearly the difference for purposes of judgment, between legal *extensions* and prerogative *prolongations*. The disputed foreign prolongation was a

matter of grace, not of right; and was actually conferred only after a complete efflux of the original term, —succeeded by an interregnum.

The doctrine of Henry vs. The Providence Tool Company was afterwards erroneously extended in two other cases (Reissner vs. Sharp, 16 Blatch., 383, and Bates vs. Gillett, 13 Fed Rep., 553), to a state of facts in which the extension was a matter of right—acquired with and as a part of the grant—and not of grace.

In the case of Bate vs. Hammond, this Court has on a state of facts like that last described, overruled and repudiated this unsound extension of a sound doctrine, by deciding that where the first, defined period, or term of a foreign patent is renewable at the sole election of the inventor (and is renewed), the foreign patent does not, within the meaning of our law, "expire" at the end of that first period; and *a fortiori* the United States patent does not then expire.

This Court appears not to have overruled or discredited in any degree so much of the doctrine of Henry vs. The Providence Tool Co., as declares that at the issue of the American patent it takes into its life an integral element or condition, derived from the fact that a specific and definitely ascertainable foreign term for the same monopoly, is at that moment in existence; but, on the contrary, this Court adopts that doctrine, and the reasons for it. It seems merely to overrule the mistaken applicationof that doctrine which limited the foreign term to what may be called the first division of that term. This Court seems to direct the lower Courts, in looking at foreign terms, to enlarge their view; and to include as of the original term all extensions guaranteed at the date of the original by provisions discernible on the face of the patent, or in the foreign law. This was all that the facts or the arguments before the Supreme Court in the case of Bate vs. Hammond presented for

decision. It is all, therefore, which we are justified in supposing the Court intended to decide.

If there be expressions in the opinion, tending to indicate what might have been the decision of the Court if a case like this had been before them,—in which a foreign patent franchise had been violently and unnaturally ended during the currency of its term, as a penalty for breach of condition subsequent,—those expressions are, according to familiar principles controlling the application of judicial judgments, to be treated as *obiter dicta*—not necessarily binding upon the Court.

If this be so, we have before the Court in this case a new question, whether the loss by the foreign patent owner of the benefit of *his* patent, by lapse (or however called), as a local penalty for not doing something required by foreign law, shall implicate the domestic patent owner to the extent of the loss of his United States patent.

In considering that question it will be useful to re-examine Henry vs. The Providence Tool Co., the judgment in which is remarkable for its prudence, its conservation of existing rights, and its clear views of public policy.

Henry vs. The Providence Tool Co.

That decision is expressly rested on principles of convenience and policy.

Having first defined and fixed the sense of the words "the foreign patent" as being equivalent to the words "the *term* of the foreign patent" (page 507); and having indicated that by the word "term" he means "the legal term *secured* to the foreign patentee when the domestic patent was granted" (page 509); the learned Justice said:

> "Great inconvenience would result from the

"opposite rule, as neither the authorities of the "United States, nor inventors nor the public "would ever in such a case be able to know what "the patentee acquired" (509).

* * * * * *

"Tested by these general considerations, the "Court is of opinion that the patent in suit ceased "to be operative when the original foreign patent "expired."

It is manifest at the same place, (from the argumentative caveat against repugnant reasons which Mr. Justice CLIFFORD draws from the system of extension formerly prevailing here), that he uses the words "original," (as contrasted with some kinds of "extended" patent) and also the word "expired," in view of a controlling postulate which is compounded from the ideas of

(1) *A fixed term;*
(2) A fixed term *legally secured;*
(3) A fixed term legally secured *and finally ending by mere flux of time* (*i. e.*, expiring).

The learned Justice says (page 508), by way of showing that arguments drawn from statutory extensions *ex jure*, are inapplicable to English prolongations *ex gratia:*

"Extensions, when they were authorized here, "were inchoate rights under the law, and were so "far property that such a right could be sold.

* * * * * *

"Enough appears in these suggestions to show "that there was *a wide difference* between the "*legal discretion* which the Commissioner of Pat-"ents exercised under the Act of Congress grant-"ing extensions, and the prerogative power exer-"cised by the Crown in granting what are called "prolongations of original patents. Applications

" of the kind here, if the statutory conditions were
" fulfilled, the Commissioner of Patents had no
" right to refuse; but a patentee in the foreign
" country, if he obtains his request at all, obtains
" it not as a legal right, but as a royal favor which
" of itself goes far to support the proposition
" * * * that Congress never intended (as of
" the time of issue of course), to extend the term
" of the domestic patent beyond the legal term
" *secured when* the domestice patent was granted "
(pages 508, 509).

Elsewhere in the opinion (page 107) he protests against the contention of the complainant because—

" None could foreknow whether the term of the
" patent was for three years or seven years, or for
" some intermediate term of duration, the effect of
" which would be to make the right of property in
" this country depend upon the discretion exer-
" cised by a foreign sovereign."

The cardinal principle of Henry vs. The Providence Tool Company, is that certainty must be attained. The cardinal error of Reissner vs. Sharp was that in the case of short term renewable patents certainty is attainable only by cutting one term down to the first short section of a full fifteen years' term. Bate vs. Hammond adopt the argument of the first case as to certainty, and corrects the last case as to what certainty consists in.

Some cases identical in facts with this case.

Three cases have arisen in the United States since the decision of Mr. Justice CLIFFORD, involving the

precise facts of this case, and therefore the precise question at bar. They were the cases of Holmes vs. The Metropolitan (1884), &c., Co., 21 F. R., decided by WHEELER, J.; Pailliard vs. Bruno, 24 Blatch., 177 (1886), decided by WALLACE, J.; Bate Refrigerator Co. Gillett, 31 Fed. Rep., 809 (1887), decided by Mr. Justice BRADLEY.

Holmes vs. The Metropolitan, &c., Company was the case of the lapse of a foreign patent for non-payment of taxes. Judge WHEELER said:

> "It is also urged that the patent has expired, "because the invention is the subject of a prior "English patent which has been suffered to lapse "for non-payment of taxes. The statute merely "requires that in such a case a patent shall be "so limited as to *expire* at the same time with the "foreign patent.
>
> "This seems to mean that the *term* of the for- "eign patent here shall be as long as the remain- "der of the term *for which* the patent *was granted* "them *without reference to incidents occurring after* "the grant. It refers to *fixing* the *term*, not to "*keeping* the foreign patent in force."

In Pailliard vs. Bruno, the alleged cause of foreign forfeiture was the failure to pay "a certain stamp duty required by the terms of the English patent, as a condition of continuance of the grant beyond the term of three years from its date, and the plea presented the question whether the patent in suit *expired*" upon the failure to pay that duty "or whether it does not expire until the expiration of the original term of the English patent." Judge WALLACE said:

> "* * * it (the statute) should be read as "though it declared that the United States patent "is to expire at the same time with the term of the "foreign patent * * * Upon this construction "the duration of the term * * * is fixed "when the patent issues according to the maxim,

" ' *id certum est quod certum reddi potest.*' Upon
" any other construction neither the Commissioner
" of Patents, nor the patentee, nor the public,
" would know the duration of the grant."

In the case of the Bate Refrigerator Co. vs. Gillett, Mr. Justice BRADLEY had substantially the precise facts of this case before him.

Concerning the *fixing* the U. S. term at the dnte of issue by reference to something which is certain at that time, he said :

" I may say at once that I attach no importance to
" the last-mentioned act." (An act of the Dominion Parliment of May 25th, 1883, declaring that all Canadian patents were issued for fifteen years, subject to lapse at the end of each period of five years, unless renewed by payment of fees, &c.) " The American
" patent received its operative force and effect on the
" day it was issued, and no subsequent legislation in
" Canada or elsewhere could change it, whatever might
" be the effect of such legislation where made. The
" force and effect of the American patent could only be
" affected by the Canadian patent as the latter stood
" when granted, and not as it was afterwards modified
" by legislation. * * * The defendants have presnted
" an additional petition praying for a dissolution of the
" injunction, and an order to limit the period of account-
" ing for profits, on the ground that a previous English
" patent was granted for the same invention on the
" twenty-ninth of January, 1877, for the term of 14
" years, provided, that if the patentee should not pay
" the stamp duty of £50 within three years, or of
" £1000 within seven years, the said letter patent
" should cease and determine. The petition alleged
" the patentee failed to pay the said stamp duty of £50
" within three years, and that thereby the said patent
" became void on the twenty-ninth of January, 1880,
" and the defendants contend that the United States
" patent of the complainant did, by operation of law,
" cease and determine at the same time. I do not
" think that this position is maintainable. The English
" patent was granted for a term of 14 years, subject to

" be defeated by the non-performance of a condition
" subsequent. I do not think that the American patent
" became subject to the same condition. The *term* of
" the English patent fixed the term of the American
" patent; nothing more, nothing less. The subsequent
" fate of the English patent had no effect upon the
" American. The life of each after its inception pro-
" ceeded independently of the life of the other.,'

Thus the law as established by the Circuit Courts of the United States up to the decision by this Court of Bate vs. Hammond, was,

(1) That the life of an American patent is fixed at the the date of its issue by the shortest foreign term in view at that time—and *without* reference to any conditions subsequent affecting that, or any, foreign term.

(2) That when the foreign law provides for divisional and renewable terms it is only the first division which is legally in view for the purpose of fixing the American term; and that when the first foreign divisional term expires, the foreign patent expires within the sense of our statute; and therefore, the American patent also then expires.

The Supreme Court has now readjusted the point of view from which such foreign patents are to be contemplated; and has directed us to recognize, in the initial divisional term all future extensions thereof, the uncontrolled right to which vested in the foreign patentee when he took out that initial divisional term. By this they overruled all decisions classified under the second paragraph above stated.

Have they done anything more?
Have they disturbed those clear, strong, reasonable and

consistent declarations of law quoted from the four cases decided by J.J. CLIFFORD, BRADLEY, WALLACE and WHEELER?

Is there anything in the judgment in Bate vs. Hammond inconsistent with Mr. Justice Bradley's opinion, "I do not think that the American patent became subject to the same (subsequent) condition."

The Court below recognized that the Circuit Courts in Holmes Electric Co. vs. Metropolitan Co., 22 Blatch., 471; Paillard vs. Bruno, 29 Fed. Rep., 864, and Bate Refrigerating Co. vs. Gillett, 31 Fed. Rep., 809, had held on all occasions prior to the decision in Bate vs. Hammond, that the term of a United States patent was not shortened by the failure to perform a condition subsequent contained in some previously obtained foreign patent for the same invention. In fact at the bar no doubt or question was ever entertained upon this subject before the view taken by the Court below in the present case, and by Judge THAYER in Huber vs. Nelson Mfg. Co., 38 Fed. Rep., 830, as the result of the interpretation which has been given by these Courts to the decision of this Court in Bate vs. Hammond.

It was supposed by the Court below that a new rule of decision on this question had been introduced by this Court, and that the doctrine of the cases cited had been overruled. This conclusion is derived from certain passages found in the opinion of the Court which are entirely consistent with the subject involved in the decision of that case, but are not necessarily decisive of the present question. The question now under consideration was in no respect under review before this Court in the Bate case, and it is not to be inferred that this Court intended by anticipation to decide the present question.

In order to reach the conclusion at which the Circuit Court arrived it became necessary to find that the

principle involved in the decision in the Bate case went to the extent of holding that the life of a United States patent was necessarily coextensive with the duration of the patented protection in the foreign country in which the invention had been previously patented. This Court has made no such decision. The language which has been cited from the opinion as authorizing this conclusion is entirely consistent with the reasoning of the Court in that case, and while its generality of phraseology may be sufficient to include a decision upon the point now under consideration, it is apparent that the language was not used in reference to the subject involved in the present case.

The simple question before this Court in the Bate case was what is the term contemplated by Section 4887, by the words: "But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one at the same time with the one having the shortest *term*." The contention in the case on the part of the appellee was that the "term" specified in the act was the actual period of years for which the patent was granted by the foreign country at the time of the procuration and issuance of the United States patent. But the Court did not take this view. It decided, in effect, that under a statute like that which was in force in Canada at the time that the Bate patent was procured in this country, the term was not limited to the first fraction of the authorized term under the foreign statute, but was capable of embracing a period equal to all the terms authorized by the foreign law within the limit of seventeen years. In other words, the Court held that under the law of Canada, a patent was granted for fifteen years to all intents and purposes in case the patentee chose to perform certain conditions precedent. It took into account the fact that an adjudication had

been had in favor of the patentee to a patent for fifteen years, if he chose to take it for that full term; that no further judicial action was necessary to determine his right to such patent; and that as all that the patentee was required to do was to pay his fees seasonably, it was his right to take in the first instance, the first installment of the authorized term, and afterwards, by complying with the simple requirement of paying the fees, avail himself of the remaining installments of such legally authorized term.

Now, inasmuch as a title in the patent for the later installments of the term of the Canadian patent could not be acquired by the patentee except upon the performance of a condition precedent by the patentee, it became the duty of Bate to show that he had in fact availed himself of his privilege under the Canadian law, and as the proof of this fact resides *in pais*, the language of the Court recognized the necessity of proving it, and this is the meaning of the language: "Under this view the time of the expiration of the foreign patent may be shown by evidence *in pais* * * * and thus to show the time when by virtue of such extensions the United States patent will expire."

If the Court had happened to have phrased the the sentence so that it would read, "and this to show the time for which by virtue of such extensions *the term contemplated under Sec. 4887 will continue.* It is not at all likely that any Circuit Court would have drawn the conclusion which is expressed in the present case. The form of expression suggested would mean precisely what the paragraph in the opinion means, but because the word "expire" happens to be used, the argument is built upon it that the actual falling in of a foreign patent by the effect of a lapse in the performance of a condition subsequent shortens the life of a subsequently obtained United States patent.

Undoubtedly, if it had appeared in the Bate case

that Bate had never availed himself of his statutory right in Canada to prolong the first period of his patent term, this Court would have held that the patent in this country expired at the end of the first term of five years of the Canadian patent, and for the obvious reason that the Canadian patent would then in fact have *expired* as distinguished from having *lapsed*, and this follows from the fact that the thing to be performed by Bate to prolong his patent term beyond five years was a condition precedent to the vesting of a title in himself. And thus, under this supposed case, the patent which he had in hand would have truly expired at the end of five years, because it was in fact a grant for five years and no longer except upon the performance of a condition precedent which in the case supposed had not been performed.

In the present case there is no condition precedent to be performed on the part of the patentee in a foreign country to uphold the United States patent. In this case the foreign patent, both in Germany and France, were in fact for terms of fifteen years each. When the United States patent was procured the then existing legally recognized term of each of these foreign patents was fifteen years. The term contemplated by Sec. 4887 in respect to the grant in this country was fifteen years from the date of the foreign patent. The terms of the foreign patents in this case are not shortened because such patents were allowed to lapse for non-performance of conditions subsequent within the meaning of our statute. True the patent protection abroad in such countries has failed, but in no legal sense have such foreign patents expired.

There is no power under Sec. 4887 to defeat the term of a United States patent by the failure of a patentee of the same invention in a foreign country to perform a condition subsequently imposed upon him. The rule which is to govern is our own statute. The whole

of the section must be read together to reach its true meaning. The declaration is that every patent granted in this country upon an invention previously patented in a foreign country shall *expire* at the same time with the foreign patent. That is to say, its term of limitation shall be the term for which such foreign patent was at the time actually granted, which in this case was fifteen years. The concluding clause of the section emphasises this view, which might be open to some doubt except for this latter clause. The words are, "If there be more than one" (foreign patent) then the United States shall be limited to expire "at the same time with the one having the shortest term." The shortest term in the present case was fifteen years, and hence in express terms this patent was granted in this country for the term of fifteen years from the date of the earliest foreign patent. After this title to the invention for such period had become vested under the statute in the patentee, we look in vain for any provision in this or in any other section of the statute which will curtail its life, as the result of any failure to keep up the patent protection abroad. Under the doctrine upon which the Circuit Court acted in rendering its opinion and judgment the words in the statute, "shortest term," do not mean what the statute plainly intended they do mean, but there is substituted for these words the words, in effect, "period for which patent protection continues abroad." This we can imagine that in a foreign country, upon some principle which the Courts of this country would never recognize, the patent might be held invalid by a Court of last resort in the foreign country. Under the doctrine of the Circuit Court in this case, the patent in this country would fall also. But surely this result cannot be fairly found contemplated by our statute.

The terms for which patents are granted in this country are defined by the statute and obviously

should be for fixed times capable of being ascertained and not terms for uncertain periods dependent upon contingencies in a foreign country happening subsequent to the grant in this country. Undoubtedly that is certain which is capable of being made certain, and it would have been entirely competent for Congress to have framed Section 4887 so that the United States patent would fall when any previously obtained foreign patent lapsed or was declared invalid within the term for which it was granted. But Congress did not so frame the section. In the Bate case this Court declared that the term of the Bate patent was, under Sec. 4887, the period for which the foreign patent was authorized to continue in Canada, and it held in effect that under the Canadian law the terms of patents were for fifteen years subject only to the performance of a condition precedent not involving any judicial or ministerial action for determining a right. The same duty of defining what is meant by the word "term" in the same section arises in this case as an original question before this Court, the decision of which has not been anticipated in the Bate decision, and which, on the principle of the decision in the Bate case, is not required, as the Circuit Court supposes, to be decided in favor of the appellee to preserve consistency with that decision. The doctrine of Henry vs. Providence Tool Co. has not been overruled by this Court. Its principle stands unaffected by the decision in the Bate case, and the sound doctrine on which it rests, to the effect that the then existing term of the foreign patent measures the period of duration of the subsequently obtained United States patent, is the doctrine relied upon by the appellants in this case, and this doctrine is not inconsistent at all with the doctrine of the Bate case, but in fact is in entire harmony with it.

It seems to us that the Court below failed to

consider the radical difference between the character of titles to estates dependent upon the performance of conditions precedent, and of titles to estates dependent upon the performance of conditions subsequent. The difference is illustrated by the fact that in the former case equity cannot relieve against the non-performance of the condition; in the latter case it can give ready relief. But this case, indeed, does not involve the question of relief for the non-performance of a condition subsequent. It is the simple question of the meaning of the word "term" in our statute. That term which is to determine the duration of a patent in this country obtained subsequent to a foreign patent for the same invention, we say in the term authorized by the law of the foreign country, and in this case that period was fifteen years. Any shorter period for the life of the foreign patent, resulting from the non-performance of a condition subsequent, is not by legal intendment of our statute the shortening of its term any more than a judicial decision against the validity of the patent in the same foreign country would, from that fact alone, effect a shortening of the term of the patent in this country. The patent monopoly in the foreign country would be destroyed by such decision of invalidity, but the patent itself abroad would not "expire" in the sense in which the word is used in our statute, for the reason that the term or period of years for which it was granted would not have run out. It is this period of which our statute takes cognizance.

Some Practical Results of Interpreting the Statute as is Desired by the Appellee.

There are more than fifty countries in which letters patent are granted for inventions and discoveries. In

most of these countries the grant of letters is of course; is not preceded by any examination into novelty or utility; no possibility of contest between inventors exists; and there is no delay. For instance, the Belgian Patent Law provides (Carpmael, p. 40).

"ARTICLE II. Patents will be granted without previous examination at the risk and peril of the applicant without guarantee of the reality or of the novelty or of the merit of the invention or of the correctness of the description and without prejudice to the rights of third parties."

In this country a contrary system prevails. Patent applications are submitted to a rigid scrutiny; references, as they are called, are given to the inventor to such publications and prior or foreign patents as are deemed by the Examiner to anticipate or limit the applicant's claims; conflicting applications are put into interference and a judicial trial often proceeds with the not uncommon result of delaying the issue of the patent for several years. The shortest possible course in any case would make an American patent fail of issue until foreign patents of the same date of application could be issued in almost every country in the world. In many the issue date is the date of application, so that a prior American issue upon simultaneous applications is impossible.

Until the recent International Convention (Official Gazette, p.) the laws of foreign countries were such that it behooved the American inventor to get his foreign applications on file as early as possible, since the rule in many countries was, first come first served, without reference to originality or priority of invention. Besides that, subjects of a general interest often engaged at the same time the attention of studious and ingenious men in different parts of the world; and there was that race of diligence which

equity loves and rewards. It is well known that Mr. Edison's invention of the high resistance filamentary incandescent lamp—an invention which has perhaps suffered more perils of law in various countries than any other invention ever made—reached the British Patent Office only a few days before the arrival of a complete printed description in the "New York Herald;" and that within six days after, a complete claim for the same invention was filed in the British Patent Office by Mr. Swan, who had indeed been engaged upon similar studies, but like others had failed to hit upon the principle of high resistance, until he saw it set out in the "Herald" article—an unauthorized and unexpected publication. Mr. Edison escaped, therefore, by only six days, the loss of his English patent.

The intense motive which American inventors had, therefore, at that time, for getting their foreign applications on record is apparent.

It can also be seen that by the mere operation of our system to create delay, it is impossible that any diligence should save the inventor from the chance of having his foreign patents *issued* first, unless he will risk the loss of foreign patents alogether. And if those foreign patents issue burdened with conditions subsequent, the American patent is, on the appellee's theory, eventually born infected with chances and possibilities of frustration, by the hostile action of rivals and enemies, even in the hands of innocent purchasers, which tend but little to encourage capital and industry to the promotion of science and the useful arts.

The list of dangers, in number and variety, to which the American patent is thus made subject under the appellee's choice of the two readings pointed out by Judge Wallace may, by an examination of foreign laws, be extended until the whole operates by a *reductio ad absurdum* to refute the idea that Congress ever intended

to subject American property to such risks. Only some great and overbalancing motive of policy or convenience could justify entertaining the idea that such could have been the intent of the Legislature. That there is an entire absence of such a motive, and that the suppositions motives and policy which have been suggested—such as, "That the monopoly in this country should cease when the monopoly in other countries ceases, etc."—will be demonstrated later. For the present we desire to call attention to some of the great variety of conditions subsequent—ranging from the serious to the whimsical—each of which may defeat a foreign patent which, in spite of the inventor's diligence in prosecuting his American application may have issued in the foreign country before issuing here.

We take the case of Canada first.

The Canadian statute provides:

> "Section 28. Every patent * * * shall be subject * * * to the conditions that such patent * * * shall cease and determine and the patent shall be null and void at the end of two years from the date thereof, unless the patentee * * * shall, within that period, have commenced * * * the construction or manufacture of the invention * * * and that such patent shall be void if, after the expiration of twelve months * * * the patentee * * * import or cause to be imported into Canada the invention, * * * and provided always that in case disputes should arise as to whether the patent has or has not become null and void under the provisions of this statute, such dispute shall be settled by the Minister of Agriculture or his deputy, whose decision shall be final."

Upon this statute, one of appellant's counsel said in his brief below in this case what is now quoted, in order that the prophecy at the end may be noted and a warning drawn from its quick fulfillment.

" The Edison Company in Canada was charged with " having imported and with not having manufactured, " lamps after the statutory periods.

" The charges were made before the Deputy Minis- " ter of Agriculture, who is not required to be learned " in the law, and is in fact, as counsel is informed, not " a lawyer by study or profession.

" The defense of the Edison Company was that they " had not imported '*the invention*,' for which their patent " had been granted, and which in the language of the " claim is: '*An electric lamp giving light by incandescence* " '*consisting of a filament of carbon of a high resistance* " '*made as described and secured by metallic wires as set* " '*forth.*' The facts proven were that the lamp consists " of various materials and elements—bamboo fibre " carbonized, glass, platinum, and some other me- " tallic elements; that labor is the principal ele- " ment in forming the lamp; that no lamp as a lamp " had ever been imported. But it was admitted that " glass tubes (in a form general in commerce), and " platinum wire (in a form dealt in for many " purposes), and bamboo fibre grown in Japan and " partially carbonized in the United States, had been " at different times, and separately, introduced for the " purpose of being employed in Canada to be made up " into lamps; and it was shown that the chief ex- " penditure and labor has occurred in Canada, where " the glass tube was blown into a new shape, the plati- " num wires were cut into lengths and fused into glass, " and where various other operations took place under " which these separate parts eventually became 'the " lamp,' which was 'the invention' named in the " patent.

" The judgment of the Deputy Minister, whose ac- " tion is by statute final, was, that '*the invention*' had " been imported, *because the essential elements* and parts " comprising 'the invention' had been imported. In " short, by this interpretation, which we can see will " not for a moment sustain the criticism of a legal mind,

" and will doubtless be corrected whenever the matter " is by *certiorari* or otherwise brought under judicial " consideration, an ' invention ' is ' imported ' whenever " material essential to its manufacture is imported.

" It is a circumstance not immaterial to be noted " that the hearing, accorded by the Canadian official " upon an alleged breach of the section cited above, is " one in which there is no power to compel the attend- " ance of witnesses, and no authority to administer " judicial oaths to them; and that no direct appeal " from a decision thus arrived at is provided by the " statute. Under such circumstances while the judg- " ment may be intelligent and just, it manifestly lacks " the customary guarantees of these conditions, and " possesses the outward appearance and inward pos- " sibilities of an arbitrary and irresponsible decree. It " is in fact an administrative order in the Russian " sense, and not a judicial judgment in our sense.

" It is now claimed that such a judgment, ricochett- " ing across the border, has power to put to an end an " American patent of great value.

" Such administrative errors are doubtless subject to " correction somewhere in the judicial system of the " Dominion of the Crown; from which it appears that " after an American patent should have been declared " ' expired ' because of the foreign forfeiture, *we might* " *see that forfeiture nullified and the foreign monopoly* " *reinstated.*"

Immediately following the decision by the Deputy Minister of Agriculture, an American Electric Lighting Company, whose United States counsel had appeared in the prosecution before the Canadian Department, obtained leave to file a plea in an action pending against them in the Circuit Court for the Southern District of New York, by the Edison Electric Light Company, upon its United States patent for the same invention. The plea set up the lapse of the Canadian patent for breach of the conditions subsequent of the Canadian statute, and that case is now understood to be at issue on that plea. In the meantime an appeal

was made by the Edison Company to the Governor-General in Council for a rehearing, and the examination of that petition led to the discovery that the Canadian Deputy who had heard the case and who signed it in his character of Deputy Commissioner of Patents, had never been commissioned as Deputy Commissioner of Agriculture, in which character alone could he entertain and determine such a matter.

The discovery of this defect in the jurisdiction caused notice to be sent by the Minister of Agriculture personally to the parties to attend for a retrial. By consent the evidence taken upon the former hearing was adopted, and the retrial consisted merely in restating the arguments upon both sides. On this occasion, the matter having assumed serious importance, the Minister of Agriculture invited the Minister of Justice, Sir John Thompson, an accomplished jurist, to sit with him. The hearing occurred in July; a decision was rendered in November, and it is accompanied by an elaborate examination of all the facts of the case by Sir John Thompson, on which he arrives at the clear conclusion that the Edison Company did *not* import "the invention," and that the work done by it in Canada *did* constitute a manufacture of the invention; and a judgment precisely contrary in all respects to that delivered by the Deputy Commissioner of Patents has finally been entered in this case. The case has been fully stated in public print and is referred to only as illustrating our argument.

Had the Canadian correction been delayed a little longer, judgment might have been pronounced in the Circuit sustaining the plea; and an appeal having been made to this court, that case would have been for the three years or thereabouts in which the appeal would have been pending, past all possibility of remedy—in the Southern District of New York at least; and in the

meantime the patent of Mr. Edison would be rapidly running to its conclusion!

Can it be doubted that courts will strain against interpretations of statutes which, without necessity, or benefit to any one, open the way to such frightful injustice?

We have appended extracts from a few foreign statutes, chosen in alphabeti cal order, from which may be gathered an arra yof conditions subsequent—not favored by our law—by which th e owner of every American patent thus issue d is imperiled through acts and omissions of foreign assignees over whom he has no control.

In addition to those quoted may be mentioned the law of Guatemala (Carpmael, p. 261, Article 15), by which it appears that patents lapse for a variety of causes, including, "if the products *are adulterated, proving inferior* to the specimens or models presented."

That is a condition which it is impossible for any one to follow and secure the performance of, from the United States.

The same may be said in respect to the decrees of forfeiture to be made by Governors of provinces and others, as shown in the citations in the appendix; as for instance the case of British Guiana, where a patent will become "void" and "cease and determine," if the owner of the patent declines to supply the patented article to H. M's. officers, on such reasonable prices and *terms* as may be fixed by the Governor!!

"12. All letters patent for inventions under this or-
"dinance shall also be subject to the further conditions
"that the same shall be void, and that the powers and
"and privileges thereby granted shall cease and de-
"termine, * * * also if the said instrument in
"writing deposited as aforesaid does not particularly
"describe and ascertain the nature of the said inven-

" tion, and in what manner the same is to be performed,
" and also if the said patentee, * * * shall not sup-
" ply or cause to be supplied for her Majesty's service in
" this colony all such articles of the said invention, as he
" or they shall be required to supply by the officers ad-
" ministering the department of Her Majesty's service in
" this colony for the use of which the same shall be re-
" quired, in such manner, at such times, and at and upon
" such reasonable prices and terms, as shall be settled
" for that purpose by the Governor."

Do any assignable reasons justify a statutory construction which brings with it these consequences?

The inconveniences, incongruities, absurdities, and possible frauds and oppressions possible under such a state of the law being manifest, it is time to inquire what ground of *reason* is suggested for choosing the first of Judge WALLACE's two readings of the statute (fol. 33), viz. :

> " that the exclusive right to the invention here is to cease with the exclusive right of the patentee in *any* foreign country." * * *

Thus in many countries, *e. g.*, Norway and Germany, a judgment against the *novelty or originality* of the invention results in an express revocation of the letters patent; and in some countries an entry is made in the public register that that patent is *no more a patent.* From this it is conceivable that a case should arise in which an American patent for an American invention should be upon trial be sustained here as new and useful, and yet be afterwards successfully resisted in its enforcement because of a later foreign judgment to the contrary, on those latter points.

And the foreign judgment might result, and the American patent fail, under the application of proofs, or of rules of law *which would be inadmissible here.*

For illustration, let us take the facts of the Bell Telephone, as proved in the records of the case reported in 126 U. S. Prof. Bell, having made simultaneously an application for a patent in England and here, was put into interference with Gray in the United States Patent Office. (The interference was, it is true, almost immediately dismissed, for reasons which have drawn the sharpest criticism upon the Patent Office official who acted in the matter). But let us suppose that this had not occurred, and that the two applications had been kept in interference—with the usual delay in issue.

In the meantime Mr. Bell had given to Sir William Thompson a telephone; and Sir William, returning to England, exhibited that instrument to the British Association, and attempted to explain it and make it talk,—which it would not do!

When the English patent was issued and brought to the test of hostile litigation, a strenuous attempt was made to defeat it on the ground of that *prior publication in England* by Sir William Thompson. The effect of Sir William Thompson's incautious action was avoided, however, and the English patent was saved, because it appeared that the diaphragm of one of the instruments was so bent by accident in transportation that it made the instrument inoperative, *so that it was not the real Bell telephone!*

Now, if Bell's American issue had been delayed by interference until after the English issue, and Sir William had straightened the bent diaphragm, Mr. Bell's prior English patent would have failed. Having thus failed the later American patent would have failed, because of a fact which does not by law of this country

constitute a defense to a patent, viz., the prior exhibition of the patented article!

This state of facts would also in Germany have constituted a prior publication; and would have resulted in a recorded revocation of the patent.

Did Congress intend such failures of foreign patents, when it referred to "terms,"—*and to the* "expiration" *thereof?*

The law of Peru (Supplement to Carpmael, p. 119) furnishes another example.

"ART. 12:

"Any persons who with justice consider themselves "interested are entitled to demand the nullity or cessa- "tion of a privilege.

"ART. 13:

"Patents are null, * * * * * *
"1. If the discovery, invention, * * * * "is not new——
"2. * * * * * * * * * *

"ART. 14:

"A discovery, invention * * * shall not be "deemed *new* if, in Peru or abroad, previous to the "date of the application it had sufficient publicity to "to put it in practice."

Now, our own law allows two years of public use, prior to application. It may be seen, therefore, that the following order of events might easily occur, resulting in the destruction of an American patent:

1. An application for a patent here, followed by public use, involving, of course, "that sufficient publicity" mentioned in the Peruvian law;

2. A Peruvian application followed promptly by the issue of a patent;

3. Allowance in this country, followed by an issue later in date than that of Peru;

4. A petition in Peru to the Fiscal Ministry, by some person who considers himself interested to have the patent "declared null or terminated" (Art. 17), on the ground of sufficient "publicity" in the United States, previous to the date of the Peruvian application, &c.

5. A Peruvian declaration of nullity or termination;

6. A judgment in the United States dismissing a bill for infringement, on the ground that the prior Peruvian patent had "expired," and, therefore, that the United States patent must expire; the *effective cause* being in both cases, *lawful public use in this country.*

Another absurd possibility might arise under the Austrian law. Austrian patents appear to be invalid when granted upon foreign inventions which are not at the time patented in the place of their origin (Austrian Law of 1852, § 3; Carpmael, p. 15). From this it seems to result that an American inventor, applying here first, and in Austria afterwards, but receiving the Austrian patent first, might *lose it*, because he had not at its date received his *American* patent; and he would then (on the defendant's theory) in due order lose his American patent as a proper punishment for having lost the *Austrian* one!

Expiration of Term.

The language of the statute is:

"* * * But every patent granted for an invention, which has been previously patented in a foreign country, shall be so limited as to expire at the same time with the foreign patent; or, if there be more than

one at the same time with the one having the *shortest term.*

Judge CLIFFORD has said that the words "the foreign patent" is used by Congress, "evidently referring to the *term* of the foreign patent."

And the limitation, taking effect at the moment of issue, is measured by the "shortest term" where there is more than one. Indeed there is no appearance of statutory authority for ending the domestic patent upon the lapse of any but the shortest term foreign patent. It may be that the annuities will be paid on that one and not on the longer term patent. Thus the appellee's interpretation leads to more difficulty. What shall be done if not the shortest term, but the longest term patent is the one which is not kept alive.

What is the signification of the word "term" in the law of conveyancing, and in the written law generally?

The phrase is one in common use, and is without exception, as we believe, understood to signify a time fixed. The cessation of rights granted to be enjoyed during that time is never understood to end the "term." The words "expiration of term," when applied to estates, the essence of which is time, were defined in the case of Oakley vs. Schoonmaker, 15 Wendell, 226. A clause of the Revised Statutes (N. Y. S., 513, Section 28, Subdivision 1) provides that certain officers may summarily remove a tenant in certain cases, the first of which is—

"1. Where the tenant held over after the 'expiration of his term.'"

The appellant Oakley had violated an agreement as to cutting wood, which was claimed to work a forfeiture of his term. The Court, by SAVAGE, C. J., NELSON, J., and BRONSON, J., concurring, said:

"This is not the expiration of the term referred

" to in the first subdivision of the 28th Section.
" The statute means expiration by lapse of time."

In Breach vs. Dixon, 9 N. Y., 35, the Court, in a similar case of breach of condition, said, " Oakley vs. Schoomaker, 15 Wendell, 226, is in point. That case holds :

" By the ' expiration of the term,' *a forfeiture by*
" *breach of condition is not meant*, and the deter-
" mination of that case is plainly right."

There is a usual form of covenant for surrender of leased premises, which is as follows :

" That the said lessee will, at the expiration or other sooner determination of the said term, peacefully surrender and yield up," &c. (Taylor's Landlord and Tenant, p, 59, No. 10, 4th Ed., 166).

The English Patent Act of 15 and 16 Victoria, Ch. 83, Sec. 25, contains a provision (entirely omitted from the British Act now in force) that domestic patents for inventions previously patented abroad shall cease and become void " with the expiration or *other determination* " of the foreign act.

Under this English patents were held to fail when foreign patents failed, by force of the " other determination " of the foreign term, and not because of its " expiration."

The German act (Sec. 19) provides for the registry of (1) the commencement; (2) the termination; (3) the expiration; (4) the decree of annulment; (5) the revocation of the patent. Thus it appears that according to German ideas a patent monopoly may come to an end in at least two ways without expiration of the term, (viz., by termination and by revocation).

" To terminate a thing " is, doubtless, a phrase signifying that an end is put to it; and it would be quite

correct to say of a patent, and of the monopoly under a patent, that it is "terminated;" by which would be meant that it has ceased and exists no more. But when the subject matter is the *term* of a patent, and that term is stated by naming a time for which the patent shall exist, it is not in accordance with accurate and discriminating use of language to say that the term has expired because the patent or monopoly has ceased to be operative.

Unless the idea and substance of what the former British statute calls "other determination" is to be found in the word "expire" as it appears in our statute, then there is no written law which affixes to the American ownership of a patent the penalty now sought to be enforced.

When, therefore, the sole object is declared to be, to attain certainty as the duration of a grant, and no other object has been suggested in any decided case (except in the case of Huber vs. N. O. Nelson, &c., Co., 38 Fed. Rep., THAYER, J., to be more particularly referred to hereafter)—the way is made clear. A definite term being in existence, to be referred to, that object is accomplished. From that point all suggestions which have an unsettling effect should not be favored; and all rules which help to maintain that certainty should be favored.

Apparently this Court recognized the necessity for certainty in determining the case of Bate & Hammond, and the opinion defends against any idea that judgment will introduce uncertainty, by saying—

> * * * "The time of the expiration of the
> "foreign patent may be shown by evidence *in pais*,
> "either the record of the foreign patent itself
> "showing its duration, or other proper evidence;
> "and it is no more objectionable to show the time
> "of the expiration of the foreign patent by giving

" the evidence of extensions such as those in the
" present case, and thus to show the time when by
" virtue of such extensions the United States pat-
" ents will expire."

Reading these words in the light of the facts to which they apply we understand the Supreme Court not to have disapproved of the controlling principle in respect to certainty laid down by Judge CLIFFORD, but to have said that certainty is attainable, in cases where the term is one which on its face has different points at which it may end, by giving evidence in pais whether or not it did in fact end at one of those limits, or passed on to the others.

" Terms " and " Conditional Terms."

It has been suggested in argument that a German patent issued under the law which has been quoted is from the beginning conditional as to the duratsin of its monopoly, and therefore that its term " is a conditional term." By this they mean that its term is not for fifteen years, but for such length of time as it may happen to last. It is for fifteen years, if so be, it lasts that long ; and it is equally for any other period of time at which the monopoly may in fact cease. If a year after its passage the law should be abolished, then, there being no means of enforcing penalty, it would be a one year patent. In short, it is said that the term being a term on condition is never definitely ascertainable until it is ended.

Apart from the inconvenience which the Patent Office would find in determining which of two foreign patents issued under such conditions has the shortest time ; and the utter confusion as to rights which it introduces, there are certain familiar principles which tend to neutralize the fallacy of this suggestion.

Patents and other like human contrivances for representing values which are constituted by expressions and declarations of intention, are to be construed if possible so as to preserve that which is valuable to the private owner and to the public. This is all the more true of legislation framed on public motives, to foster private efforts.

The limitation of rights by inherent and self-operative conditions is one matter, and the liability of a thing or an estate to be ended by something happening outside of itself is another matter.

That declared, artificial incapacity of a thing to survive an event, which event is certain to result from a defect in its original constitution (*ex. gr.*, the limitation of a British patent to fourteen years—beyond which it has under no circumstances, inherent power to pass), is different from a declared inability to survive another event which may not happen (*ex. gr.*, the possible refusal of the British owner to pay taxes),—which is to the patent a sort of external violence, which it may possibly evade, whereas it cannot evade the inherent condition.

Thus a gift to a woman during her unmarried life ends with her marriage by its constituent terms, but a gift to a woman for life to lapse upon her marriage, ends with her marriage, provided, and only if the provision is strong enough of itself be enforced. Depending on an uncertain event, it is a gift for life ; and other estates measured at their origin by its then existing term, would also be estates for life.

But again we repeat that what is needed, and all that is needed, for public ends or private interests, is certainty as to the duration of a grant; and the introduction of the idea of patents with conditional terms, begins to make trouble at the inception of the American patent, which continues without cessation throughout its life.

If, for insthnce a French patent for fourteen years and

a German patent for fifteen years shall issue on the same day (and with this same conditional liability to be ended at any moment by non-payment of taxes, etc.) which of those two patents has the shortest term? And if the French fourteen-year patent should be kept alive by payment of annuities, while the German fifteen-year patent is permitted to expire, will the American patent expire also? And if yes, how is it that it expires, not with the patent having the shortest, but with the patent having the longest original term? Was there a mistake about the limitation?

In short, Sec. 4487 implies that there must be——as a condition precedent to its taking effect at all—one or more prior foreign patents existing at the date of the U. S. issue; of which one or the other is then the "shortest;" and the fact in that respect must be ascertainable at that time—else the limitation required by our law has nothing upon which to take effect at that time.

The Coincident Monopoly Idea.

It has been suggested, though I think not in any decided case except the Missouri case just cited (THAYER, J), that the purpose of Congress in passing Section 4887, R. S., was to make sure that protection to American inventions should cease when prior protection therefor ceases abroad. Such a purpose, if it existed, has wholly failed of expression in the statute, and the suggestion is a mere guess.

But that argument proves too much, and is pregnant with its own refutation. No reason to support it can be suggested which is not equally applicable to all instances in which inventions are patentable here and in foreign countries *without reference to their respective priorities*.

Nor can any reason be suggested which would not

logically require that every invention held under monoply here should lose its protection if the owner fails to have it *similarly protected in every other country.*

If the existence of monopoly abroad is a reasonable condition of monopoly here for any case, it is indifferent whether the lack of it is due to the ending, or to the never beginning, of foreign monopoly. If there is reason why it should end here when it ends there, *pari ratione*, it should not begin here unless it begins there.

But, indeed, there is no such reason.

Why should Congress have such a policy? Let any rational man try to formulate a reason which shall contain something more than mere words. In what manner, adopting the narrowest and most selfish maxims for our guide, is the American people injured if the people of Germany are free to make and enjoy use of an article on which we must pay patent royalty? The patented article cannot be introduced here however cheaply it is made abroad.

The provision has its force solely as an arbitrary enactment, imitated, without thought, from foreign laws. It has no policy, or reason—and no effect except now and then to catch and ruin a deserving inventor—to dash from his lips the cup which is to reward his labors. And this it does only for the interest of those who lie in wait to reap where they have not sown.

It existed in the act of 15 and 16 Vict., but left out of the carefully considered new patent act of 46 and 47 Victoria.

We must not confound the tariff laws with the patent system, or import into the interpretation of the one motives and reasons solely applicable in the other. The promotion of science and the useful arts is the aim of one; and the regulation of international trade relations, of the other. If there were any policy in favor of freeing our people from patent royalties whenever other people are free, so that domestic pro-

duction should be put on competing terms, it is still the tariff laws and not the patent laws we would look to for this.

The spirit of this defense is not entitled to favor.

It seeks to apply a beneficent law, founded on the constitutional authority "to promote science and the useful arts," as a penal law inflicting penalties here for acts and omissions in other countries, many of which if done or omitted here would be innocent.

The statutory construction which the defendants offer is radically offensive to the reasons of convenience and policy expressed by Judge CLIFFORD, and taken in a sense as a chart in all succeeding cases.

To adopt this construction would be to the detriment of every legitimate patent interest, and beneficial only to those which cannot be avowed. It would serve only those who seek an unearned advantage, by the undeserved misfortunes of their neighbors.

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Of Counsel.

APPENDIX.

Name of Country.	Term.	Cause of Nullity or Lapse During Term.
ARGENTINE REPUBLIC.....	5, 10 or 15 years..... *Note.* No special decree of nullity or lapse is required. Art. 49.	All patents are null and void which come within five enumerated classes; patents also become void when not worked for 2 years; or for interruption of work for that period, and by "the expiration of the term" Art. 47.
AUSTRIA...	15 years.....	There are three causes which may bring about an expiration of the privileges, besides the natural expiration of the term by flux of time.
BARBADOES	7 years.....	Failure to work within 3 years.
BELGIUM..	20 years.....	Failure to pay annual tax.
	Note. The effect of this would be that if an application were first filed here, but afterwards an English and Belgian patent were filed in that order, the English patent would render the Belgian patent void, and the lapse of the latter would (according to complainant's idea) cause the American patent to "expire."	Failure to work within 1 year, not from date of patent but from date of any working abroad or ceasing to work for one year. Not being a patent of importation, having been previously patented abroad. Three other causes for declaring patent void, common to most patent laws.
BRAZIL....	15 years.....	Twelve causes, some of them difficult for a purchaser or even a patentee to be sure of, and including failure to appoint a legal agent in the Empire may end the privilege during the term. The last cause for lapse, "*When the term of the privilege* has expired."
BRITISH GUIANA...	14 years.....	The patent shall be void and the powers and privileges shall cease and determine: 1. If the patentee shall not within ten days record the letters in the Register's Office

APPENDIX.—*Continued.*

Name of Country.	Term.	Cause of Nullity or Lapse During Term.
		for the Counties of Demerara and Essequebo. 2. If he shall within six months from date of the patent file a clear and copious description, &c. 3. If he, his heirs, executors, administrators and assigns shall not supply or cause to be supplied for Her Majesty's service all such articles of the invention as he may be required by H. M.'s officers in such manner and at such time and upon such reasonable prices and terms as shall be settled for that purpose by the Governor. 4. If a certain stamp duty is not paid at the end of seven years.
CANADA.....	.....	28. Patent to be manufactured in Canada or to become void at end of two years, etc.
CANADA.	5, 10, 15 years.....	§ 17. When only partial fee is paid, patent expires at end of term for which fee is paid, unless before expiration further fee be paid.
CAPE OF GOOD HOPE.....	14 years.....	X. Patent to be void at expiration of 3 and 7 years, on non-payment of fee. IV. Patent void, if specification does not describe nature of invention. XIV. Patent void at expiration of foreign patent.
CEYLON.....	14 years	223. Has not exclusive privilege when invention is not fully described in specification. § 25. Exclusive privilege shall cease when the Governor with advice of Executive Council declare in the Gov. Gazette, that the invention is prejudicial to the public or mischievous to the State. Or

APPENDIX.—*Continued.*

Name. of Country.	Term.	Cause of Nullity or Lapse During Term.
		by breach of any special condition on which petitioner shall have been authorized to file a specification.
BRITISH HONDURAS.....	Not to exceed 14 years.....	XV. Shall become void at end of 3 and 7 years on non-payment of certain sum as per schedule. XXIII. Letters Patent for foreign articles expires with foreign patent. § 27. Patent void if specification too much or too little to obtain the purported end. § 28. For importation after one year. For non-manufacture within two years.
CHILI.....	10 years.....	ART. 3. Patent annulled for fraud.
COLUMBIA.....	5 to 20 years.....	Expires with foreign patent. ART. 12. A patent is void when practiced not for a year unless unavoidable circumstances shall have intervened.

These instances might be greatly extended to show what boundless uncertainty surrounds American patents of this sort, if the theory concerning their tenure, urged by the defendant, should prevail in the Courts.

BRIEF

OF

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A further argument arises upon the language of the statutes themselves.

The contest in England against the continuance of old and the creation of new monopolies by the exercise of the prerogative power, which tended to the abridgment of the freedom of trade, led to the passage of the Act of 21 Ja., 1, cap. 3, of the 2d of November, 1624, the 6th section of which authorized the granting of letters patent for "the term of fourteen years to be accomplished from the date of the letters patent."

This was the origin of all the Anglo-Saxon patent laws and became the basis of those of the United States. It introduced the word "term," and defined its "expiration" as the "accomplishment" of the fourteen years "from the date of the letters patent," and not otherwise. The effect of this definition upon the term granted has never been changed.

The word "term" is a derivative one, and comes burdened with the legal maxim of its origin "*terminus annorum certus debet esse et determinate*," and with the necessity that there should be *ab origine* a *terminus a quo* and also a *terminus ad quem*.

Section 8 of the Federal Constitution conferred the prerogative power upon Congress of "securing for limited times to inventors the exclusive right to their discoveries," and thus originated the distinction, which has ever since obtained, between the "limited time" or "term" and the thing granted, "the exclusive right."

Under this Constitutional power the Acts of Congress (April 10th, 1790; Feb. 21st, 1793) were passed, whereby letters patent were authorized to be issued "for a term not exceeding fourteen years," and a specification was required to be filed,

"to the end that the public may have the full benefit thereof after the expiration of the patent term." This was an adoption of the British "term" and a declaration that "expiration" meant "of the patent term," and not otherwise.

Pending these statutes, meritorious cases arose in both countries in which inventors failed to realize, during the allotted fourteen years, a just reward for their inventions, and in which, therefore, Parliament on the one hand (Liardet's Act, 16 Geo. III., c. 29) and Congress on the other (Evans' Patent, Feb. 7th, 1815; Eastman's Patent, March 3d, 1835), exercised their undoubted prerogative of extending the duration of such fourteen year patents for seven years more. Therefore, the legislative custom of extending such patent for the further term of seven years obtained, and was well understood in both countries and by both Governments.

Subsequently, and by the statute 5 and 6 Will. IV., c. 83, s. 6 (Sept. 10, 1835), the Judicial Committee of the Privy Council were authorized, after due advertisement, to examine and report that a further extension of the term should be granted, and thereupon a further extension "for the term not exceeding seven years" was authorized "after the expiration of the first term," if the application therefor was made and prosecuted "before the expiration of the term originally granted."

Congress followed the example thus set by England, and by Section 18 of the Act of July 4th, 1836, authorized the Secretary of State, the Commissioner of the Patent Office and the Solicitor of the Treasury, after due advertisement, to entertain an application for an extension of a patent, and if it were just and proper, to "extend the patent for the term of seven years from and after the expiration of the first term," provided that no extension of a

patent should be granted "after the expiration of the term for which it was originally issued."

The origin and definition of the words "term," "extension" and "expiration of the term" are thus shown for all the purposes of the patent acts, and the original meaning adheres and attaches wherever the words are used. It results, therefore, that "expiration" means the termination of the original grant by the efflux of the time therein specified.

By the 16th section of the Act of March 2d, 1861, it was enacted that all patents hereafter granted should remain in force for the term of seventeen years from the date of issue, and all extensions of such patents were thereby prohibited. Speaking of this section in Siemens *vs.* Sellers (123 U. S., 285), the Supreme Court said:

> "This right of extension was attended with many inconveniences and much expense to meritorious patentees, and Congress, by the Act of 1861, cut it off and made the term of all patents seventeen years—a compromise between fourteen and twenty-one years."

This remained the law until the 25th section of the Act of 1870, which, in the language of the Supreme Court (123 U. S., 284), was "substantially carried forward into the Revised Statutes, Section 4887."

Revised Statutes, Sec. 4887:

To correctly appreciate this point requires that the nature of a patent should be observed. It is of a dual nature. The statute says it is "a grant to the patentee, his heirs or assigns, for the term of seventeen years." This is its first feature—the grant of a term of seventeen years.

The second feature is the exclusive right to make, use and vend which it creates.

Waiving the question which is still open in the Supreme Court of the effect upon this section of the prior filing of the American application, the effect

of the section remains to be considered when a given state of facts is presented, which has never yet been presented to the Supreme Court, and which makes the present case, therefore, different from any case that that tribunal has yet decided. As the plea in this case sets up the alleged expiracy of two patents—a French and a German one—the case is brought within the second contingency specified in Section 4887, and there is therefore no escape from a judicial construction of the word "term."

There ought not to be any doubt as to the proper interpretation to be given to the words "expire at the same time with the one having the shortest term." They should be given the same interpretation as substantially the same words have been given by Congress in the previous Acts above referred to.

In Claflin *vs.* Commonwealth Insurance Co. (110 U. S., 81), the Court said:

> "We are bound to take the words of the law in their usual, ordinary, literal meaning, and to construe the two provisions in the different sections in the same sense which, in previous statutes, had uniformly been given to them, and not invent a new application and relation of the two clauses without any indication whatever of any intention on the part of Congress to that effect."

Congress said that when there was a previous foreign patent the American patent should in no case be in force more than seventeen years. Con- [illegible] that under foreign patent laws the for was made and prosecuted before the expi- tion of the term originally granted."

Congress followed the example thus set by England, and by Section 18 of the Act of July 4th, 1836, authorized the Secretary of State, the Commissioner of the Patent Office and the Solicitor of the Treasury, after due advertisement, to entertain an application for an extension of a patent, and if it [illegible] to "extend the patent for the

Russia	10	"
Spain	15	"
Prussia	12	"

But Congress also knew, as has been shown, that under the foreign law the original term might be extended for seven years. Congress, therefore, intended that the American patent should have the benefit of so much of the extended term as might give the full period of seventeen years to the American patent by saying "and in no case shall it be in force more than seventeen years," which duration it could not possibly have had if it had expired with the original term of ten, twelve, fourteen or fifteen years of the foreign patent.

This again illustrates the rule that the definition of the word "expiration" or "expire" as used in reference to foreign patents means the termination of the statutory grant by the efflux of the period therein mentioned, saving always the American limit of seventeen years, and not the cessation of the exclusive right if otherwise occasioned.

Congress also knew that the foreign laws provided that for a breach of a condition subsequent, such as a failure to pay an annual tax or to manufacture or to keep up the sale within the given country, the inventor could be cut off from enforcing his rights. Congress knew this for it had done the same thing itself, and it intentionally omitted in 1870 and in Section 4887 to visit the foreign and local penalty of curtailment upon the American patentee.

To correctly appreciate this point requires that the nature of a patent should be observed. It is of a dual nature. The statute says it is "a grant to the patentee, his heirs or assigns, for the term of seventeen years." This is its first feature—the grant of a term of seventeen years.

The second feature is the exclusive right to make, use and vend which it creates.

The two are not inseparable or indissoluble.

The patentee may convey his exclusive right or he may convey the patent grant. He may sell the ex-

clusive right for ten years or more or less and then die. The patent grant will go to his personal representative and the exclusive right would remain in its owner, and on his death during the term would go to his representatives.

The patent grant may be seized and sold on execution and the purchaser would get the parchment but not a right to make, use or vend.

A receiver or a State assignee in bankruptcy may take and sell the parchment, but the purchaser does not get a right to make, use or vend.

Stephens *vs.* Cady, 14 How., 528.
Stephens *vs.* Gladding, 17 How., 448.
Gordon *vs.* Anthony, 16 Blatch., 234.
Ashcroft *vs.* Walworth, 1 Holmes, 152.
Agar *vs.* Murray, 105 U. S., 128.

These illustrations show that there may be two owners, one of the patent grant proper and the other of the whole or less of the exclusive incorporeal right, and therefore that Letters Patent are of a dual nature—a grant of a term and a creation of an exclusive right.

So also a patentee may sell for a sum in gross the exclusive right to make and vend. He may also grant an exclusive right to use. If he did both, he would still remain the owner of the patent. The proprietor of the exclusive right to make and vend might abandon that right to the public. If he did, such abandonment would not affect the patent nor the exclusive right to use.

This distinction is recognized in the French law (Record, p. 7) and in the German law (Record, pp. 9 and 10).

It is also recognized in the Act of Congress of July 13th, 1832, which uses these words:

"*Every patent granted by virtue of this Act and the privileges thereto appertaining,* shall be and become absolutely void."

Foreign laws are facts, and in the absence of proof our Courts will presume that the foreign law is the same as our own.

The failure to comply with a condition subsequent does not, under the American law, affect the patent grant of the term, but only the right to the exclusive privilege.

By Sections 14 and 15 of the Act of July 4th, 1836, a patentee was authorized to bring an action for damages for a violation of the exclusive right secured by the patent, and Section 15 said:

"That the defendant in any such action shall be permitted to plead the general issue and to give this Act and any special matter in evidence * * * tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention, * * * or that the patentee, if an alien, at the time the patent was granted had failed and neglected, for the space of eighteen months from the date of the patent, to continue on sale to the public on reasonable terms the invention or discovery for which the patent issued, * * * in either of which cases judgment shall be rendered for the defendant, with costs."

So that under the American statutes, which provide for a compliance with a condition subsequent, the breach of such condition did not go at all to the term of the patent, but only to the right of the patentee to enforce his exclusive privilege. In the absence of any evidence that the foreign law is different from our own in this regard, such effect and such only, should be here given for the failure to comply with a condition subsequent under the foreign patent law.

This same distinction between the patent grant, and incorporeal right which it creates, marks the English Patent Act, and the remedy which it gives for a breach of a condition subsequent is precisely that which was given by the Act of 1836 for a similar failure. The English Act says:

"The term limited in every patent for the duration thereof shall be fourteen years from its date.

"But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times."

What this "ceasing" practically is, is shown by the Act:

1. Neglect to make the payment may be condoned by the Comptroller.

2. And then the Act says that

"If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall see fit, refuse to award or give any damages in respect of such infringement."

This is permissive and not mandatory—is in discretion—gives the plaintiff a right of explanation to the Court, and establishes that it is not the patent grant which is affected by the non-payment, but the incorporeal right only, as under the Act of 1836.

The Canadian law provides that

"The defendant in any such action may specially plead any defense or default which by this Act or by law would render the patent void, and the Court shall take cognizance of that special pleading and of the facts connected therewith and shall decide the case accordingly."

This shows that notwithstanding the default which renders the monopoly void the patent grant survives and may be sued upon, and that the avoidance must be pleaded as under the Act of 1836.

Article 4 of the French law provides that every patent shall be subject to the payment of a tax as follows:

"This tax shall be paid by yearly installments of one hundred francs, under the penalty of forfeiture if the patentee allows any year to elapse without paying the tax."

Article 32 provides as follows:

"An action for annulment or an action for forfeiture may be brought by all persons interested therein. These actions * * *

shall be brought before the Civil Tribunal of the First Instance and before the tribunal of the domicil of the owner of the patent. The case shall be examined and decided in the form prescribed for summary matters by Article 405 of the following articles of the Code of Civil Procedure. Whenever the absolute annulment or forfeiture of a patent has been pronounced by a judgment or final decree, notice shall be given to the Minister of Agriculture or commerce and the annullment or forfeiture shall be published in the form prescribed by Article 14 for bringing patents to public notice, that is, by Royal ordinance inserted in the Bulletin des Lois."

The result of the non-payment of the yearly tax is a penalty of forfeiture. This is different from the annulling of a patent, but both the annulment and the forfeiture require, in order to render them efficacious, that an action should be brought in the designated tribunals and be by them decided before any result follows in France from the failure to pay the tax.

The "penalty of forfeiture" arising from the non-payment of the tax has no effect under the French law upon the patent grant.

What the effect is of such non-payment under that law is specifically stated in Article 32 above quoted, as follows:

"The following shall be deprived of all their rights: (1) The patentee who has not paid his annuity before the beginning of each year of the term of his patent."

This result does not affect the term of the French patent, but simply deprives the patentee of the right to enforce his monopoly thereunder, if any one chooses to contest such right. The patentee is not deprived of his right to his possession of the parchment granted term. That remains undisturbed, and may be enforced as here unless the defendant sets up the forfeiture or brings an affirmative action for annulment.

The German law provides that—

"The duration of a patent is fifteen years. A patent lapses if the patentee fails to pay the fees within three months, at the latest, after

they have become due. A patent can be declared void after the expiration of three years if the patentee fails to work his invention in Germany to an adequate extent or at least to do everything that is necessary to its being worked."

Under this statute the lapsing of a patent is simply a failure of the right to enforce the exclusive privilege. The declaring a patent "void" is a judicial act, and when performed is of no wider effect than a judgment of a Federal Court, reaching, as such judgments frequently do, the declaration that a patent is "void."

Thus, in Western Co. *vs.* Ansonia Co. (114 U. S., 453), the opinion of the Court concludes:

"The result of the views expressed is that both the patents sued on are void."

In Wood Paper Pulp Co. (23 Wall., 596), the language of the Court is:

"The reissued patent, No. 1448, is therefore void for want of novelty in the manufacture patented."

And again on page 599:

"Both the reissues, therefore, we think are void."

This does not mean that the term of the American patent is thereby terminated, but it simply means that on the case so arising the Court reached the conclusion that the monopoly right is void, leaving the patent untouched both as to point of ownership and possibility of further enforcement against any one ignorant of the former defense, or as against him if new evidence should show that such former defense was untrue in point of fact. No larger signification should therefore be accorded to a judgment or decree under the foreign law than that the monopoly becomes void and that the right to enforce it becomes void by reason of the neglect to pay the tax. Presumably, in the absence of counter-proof, the foreign laws are as our own, and if they are, the foreign patentee may bring his

action, and unless the plea sets up the non-payment of the tax or the failure to manufacture, he would be entitled to recover.

This view is sustained by Article 32 of the French law, which says as follows:

"The following shall be deprived of all their rights: (2) The patentee who has not worked his discovery or invention in France within the term of two years from the date of the signature of his patent, or has ceased to work it during two consecutive years, unless in case of one or the other he justifies himself as to the causes of his inaction."

This establishes the right of the patentee to sue upon his patent and to present such justification. If he fails, the result does not affect the term of his patent but only deprives him of his right to enforce the monopoly. Therefore, the patent grant does not, *ipso facto* and *per se*, terminate by reason of the failure to work the invention for two years, but such failure merely temporarily suspends the right of enforcing it.

It results, therefore, that the "term limited for the duration of the" Canadian "patent," which "shall be fifteen years"; for the duration of the English "patent," which "shall be fourteen years from its date"; for "the duration of the French patent, which shall be five, ten or fifteen years"; for "the duration of the" German "patent, which is fifteen years, the term commencing with the day following the day of application," is recognized under the foreign law as a distinct grant from that of the exclusive privilege, and that it is such privilege and not such grant which lapses or is declared void by a failure to pay the tax or to continue the manufacture.

The Canadian Act uses the words "shall expire," "to cease," "become null and void" and "be adjudged to be void."

The German law uses the words "termination," "expiration," "annulment" and "revocation."

The English law uses the words "expiration of the term," "cease" and "revocation."

The use of these various words is persuasive evidence that each one refers to a different act or fact, and therefore that they are not synonymous, and that the use of the words "expire," "expiration," and "expiration of the term" means the termination by the efflux of time of the period expressed in the grant; and such also would seem to be the proper interpretation of the words in Section 4887, "as to expire at the same time with the foreign patent, or if there be more than one with the one having the shortest term." The foreign grant alone expresses the "term," and Section 4887 speaks of it *in præsenti* and as having at the moment of the issuance of the American patent a then expressed duration which *eo instanti* applies to the life of the American patent and attaches thereto until such term "expires." That this is the proper construction is shown by the last clause of the opinion in Bate Co. *vs.* Hammond (9 Sup. Ct. Rep., 229).

If the effect of the failure to pay the annual tax or to manufacture within the realm, or of importing within the realm, is *ipso facto* to kill the foreign patent, then such effect is a penalty. Its result is that it deprives the patentee of his property as a consequence of his doing or not doing a designated act. It is a punishment inflicted by the government for not doing that which it requires. Such act affects only such government and its citizens. Our law confines the punishment for such wrongs exclusively to the country which is injured and the Federal Courts will not assist in enforcing it (Wisconsin *vs.* Pelican, 127 U. S., 267; De Brimont *vs.* Penniman, 10 Blatch., 441).

A foreign sovereign who has a demand of a civil nature against any person here may prosecute it in our Courts (11 Wall., 167). If, therefore, a foreign government found its patentee here it might sue him to have the foreign patent declared void for non-payment or non-manufacture or mal-importation in accordance with its law, and if it brought such suit it would be defeated because the penal laws of a country do not extend beyond its own territory and cannot be enforced by the Courts of another country (*Id.*).

A fortiori, will not our Courts enforce the foreign penalty against an American citizen claiming under an American patent, and punish him for the breach of a condition subsequent under the foreign law of which he was presumably ignorant and which he had no right to prevent. That which could not be directly gained by the foreign government cannot be gained by indirection by declaring, as against an American citizen, an American patent to have terminated by reason of a violation of a foreign penal statute.

The word "term" as used in Section 4887 is the same word as is used with reference to leases both in the instruments themselves and in statutes referring thereto. Thus, for illustration. the statute of New York (1 R. S., 514, Sec. 28, subdivision 1), provides that certain officers may summarily remove a tenant in certain cases, the first of which is where the tenant holds over after the expiration of his term. The appellant Oakley had violated an agreement as to cutting wood which was claimed to work a forfeiture of his term. The Court (15 Wend., 226), by Savage, Nelson and Bronson, JJ., said:

"This is not the expiration of the term referred to in the first subdivision of the 28th section. The statute means expiration by lapse of time."

In Beach *vs.* Dixon (9 N. Y., 35), the Court of Appeals in a similar case said :

"Oakley *vs.* Schoonmaker, 15 Wend., 226, is in point. That case holds by the 'expiration of the term' a forfeiture by breach of a condition is not meant, and the determination of that case is plainly right."

Is the analogy applicable to a patent "term"?

In Russell *vs.* Ledsam (14 Mees. & Welsby, 581), the original patent for fourteen years was issued on the 26th of February, 1825. A renewal was granted on the 26th of February, 1839, and the objection was taken that the renewed patent was issued after the expiration of the original patent. The Court said :

"The question is whether the day of the date of the first letters patent was inclusive or exclusive. In this case the question is when the term given by the patent commences, and the same rule would apply as to the commencement of a term which, if it is to run from the date of the lease, includes the day of the date. If so, the date would be included and the patent would expire at midnight on the 25th of February, 1839."

Johnson *vs.* McCullough, 4 Fisher, P. C., 172.

Johnson *vs.* Onion, 3 Hughes, 290.

The true judicial view would seem to be as stated by the Supreme Judicial Court of Massachusetts in Farnum *vs.* Platt (8 Pick., 338). One Garlick leased a marble quarry for ten years. He sold the realty on the 14th of September, 1822, to Farnum, the plaintiff, by a deed which contained the following clause :

"Reserving also the use of the quarry until the expiration of the lease I have heretofore made."

The lease was subsequently and on the 5th of October, 1822, cancelled by consent of the parties thereto. Garlick's supposed right in the quarry was thereafter sold to the defendant, and the action was by Farnum against him in trespass for passing

to and from the quarry to work it. It was contended by the plaintiff that the reservation was only till the expiration of the lease and that when the lease terminated by the agreement of the parties all Garlick's rights under the reservation ceased. The Court said :

"This lease, or agreement which had the effect of a lease, was by consent of all parties to it cancelled after the execution and delivery of the deed to Farnum, and he contends that, on such cancellation, he held the land under the deed, free from the right secured by the reservation. We do not think this is the true construction of the reservation, but that its effect was to exclude from the operation of the grant the use of the quarry by Farnum during the time provided in the agreement for its continuance. This is the most natural construction, and such as was intended by the parties at the time. The words 'until the expiration of the lease' mean until it shall expire according to the terms of it, and not the termination of it by a new agreement between the parties to it. And the reservation enures to the use of the lessor as well as the lessee; *for it saves the quarry from the operation of the deed, for the time, as much as it would if the reservation had been for the unexpired time, without any mention of the lease.* Therefore, Garlick or those lawfully holding under him, would not be liable in trespass for taking stones from the quarry."

The words in italics are illuminating as well as instructive.

If these views commend themselves, then it results that an American patent is not in any way affected by the "lapsing," "ceasing," or "voiding" of a foreign patent in a foreign country as a result of a failure there to pay taxes, or to manufacture the thing patented or as the result of mal-importation.

CLARENCE A. SEWARD,
J. M. DEUEL,
Of Counsel for Plaintiff.

December, 1889.

I. L. PULVERMACHER.—Interlocutory Appeal.

"I am not prepared to say that the applicant is compelled in his reissue, or disclaimer, to discard the subject of that English patent which has been forfeited by the non-payment of the tax required by the English law. The provision of our statute which declares that every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with a foreign patent, appears to alone create a limitation as to the full prescribed term, without regard to local laws upon which matters may arise after such term has commenced to run, affecting (temporarily, perhaps) its continuance."—10 O. G., 3.

U. S. *ex rel.* KOECHLIN *vs.* MARBLE, 22 O. G., 1366.

"An inventor taking out a patent in the first instance in this country is entitled to a seventeen year's protection; but if he has previously obtained letters patent in one or more foreign countries, then, while not deprived of his right to a patent here, the term to which the law in such case limits his protection is a period not extending beyond the date of the expiration of that one of the foreign patents first expiring."

Supreme Court of the United States.

CARL POHL and CHARLES ZOLLER,
Appellants,

vs.

THE ANCHOR BREWING COMPANY,
Respondents.

In addition to the briefs presented on behalf of the appellants in this case the Edison Electric Light Company, in view of the vast interests involved in this controversy, begs permission to submit the following brief :

I.

The plea in this case avers that prior to the time of granting letters patent to the appellants under our patent laws the invention had been patented under the laws of France, and of Germany, by letters patent issued respectively on the 3d, and on the 6th days of September, 1877, for terms of fifteen years each ; and that the patent issued from the American office to appellants for seventeen years was subject by its provisions to the limitation prescribed by Sec. 4887 of the Revised Statutes, by reason of such French and German patents (see Exhibit A, page 4 of Record).

Under the provisions of said Section 4887, there being more than one foreign patent, only that one of these foreign patents "having the shortest term" is of any importance to the question presented in this case; for the term of the American patent must be limited to such "shortest term," unless that term exceeds seventeen years, in which case the *term* is to be seventeen years.

Hence, under Sec. 4887, the term of the American patent is ascertained and fixed *by law*, upon the condition of things actually existing at the time of the granting of the American patent, and not at some future time upon the happening of some future accident or event.

The grant of the American patent is for a definite term ascertained or ascertainable at the time it issues upon the then existing facts and is for the full term that can be enjoyed by virtue of the right conferred by the then controlling foreign patent. Therefore, the moment it appeared that by the foreign patent having the shortest term the right of enjoyment was granted for a term of fifteen years from the date of its issue, *the term* of the American patent became a definite and fixed period for the unexpired portion of such fifteen years.

II.

If this be not so, then where there are several foreign patents there can be no possible mode of accurately determining which of the several has "the shortest term" within the meaning of the statute. All is afloat upon a sea of uncertainty. There *can be* fifty foreign patents. Suppose there are, in fact, twenty having unexpired terms ranging from ten to fifteen

years? If the one of the twenty having "the shortest term," is not to be definite and fixed *upon then existing facts* in order to establish the term of the American patent at the time it issues, then it necessarily follows that the "*term*" of the American patent is a shifting and variable quantity dependent upon some future incident that may happen to any one of the twenty foreign patents terminating the rights of enjoyment under it. The one having the longest apparent term of the twenty may be the first to be forfeited or destroyed by non-payment of fees or failure "to work the patent" as required by the law of its home. That one becomes, then, the one "having the shortest term," if the statute means the cutting short of a term by subsequently accruing accidents or events, that may work forfeiture of enjoyment under the foreign patent. The Commissioner of Patents has ruled (and such is the practice) that it is not necessary to define in the American patent, the limitation of the term under Sec. 4887, but that it may be in form for seventeen years, which term the statute cuts down to the shortest term of any general foreign patent then existing.

But we respectfully insist that the statute (Sec. 4887) means nothing of the kind claimed by our opponent. It means that the patent issued under its provisions shall be for a full term of seventeen years, as provided by our laws, unless the invention has been *previously* patented in a foreign country for a less term, in which case the term of the American patent shall be measured by the remainder of the term for which the foreign patent was granted upon its issue, or if several foreign patents have been granted, then by the remainder of the shortest term for which any one of such patents was granted. This construction makes the statute definite and certain under the maxim that that is definite and certain which is capable by its own language of being made so. It enables the

patentee, and our Commissioner of Patents to understand definitely what is granted and what is acquired upon the issue of the American patent; and does not subject the American patentee to consequences over which he may have no control, that may afterwards accrue to the foreign patent by the neglect, misconduct or *hostility* of its owner. And it respects the established rule of construction; that all penal laws must be strictly construed, and nothing can be implied "for the purpose of imposing or extending a penalty."

Bonell vs. Griswald, 80 N. Y., 128, and cases there cited.

III.

The construction claimed by the respondents of Sec. 4887, requires the Court to interpolate in the statute a provision that expressly subjects the term of the American patent to every provision of law of the foreign country by which the foreign patentee may lose or forfeit his rights of enjoyment for the full term of the patent in that country by reason of future failures to comply with or perform some duty or act which such foreign laws impose upon him as a subsequent condition of future enjoyment. But Congress had no such intent. In limiting the *term* of the American patent by the shortest term of a foreign patent, it merely intended to substitute one fixed and certain period of time for another, to wit, the remainder of an existing foreign term, for the fixed and definite term which our general statutes would grant in the absence of such foreign term. There was no intention to subject the substituted term to the laws of the country which had created the patent; nor to impose upon the American grant any forfeiture which the foreign laws had then or might thereafter impose upon its patent.

Such a construction would inject into the American patent, conditions and limitations which would render it substantially worthless. There is no policy of principle which requires it, for how is it of the least importance that our Government in granting a patent for an invention which it adjudges to be useful and meritorious for our country, shall concern itself at all with a question of the continued operation of the invention in a foreign country, or with a question of taxes or annuities to be paid to such foreign country.

Why should it subject its own patentee to a loss of his patent here, for some neglect or omission to obey the requirement of a foreign statute, whether or not he has any interest in or control over such foreign patent; or if the American patentee owns the foreign patent but finds it of no value there, then why should he be compelled to maintain and work at loss an unprofitable patent abroad or forfeit his valuable American patent; or suppose the invention to be patented in numerous countries, each patent dependent upon its own laws, why should our country destroy its patent because in the one from which it takes its measure of term, the patent may be forfeited for some neglect, while the patents of all other foreign countries remain in full vigor? These questions only address themselves to matters of public policy, but they may be rightly considered when the construction claimed for a statute operates to import and attach to American patents conditions of foreign law which Congress has not chosen to adopt and enact.

IV.

It cannot justly be supposed that Congress, in enacting Sec. 4889, intended to subject the American patents

to be issued under its provisions, to the laws of any foreign country so that the rights of the American patentee under his patent shall be at all times at the mercy of foreign laws and foreign owners or assignees who may be interested and intensely anxious to destroy the American patent.

On the contrary, Congress intended to give to the patentee under its laws proprietary rights (of immense value in some instances), and to measure the enjoyment of them for a definite and declared term, made certain in each instance by an existing fact, to wit, the unexpired term of an existing foreign patent. It intended a certainty and not an uncertainty; and, therefore, not to import into the measurement of the term the incertitude of foreign statutes that may exist to-day and to-morrow be repealed; or the adjudication of courts that might assert the enjoyment of a term forfeited or lost for violation of conditions subsequent, or other causes in which Congress or the country has no interest, and over which, no control.

It is undoubtedly true that France and Germany have absolute control over their own patent laws. Either of them may repeal, modify or change them at its own pleasure at any moment. Suppose they shall see, fit in wisdom or folly, to abolish all patent laws and enact that hereafter there shall be no monopoly by patents in those countries. Of course the patents named in the plea, having in such case no law to sustain them, would wholly cease; but what effect would that have upon the American patent issued before the repeal under Section 4887 of our statutes. None whatever, we insist, for the American patent does not depend upon the continued existence of foreign laws, although when issued it took its *term* from a then existing patent under such laws. The question would remain as it now is; what was the then existing term of the foreign patent which was to dictate the term of the American patent; that fact

once ascertained and applied cannot be changed by any subsequent contingency even though it be the abolition of all patents and patent laws in the foreign country. Or, instead of abolishing the statutes, suppose the foreign country shall enact that all patents granted for fifteen years shall be patents for twenty years. Would such a law enlarge the term which existed when the American patent was granted, and make it seventeen years under the ultimatum of Section 4887? Or would it leave the term just as adopted when the patent issued? Clearly the latter, because the term was a definite period when adopted by force of our statute and not to be diminished or enlarged except by the laws of the United States properly enacted.

This construction makes the term fixed by our statute, a definite and certain one. It enables the patentee and the patent officials to measure with accuracy what is granted and what is acquired, and does not subject the American patent to consequences over which the patentee may have no control, to prevent or avoid.

This construction is the only safe one for American patentees. The other construction turns the batteries of all enemies of the American patent, not to legitimate contests in American courts, but to a base guerilla warfare in foreign countries wherever patents for the invention have been issued to destroy the foreign patent by forfeiture or some violation of foreign law; which they can by fraud or otherwise, without difficulty, accomplish. In Germany "*A patent lapses if the patentee renounces the same*" (see Carpnael's P. Laws, p. 208). What hinders the owner of such a patent *renouncing the same* for the express purpose of killing the American patent? If it had been the purpose of Congress to create such a condition of things there would be no ambiguity in the language of the section.

V.

The word term, when used in a grant, demise or lease, is as fixed and definite in its meaning as any word known to the language of the law. It means the space of time between a definite beginning and end; and nothing short of the complete efflux of that period satisfies the legal sense of the word. Whatever arrests the efflux of the time never terminates the term, or causes it to expire, though it may physically destroy its subject or lawfully or wrongfully prevent its enjoyment.

It, therefore, necessarily follows that where the term of one grant or demise is measured by an existing term of another, the destruction of the measure by any cause short of the expiration of the period named, has no legal effect upon the thing measured—that is, the term of the second instrument. For illustration: If the owner of an apartment house leases apartments to A for a specified term, and then leases to B other apartments "for *the same term* as those leased to A," such term to expire at the same time with A's term, there is no doubt that B can hold for the full term of A's lease whatever may happen to terminate A's right of enjoyment of his full term.

A may surrender his lease—he may forfeit it by nonuser; or by using the property for some forbidden or unlawful purpose; or by violation of its covenants; or be turned out for non-payment of rent; or by the judgment of a court; or any other imaginable ground—yet A's term, as a definite unchangeable measure of B's term, remains as inflexible as though none of those things had happened. The same rule for the same reason is applicable to this case, and that, we think, was the manifest intention of Congress.

VI.

But it is claimed (and that is the chief argument of our antagonists) that this Court in the late case of Bate vs. Hammond has given a different construction to Section 4887. The Court below so read divers detached sentences of the opinion in the Bates case (separated from their context, or not read in the light of the question then under consideration) and regarded itself bound by their supposed effect to construe the statute contrary to its own judgment. But with all deference, we submit that the case now under discussion was not presented by the Bate case, nor involved in any question then considered and decided. The question in that case was whether the *term* of a foreign patent included the entire period of time which by the statute under which it was issued the patentee was *entitled*, as matter of legal right to take and enjoy ; or was limited by the language of the instrument which referred to the statute without setting forth the legal rights of the grantee under it, The Court held, in legal effect, that the statute of Canada was to be read with the patent for the purpose of ascertaining the actual TERM of the patent ; and having thus ascertained the term, Sec. 4887, made that term (15 years in that case) *the term* for which the American patent was issued. There can be no doubt as to what was really intended to be decided. The Court used the phrase expiration of patent, in some instances where it intended to speak of *the expiration of the term of the patent*, and out of this inadvertence it is urged that the Court intended to hold that whenever by forfeiture or default of the foreign patentee or owner of the patent, he should lose the right of enjoyment of the patent, that loss would change the term of an American patent from that which existed when such patent was issued to the period when the forfeiture accrued. That the

learned Justice who pronounced the opinion had no such thought in his mind is sufficiently shown by the fact that the question of the case was not *one of the effect of a forfeiture*, but of the effect of an enlargement by operation of a statute of a term to fifteen years in lieu of the five only appearing on the face of a patent issued under it.

It is respectfully submitted that the judgment of the Court below is erroneous and should be reversed.

NOAH DAVIS,
Of Counsel for The Edison Electric
Light Company.

Office Supreme Court U. S.
FILED
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JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States.

CARL POHL AND CHARLES ZOLLER,
Appellants,

against

THE ANCHOR BREWING COMPANY,
Appellee.

BRIEF FOR APPELLEE.

WILLIAM J. TOWNSEND,
For Appellee.

Evening Post Job Print, New York.

Supreme Court of the United States.

CARL POHL and CHARLES ZOLLER,
Complainants and Appellants,

AGAINST

THE ANCHOR BREWING COMPANY,
Defendant and Appellee.

Brief for Appellee.

STATEMENT.

The issue is made upon the bill of complaint and the defendant's plea thereto.

The bill of complaint alleges:

1st. That Letters Patent of the United States No. 213,447 were issued to the complainant Carl Pohl, March 18, 1879, for an improvement in barrel and cask scrubbing machines, a copy of which Letters Patent is annexed to the bill of complaint.

2d. That such Letters Patent were issued "subject to the limitation prescribed by section 4887 of the Revised Statutes, by reason of German patent dated September 6, 1877, and French patent dated September 3, 1877,

copies of which Letters Patent, translated into English, are annexed to the bill of complaint.

3d. That the complainant Charles Zoller has an interest in the Letters Patent, as assignee of Carl Pohl, the patentee.

4th. That the defendant has infringed Letters Patent No. 213,447 by using machines containing the improvements described in said Letters Patent, to the injury of complainants.

The defendant, without making answer to the bill of complaint upon the merits, pleads—

1st. That the German Letters Patent, referred to in the bill of complaint, were issued to the complainant Carl Pohl, September 6, 1877, prior to his application for the United States Letters Patent No. 213,447, and were for the same invention as therein described.

2d. That in the year 1880 the German Letters Patent became and were forfeited, by reason of the failure of the complainant Pohl to pay the annuities, and to work the invention in the Empire of Germany, as required by the law of May 25, 1877, subject to the provisions of which said German Letters Patent were issued.

3d. That the Letters Patent of France, referred to in the bill of complaint and cited in the United Letters Patent, were issued September 3, 1877, also before the application for the United States Letters Patent No. 213,447, and were for the same invention as therein described.

4th. That the said Letters Patent of France also became and were forfeited by reason of the failure of the complainant Pohl to pay the annuities and to work the invention in France, as required by the law

of July 5, 1844, subject to the provisions of which said Letters Patent of France were issued.

5th. That by reason of such forfeiture in Germany and in France, the said United States Letters Patent No. 213,447 expired, and the term thereof ended prior to the time of the commencement of this action, under the provisions of section 4887 of the Revised Statutes of the United States.

There is thus presented the concise question whether under the provisions of section 4887 a United States patent will expire upon the termination by forfeiture of a prior foreign patent for the same invention.

Section 4887 reads in its applicable part as follows:

> " Every patent granted for an invention which has
> " been previously patented in a foreign country shall
> " be so limited as to expire at the same time with the
> " foreign patent, or, if there be more than one, at the
> " same time with the one having the shortest term."

The provisions of the law of May 25, 1877, subject to which the German patent was issued, is as follows (see Carpmael's Translation):

> " SECTION 8. For every patent a fee of thirty marks
> " is to be paid on the issue of it. Except in the case
> " of patents of addition, a further fee must be paid
> " for each patent at the commencement of the second
> " and subsequent year amounting the first time to
> " fifty marks, and increasing by fifty marks each
> " succeeding year.
>
> " SECTION 9. A patent lapses if the patentee re-
> " nounces the same, or if he fails to pay the fees
> " within three months at the latest after they have
> " become due."

The German patent also bears upon its face this statement:

> "The patent is already previously forfeited when "the patentee has renounced it or when the annuities "were not paid at the utmost within three months of "of their falling due" (Ex. C, p. 10).

The provisions of the law of July 5, 1844, referred to in the Letters Patent of France, an abstract of which appears on the margin of the patent (Ex. B, p. 7), are as follows:

> "ARTICLE 32. The following shall be deprived of "all their rights:
>
> "1. The patentee who has not paid his annuity be- "fore the beginning of each year of the term of his "patent.
>
> "2. The patentee who has not worked his dis- "covery or invention in France, within the term of "two years from the date of the signature of his "patent, or who has ceased to work it during two "consecutive years, unless, in case one or the other, "he justifies himself as to the causes of his inaction."

Point I.

The question appears to be settled in the affirmative by the decision of this Court in the case of The Bate Refrigerating Co. *against* Hammond & Company, 129 U. S., 151.

Prior to the decision in that case the question had arisen several times in the Circuit Court, and in each case it had been held that a United States patent granted for the same invention as a prior foreign patent would not expire upon

the termination by forfeiture of such foreign patent, but would continue in life until the expiration of the time for which the foreign patent was originally granted.

There are two classes of cases which touch the question.

The one passes directly upon the point at issue, holding as above stated; the other passes upon a cognate question, holding that the life of the domestic patent is limited to the term for which the foreign patent was originally granted, and is not lengthened by an extension of the foreign patent, under a statutory provision giving the patentee the right to such extension upon the payment of an additional fee.

The appellee herein insists that these two classes of cases are not only cognate but mutually dependent.

The first proposition was decided in the second Circuit by Judge Wheeler in *Holmes Electric Protective Co.* against *Metropolitan Burglar Alarm Co.*, 21 Fed. Rep., 458; also by Judge Wallace, in 1886, in *Paillard* and others against *Bruno*, 29 Fed. Rep., 864.

It is unnecessary to recite the facts of these cases; it is sufficient that they pass directly upon the question at issue, holding that the forfeiure of a foreign patent does not affect a United States patent subsequently granted for the same invention.

The second proposition stated, namely, the extension of a prior foreign patent does not affect a United States patent for the same invention, was held in the Second Circuit by Mr. Justice Blatchford in 1879 in *Reissner* v. *Sharp*, 16 Blatch., 383. Also by Judge Clifford in the Circuit Court for the District of Rhode Island in 1878 in *Henry* against *The Providence Tool Co.*, 3 Ban. & A., 501. Also by Judge Nixon in the Circuit Court for the District of New Jersey in 1882, in *The Bate Refrigerating Co.* against *Gillett* and others, 13 Fed. Rep., 553.

In the same circuit and in the same case in 1877, 31 Fed. Rep., 809, Mr. Justice Bradley followed with reluctance the construction of the statute given by Judge Nixon upon the ground that the prior decision of Judge Nixon had established the law of the case, and the question was no longer open.

That the two classes of cases are mutually dependent is shown by the fact that both find support in the same arguments, and rest upon the same construction of the statute, namely, that the term of the domestic patent is controlled by the term of the original grant of the foreign patent.

In *Henry* against *The Providence Tool Co.* (*supra*), it was held by Judge Clifford that Congress never intended to extend the term of the United States patent beyond the legal term secured to the foreign patentee when the United States patent was granted, giving as a reason for such holding that, under the opposite rule, neither the authorities of the United States, nor inventors, nor the public would ever be able to know what the patentee acquired under a patent granted by the United States, in a case where the invention had been previously patented in a foreign country.

In *Reissner* vs. *Sharp* (*supra*) Mr. Justice Blatchford approves and follows the foregoing construction.

In *Bate Refrigerating Co.* against *Gillett* (*supra*) Judge Nixon, after quoting the statute, says: "We do not see "how any language could have been employed that would "more clearly express the legislative design, that the life "of the domestic patent should expire with the term of "any outstanding foreign patent."

The cases last above cited are those which hold that the extension of a foreign patent will not operate to extend a domestic patent subsequently granted for the same invention, and they are all placed upon the ground that the term of the original grant of the foreign patent is con-

trolling, and the life of the domestic patent cannot be affected by anything subsequent to its grant.

An examination of the cases above cited, in which the exact question now under discussion was at issue, will show that they rest upon the same construction.

In *Holmes Electric Protective Co.* against *Metropolitan Burglar Alarm Co.* (*supra*), Judge Wheeler, after citing section 4887, says: "This seems to mean that the term of "the patent here shall be as long as the remainder of the "term for which the patent was granted there, without "reference to incidents occurring after the grant. It "refers to fixing the term, not to keeping the foreign "patent in force."

In *Paillard* against *Bruno* (*supra*), Judge Wallace, after citing the authorities above quoted from, says: "Accord-"ing to the construction thus placed upon the section, it "should be read as though it declared that the United "States patent is to expire at the same time with the term "of the foreign patent previously obtained for the same "invention, or, if there be more than one, at the same "time with one having the shortest term. Upon this "construction the duration of the term of the United "States patent is fixed when the patent issues according "to the maxim *id certum est quod certum reddi potest*," and continues using the thought and in condensed form the language of Judge Clifford in *Henry* against *The Providence Tool Company:* "Upon any other construction, "neither the Commissioner of Patents, nor the patentee, "nor the public would know the duration of the grant. "The term of the grant is the period of duration expressed "in the grant."

That Judge Wallace regarded his decision as resting upon the construction adopted in the Bate Refrigerating Company case, and kindred cases cited, is conclusively shown by the last clause of his opinion, as follows: "The argu-"ment in the present case would lead to a construction of "the section which would fix the duration of a United

"States patent by the extension of a foreign patent, or "the renewal of one capable of prolongation like the Aus- "trian patent."

There seems, therefore, to be no escape from the conclusion that both classes of cases as decided by the Circuit Courts, are supported by the same arguments and rest upon the same construction of the statute, and the way is prepared to consider the decision of this Court in the one class of cases in its effect upon the other class.

The decision of this Court in Bate Refrigerating Co. against Hammond & Co., decided January 21, 1889, 129 U. S., 151, overruling the Circuit Court cases holding that an extension of the foreign patent did not operate to extend the domestic patent, also overruled *Holmes Electric Protective Co.* against *Metropolitan Alarm Co.* and *Paillard* against *Bruno*, and established the contrary rule, the one now contended for by appellee, as effectually as though the present question had been directly before this Court.

In regard to such decision, it is respectfully submitted—

FIRST.—Its effect is to overthrow the proposition of construction upon which all of the cases herein cited rest, namely, that the life of the domestic patent is measured by the term of the original grant of the foreign patent, and is not affected by any occurrence happening after its grant. Such construction of the statute is given as the basis of the decision in each case, and the overruling of the case overrules the construction of the statute to which the case gives expression—whether such construction is or is not covered by the language used.

If the attempt to show that both classes of cases cited, namely, those holding that an extension of the foreign patent and those holding that a forfeiture of the foreign patent do not affect the domestic patent, rest upon

the same foundation, namely, the proposition of construction that the life of the domestic patent knows no other measure than the original term of the grant of the foreign patent, has been successful, it must follow that the reversal of either class of cases does, in effect, reverse the proposition upon which it rests, and, irrespective of the language used, overthrows all cases which rest upon that proposition.

The case of *Paillard* against *Bruno* must fall with the case of *The Bate Refrigerating Co.* against *Gillett.*

Of the two, standing upon the same foundation, one cannot be taken and the other left.

SECOND.—**Not only is the effect of the decision of this Court, as just stated**, namely, to negative that construction of the statute which would measure the life of the domestic patent by the term of the original grant of the foreign patent, but such is the unmistakable purport of the language of the opinion. The Court say:

"Two propositions as to the construction of this section "are contended for by the appellant.

"(1.) * * * * * * *

"(2.) That the declaration of the section, that every "patent granted for an invention which has been pre- "viously patented in a foreign country, shall be so lim- "ited as to expire at the same time with the foreign pat- "ent, or, if there be more than one, at the same time "with the one having the shortest term, does not mean "that the patent so granted shall expire at the same time "with the term to which the foreign patent was in fact "limited at the time the United States patent was "granted; but that it shall expire when the "foreign patent expires, without reference to the limita- "tion of the term of such foreign patent in actual force "at the time the United States patent was granted."

This proposition as to the construction was approved by the Court.

The section as construed by this Court means, then, that the domestic patent "shall expire when the foreign patent expires, without reference to the limitation of the term of such foreign patent in actual force at the time the United States patent was granted."

The contention of the appellants is based upon the unwarranted and illogical assumption that this Court meant that the domestic patent "shall expire when the foreign patent expires without reference to the limitation of such foreign patent, in actual force at the time the United States patent was granted," in cases where such foreign patent expires *after* the period of such limitation, but not in cases where the foreign patent expires *before* the period of such limitation. The language is that the application shall be "without reference to the limitation of such foreign patents."

The contention of the appellants not only robs the construction of one-half its effect, but gives to the statute two meanings; the one in direct hostility to the other. It condemns to death one domestic patent "without reference to the limitation of the term of the foreign patent," it grants to another domestic patent prolonged life upon "reference to the limitation of the term of the foreign patent." It is submitted that such contradictory conclusions cannot be drawn from the decision of this Court in the case of *Bate Refrigerating Company* against *Hammond*.

The Court further says "The provisions of the Act of "1870 and of the Revised Statutes mean that the United "States patent shall not expire so long as the foreign "patent continues to exist, not extending beyond seven-"teen years, from the date of the United States patent, "but shall continue in force, though not longer than "seventeen years from its date, so long as the foreign "patent continues to exist."

It is also held that the time of the expiration of the foreign patent may be shown by evidence *in pais*, and that, subject to the limitation of seventeen years, the domestic patent "is to be in force as long as the foreign "patent is in force."

This language and reasoning are hostile to the construction adopted in *Holmes Electric Protective Company* against *Metropolitan Burglar Alarm Company* and *Paillard* against *Bruno*.

In the former case it was held that "the term of the "patent here shall be as long as the remainder of the term "for which the patent was granted there, without refer- "ence to incidents occurring after the grant."

In the latter case it was held "upon this construction "the duration of the term of the United States patent is "fixed when the patent issues."

This Court say that the United States patent "shall ex- "pire when the foreign patent expires without reference "to the limitation of the term of such foreign patent in "actual force at the time the United States patent was "granted."

These two propositions of construction cannot both stand.

The one makes the original term of the foreign patent the standard of measurement, without reference to incidents occurring after the grant; the other makes the incidents occurring after the grant, if any, the standard of measurement, without reference to the original term of the foreign patent.

The one rejects what the other adopts, and adopts what the other rejects.

In *Henry Huber and ano.* vs. *N. O. Nelson Manufacturing Co.*, May 25, 1889, 38 Fed. Rep., 830, the precise question now at issue was considered by Judge Thayer, and the decision was in accordance with appellee's contention hereinbefore expressed.

Judge Thayer, after referring to all the cases hereinbefore cited, says: "Three of the cases above cited were ex- "pressly overruled by the United States Supreme Court, "in *Bate Refrigerating Co.* vs. *Hammond*, 129 U. S., "151, and in my judgment the decision in that case over- "turns as well the principle on which the other Circuit "Court decisions were predicated. The Supreme Court "has clearly discarded the doctrine that an American

"patent must necessarily have a fixed term, which may be "definitely ascertained at the time Letters Patent are "granted, by holding (as in cases cited) that the duration "of the American patent is dependent upon circum- "stances that effect the duration of the foreign "monoply. * * * The arguments used in the "course of that decision lead logically to the "conclusion that United States Letters Patent, "issued subject to the provisions of section 4887, "remain in force no longer than the foreign patent having "the shortest term; that the life of the domestic patent is "measured by the actual duration of the foreign patent, "and may be abridged as well as lengthened by circum- "stances which operate under the foreign law to abridge "or lengthen the foreign monoply."

And the record herein shows that Judge Wallace reached the same conclusion.

Point II.

Considered upon the merits of the question, the same conclusion must be reached.

If the question under discussion can be regarded as open since the decision of this Court in *The Bate Refrigerating Company's case*, the following considerations are offered:

The decisions of the Circuit Courts, holding that the forfeiture of a foreign patent does not abridge a subsequent domestic patent for the same invention, and the argument of counsel for the appellants herein are based upon these two propositions:

1st. The word "term," used in section 4887, means the term of years appearing upon the face of the foreign

patent, and that the expiration contemplated by the section refers to the termination of such term by efflux of time.

2d. The application of the contrary rule would make the duration of the domestic patent uncertain as to time, and possibly dependent upon the failure of the foreign patentee to perform some trival or absurd condition imposed by the foreign law.

FIRST.—In answer to the contention that the word "term," as used in section 4887, has reference to the term of years appearing upon the face of the foreign patent, and that such term is controlling, we answer:

1st. The word "term" in section 4887 is used for the purpose of designating one of two or more foreign patents. It has no reference to the life of the domestic patent; that is covered by the preceding clause. The word accomplishes its full purpose when it designates which of two or more foreign patents shall be referred to in determining the life of the domestic patent in cases where the foreign patent expires by efflux of time. The provision by which the life of the domestic patent is limited is found in the words "shall be so limited as to expire at the same time "with the foreign patent," which "time," it is conceded, may be shown by evidence *in pais*. To expire means to die, whether such death results from age or early disease. To support the contention of appellants, the word "term" must be taken from its place and proper reference, and given another place and a different reference, with the effect to change the manifest meaning of an independent provision of the statute.

2d. It may be conceded by the appellee that the word "term," when used in respect of a grant, has reference ordinarily to the time named in the grant, but

when found in a statute it must be so construed as to make all parts of the statute harmonious and consistent. The application of the word, with the meaning claimed, to ascertain the life of the domestic patent, results in two inconsistent provisions of the statute. The clause "expire at the same time with the foreign patent" is independent and unambiguous, and if the section ended there its construction could not be a matter of doubt, and the subsequent provision should be so construed, if possible, as to be consistent therewith.

This rule of construction is well settled, and is stated by the New York Court of Appeals in applying it to this word "term," as follows:

"In determining the question now before us the "Court is to be guided by the established rules of in- "terpretation of written instruments. It is not com- "pelled—indeed, it is not permitted—to give absolute "and unqualified effect to a single section or clause of "a statute, however direct, plain, and unambiguous, "considered by itself alone, the language may be, if "there are other provisions inconsistent with a literal "and unrestricted interpretation of such clause or sec "tion, unless the repugnance is irreconcilable, in which "case it is the duty of the Court to preserve the par- "amount intention, so far as is consistent with the "rules of law, although this may lead to the rejection "of some subordinate and secondary provisions" (People *ex rel.* Mason *vs.* McClave, 99 N. Y., 83, 89).

In the case cited the New York Court of Appeals was giving construction to the statute authorizing the appointment of Police Commissioners in the City of New York. Section 39 of that statute provides that such Commissioners "shall hold their offices for six years." Section 25 provides that "every head of de- "partment and person in this section named (includ- "ing Police Commissioners), except as herein other-

"wise provided, shall hold his office for the *term* of "six years, and in each case until a person is ap- "pointed in his place." The Court held that having regard only to the provisions quoted, the word "term" would mean the full period of six years, yet, in view of other provisions, the word term was so restricted as to cover only such portion of the six years as was left after deducting the time during which the prior incumbent held over.

The use of the word "term" in the last clause of section 4887, if there be given to such clause a "liberal and unrestricted interpretation," makes such clause inconsistent with the preceding clause. Applying the rule above quoted, if such inconsistency does not amount to "irreconcilable repugnancy," "it is not permitted to give absolute and unqualified effect" to such clause, if the "repugnancy is irreconcilable" such clause must be rejected, as an aid to ascertain the life of the domestic patent in forfeiture cases, as being a "subordinate and secondary provision" It would still perform its full office in designating which patent of two or more shall be referred to, to ascertain the life of the domestic patent, in cases where no forfeiture of the foreign patent occurs.

The rule of construction contended for is stated in *Faw* vs. *Marsteller*, 1 Dallas, 337–340 (2 Cranch, 10), as follows: "In searching for the literal construction "of an act, it would seem to be generally true that "positive and explicit provisions comprehending in "terms a whole class of cases, are not to be re- "strained by applying to those cases an implication "drawn from subsequent words, unless that implica- "tion be very clear, necessary and irresistible."

If the word "term" be regarded as synonymous with "life" the whole difficulty vanishes, and the two clauses of the section are consistent.

3d. The argument based upon the use of the word "term" in section 4887, may be well answered by

considering the ill treatment which that argument has already received in the application of the section in question.

The contention of appellants is that the "term" of a patent means always the term of years named in the original grant, and that where the life of one patent is measured by the term of another, the original grant of the latter is the only measure of the former.

Take, for illustration, a United States patent granted for seventeen years. The "term" is seventeen years. It is afterwards discovered that there is a prior Canadian patent for the same invention granted for five years. The "term" of the domestic patent is now found not to be "fixed" by the original grant, but to be changed to five years.

But it will be said that the existence of the prior Canadian patent was capable of ascertainment at the time of the issue of the United States patent. True; but that fact does not touch the present argument, which is, that the "term" cannot be ascertained by reference to the original grant.

It may still be claimed that the statute makes the "term," *i.e.*, the original grant, of the foreign patent. the measure of the life of the domestic patent, and so it was held by the Circuit Courts in the cases cited; but (waiving for the present our contention that the word "term" as used in the section was not intended as a measure of the life of the domestic patent which has been considered above) we now know that, upon the performance of certain conditions, such "term" of the foreign patent may become ten years, and again fifteen years, and that the "term" of the domestic patent is extended to keep pace with it.

We submit that the construction already given to the section takes all force from the argument based upon the use therein of the word "term." A measure, which is itself so fluctuating, cannot make "fixed" that which it measures.

4th. In the same connection a learned attempt is made to show that the word "expire," as used in section 4887, refers to "the termination of the original grant by the efflux of the time therein granted." It is sufficient to say in answer :

(*a*.) The effort is ill-directed. The attempt is to construe the principal provision of the section so as to make it consistent with the complainants' reading of a "subordinate and secondary provision." As above suggested, the clause "to expire at the same time with the foreign patent" has reference solely to the life of the domestic patent—the question at issue, while the word "term" is used to indicate which of two or more possible foreign patents shall be referred to when the expiration is by efflux of time. In determining the present question, the prior clause is the principal one, and is applicable to all case, while the latter is subordinate, and in many cases superfluous.

(*b*.) The Supreme Court repudiates such a reading of the word "expire." It ascertains the date of "expiration" without reference "to the limitation of "the *term* of such foreign patent in actual force at "the time the United States patent was granted." Certainly *expiration* cannot mean the termination of the *term* by efflux of time, when the date of expiration is ascertained *without reference* to the limitation of the term.

SECOND.—In answer to the argument that the application of the construction contended for by appellee would make the duration of the domestic patent uncertain as to time, and possibly dependent upon the failure of the foreign patentee to perform some trivial or absurd condition imposed by the foreign statute; we submit—

1st. The element of uncertain duration has clearly been

excluded as a factor in the case by the decision of this Court in the *Bate Refrigerating Co. Case.* A possible extension causes no less uncertainty as to time than a possible abridgement. The fixedness of the term at the time of its inception is lost in either case.

Judge Thayer, in the *Huber Case*, says: "The whole "controversy seems to hinge on the question whether "the term of the domestic patent is fixed at its incep- "tion by the terms expressed on the face of the short- "est foreign patent, or whether the life of the Ameri- "can patent may be to an extent uncertain, and is "subject to contingencies affecting the life of the "foreign patent. The Supreme Court of the United "States seem to have adopted the latter view."

2d. Notwithstanding the decision of this Court in the *Bate Refrigerating Company case*, the learned counsel for the appellants still insist that under section 4887 the term of the domestic patent must be *fixed at its inception*, and on that proposition base their principal argument. A single supposition, briefly stated, will show the fallacy of this argument.

An American patent issues in usual form, and for seventeen years, which is the "term" of the patent. It is subsequently ascertained that a prior Canadian patent has been granted for the same invention for the "term" of five years. Under the authorities and the practice of the Patent Office the "term" or "life" or "period of duration," whatever it may be called, of the American patent, is abridged from seventeen years to five years. Subsequently the Canadian patent, by compliance of the patentee with the provisions of the Canadian law, and, it may be, without the knowledge of the holder of the American grant, obtains an extension of the Canadian patent for five years; again the "term" or "life" of the American patent, under the rule of the *Bate Refrigerating Company case*, changes, and the "term" becomes ten years. The Canadian patent

is again extended five years, and the "term" of the American patent becomes fifteen years. We have here, under the application of rules which cannot be questioned, three changes in the "term" of the domestic patent, one abridgement and two extensions, and under the laws of some foreign countries the number of extensions could be greatly increased. What has become of the element of "fixedness at time of inception," so strongly insisted upon by counsel for appellants? And it is submitted that the argument based thereon falls with its elimination.

It is settled beyond controversy that the "term" of a United States patent which is within the purview of section 4887, *cannot be fixed, at the date of issue, by reference to something which is certain at that time.*

Conceding that, the fallacy of the argument under consideration is manifest, and we are permitted to take a further step in our supposed case, and include another abridgement of the domestic patent, logically resulting from a forfeiture of the foreign patent The domestic patent still follows, *pari ratione*, the mutations of the elder patent.

A comparison of the causes which result in prolonged life in the one case, and expiration in the other, will aid in determining whether the statute compels the one and forbids the other.

(*a.*) Both results are reached by operation of provisions of foreign laws which have no counterpart in our own laws.

(*b.*) Both are possibilities, and only possibilities, existing at the issue of the domestic patent.

(*c.*) Both are, or may be, dependent upon the act of a foreign patentee or assignee, whose interest may be hostile to thatof the holder of the United States grant.

(*d.*) Both results may be accomplished without the knowledge, intervention or assent of the owner of the domestic patent.

(*e.*) Both result in making the duration of the domestic patent uncertain.

It is thought that the foregoing presents all the objections based upon the idea of a *fixed* term, urged by counsel for appellants to the construction contended for by appellee, and they apply equally to the construction adopted by this Court in the *Bate case*. If not regarded as controlling in that case, how can they be in this?

3d. The argument and the exhaustive abstract of foreign statutes appearing in the appendix to one of the briefs submitted in opposition, might, with propriety, be presented to Congress in an attempt to procure an amendment to section 4887, but it is difficult to see how they can aid in the construction of the statute as enacted.

4th. The evil which counsel for appellants represent as likely to follow such construction, in so far as it is not imaginary, results not from the statute or its application, but from the ill advised acts of inventors. No hardship is imposed upon the resident inventor by saying to him that he must first obtain the protection of a domestic patent, or subject himself to the inconvenient application of the laws of that country wherein he first obtains protection. The statute was not designed to protect inventors against their own foolish acts.

This consideration has apparently entirely escaped the attention of counsel for appellants, whose argument seems to proceed upon the theory that the damages which they foresee are unavoidable and attend every patent. Whereas no patent issued to a resident inventor can be brought within the operation

of the section except through the fault of the inventor. It can hardly be claimed that Congress anticipated such ill advised act, and enacted the statute as a protection against it; hence:

5th. The argument not only loses its force as against the appellee, but retroacts against the appellants, when regard is had to the evident intent of Congress in the enactment of the statute, and herein—

(*a.*) Manifestly the statute has not reference, primarily, to inventors who are residents of the United States. The right of such resident inventors to a monopoly for seventeen years, unaffected by the provisions of foreign statutes, is easily secured, care only being had not to make sale of a birthright for the pottage of a premature foreign patent. The resident inventor, who first obtains for his invention the protection of a foreign government, ought not to complain, if, in respect of such invention, he is granted no other privilege by the home government than such as is given to a subject of such foreign power. Congress could hardly have anticipated that any resident inventor would first obtain a for eign patent, or have had such tender regard for the interest of one who might do so as to enact for his benefit section 4887.

(*b.*) The section clearly has reference to a foreign inventor, who, having obtained Letters Patent from his home government, makes application here for Letters Patent for the same invention. In such case, Congress, recognizing the usages of nations, grants to such inventor, by section 4887, the right to ask for a monopoly limited in respect of time: (1) to expire at the same time with the foreign patent; or, (2) if there be more than one, at the same time with the one having the shortest term. The double limitation shows a carefully expressed intent that the

foreign patentee should receive protection here only so long as he receives like protection abroad. The provision has its origin in a regard for the comity of nations, but national courtesy cannot demand the granting to a foreigner of privileges here, which his own government denies him at home.

The purpose of the patent laws is, by rewarding inventors, "to promote the progress of science and the useful arts." It must be assumed that every provision of those laws is in furtherance of such intent. It is possible to see how such intent can be furthered by granting to a foreigner a monopoly so long as his own government grants a like monopoly, but it is not possible to see how such interest can be furthered by continuing such monopoly after his own government, for good cause, has withdrawn its protection, and the invention has become public property abroad.

It is respectfully submitted that the argument drawn from the manifest intent of Congress is in support of appellee's contention.

WILLIAM J. TOWNSEND,
Of Counsel.

UNITED STATES SUPREME COURT.

CARL POHL and CHARLES ZOLLER,
Appellants,

vs.

THE ANCHOR BREWING COMPANY.

No. 1269.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Motion to Advance.

This suit was in equity. It was brought on U. S. Letters Patent, No. 213,447, dated March 18th, 1879.

The defendant interposed a special plea in bar in which it was, among other things, alleged as follows:

"That at the time of the issuing of said Letters Patent, and at the time of his application therefor, the said complainant, Carl Pohl, was thence and hitherto has been and now is a citizen of the Empire of Germany; that prior to the issuing of said U. S. Letters Patent, No. 213,447, and prior to his said application therefor, the said complainant, Carl Pohl, had made application for the issue to him of Letters Patent of the Empire of Germany for the same alleged invention shown, described and claimed in said U. S. Letters Patent, No. 213,447, and thereafter, and prior to his said application for said U. S. Letters Patent, and on the 6th day of September, 1877, by a decision of the Imperial Patent Office of the Empire of Germany, Letters Patent, No. 975, were issued to the said complainant, Carl Pohl, for said alleged invention; *that said German Letters Patent were public patents and were for the term of fifteen years*, and by the terms and provisions thereof, the rights and obligations of the said patentee, the said complainant, Carl Pohl, were determined by the law of patents of May 25th, 1877; that under and by the provisions of the

said law of May 25th, 1877, the said patentee was required to pay certain annuities on said Letters Patent, and to work the said invention in the Empire of Germany in the manner and for the term specified in and by said law, and in default thereof, the term of the said German Letters Patent would expire, and the rights and privileges of the patentee thereunder would become forfeited and cease as by said Letters Patent, or a duly authenticated copy thereof, will more fully appear; that the said patentee, the said complainant, Carl Pohl, neglected and failed to pay the annuities, and neglected and failed to work the said invention in the Empire of Germany in the manner and time required by said law, whereby and by reason whereof, and under and in pursuance of the provision of said law of May 25th, 1877, the said German Letters Patent, No. 975, in the year 1880 became and were forfeited, and the term and time thereof expired, and the rights and privileges of the complainant, Carl Pohl, thereunder ceased.

"That prior to the issue of U. S. Letters Patent, No. 213,447, and prior to his said application therefor, the said complainant, Carl Pohl, had made application for the issue to him of Letters Patent to France for the same alleged invention shown, described and claimed in said U. S. Letters Patent, No. 213,447, and thereafter and still prior to his said application for said U. S. Letters Patent, and on the third day of September, 1877, Letters Patent, No. 120,164, were, by the proper authorities of the Government of France, issued to said Carl Pohl, for said alleged invention; *that said Letters Patent of France, were public patents and were for the term of fifteen years*, and by the terms and provisions thereof, the same were issued in view of and subject to the provisions of the law of July 5th, 1844, and the rights and privileges of the patentee, the said complainant, Carl Pohl, were limited by and subject to the provisions of said law; that under and by the provisions of said law of July 5th, 1844, the patentee who failed to pay his annuities, as required by law, before the beginning of each of the years of the duration of his patent, or who failed to put his invention in working order in France within two years of the signature of the patent, or who ceased, during the two years consecutive, such working, would forfeit all right under such Letters Patent as by said law, or a duly authenticated copy thereof, will more fully appear; that the said patentee, the said complainant, Carl Pohl, neglected and failed to pay his annuities as required by said law of July 5th, 1844, and neglected and failed to put his said alleged invention in working order and force within two years from the signature of said Patent, and the said patentee, the said complainant, Carl Pohl, ceased, during two years consecutive, such working; whereby and by reason whereof, and under and in pursuance of the provisions of said law of July 5th, 1844, the said Letters Patent of France, No. 120,164, became and were forfeited, and the time and term thereof expired, and the rights and privileges of the complainant, Carl Pohl, thereunder, ceased and determined.

"That by reason of the premises, and under and in pursuance of the provisions of Section 4887 of the United States, the said Letters Patent, No. 213,447, prior to the time of the commencement of this suit, expired and the term thereof ended, and at the time of the commencement of this suit the said

complainants, Carl Pohl and Charles Zoller, had no interest in or title to the said Letters Patent, and no exclusive or other rights or privileges thereunder.

"Wherefore and by reason of the premises, the said complainants have no equitable claim against this defendant, and this court of equity has no jurisdiction and ought not to take cognizance of or entertain this suit; and this defendant, The Anchor Brewing Company, pleads this fact to the whole of said bill, and demands judgment of this honorable Court whether it ought to be compelled to make any answer to said Bill of Complaint, and prays that it may be hence dismissed with its reasonable costs in this behalf most wrongfully sustained." (Record, pp. 13, 14, 15.)

The patent sued upon contains this provision:

"Now, therefore, these Letters Patent are to grant unto the said Carl Pohl, his heirs or assigns, for the term of seventeen years, from the 18th day of March, one thousand eight hundred and seventy-nine, the exclusive right to make, use and vend the said invention throughout the United States and the Territories thereof, subject to the limitation prescribed by Section 4887, Rev. Stat., by reason of German Patent, dated September 6th, 1877, and French Patent, dated September 3d, 1877."

The plea was set down for argument (p. 16), and was heard and was sustained, and the bill was dismissed with costs (p. 19).

The opinion of the Court below is contained in the record, which is printed (p. 17).

The question involved in the suit may be briefly stated as follows:

"Is the term of an American Patent for seventeen years affected by the failure of a foreign patentee, having a previous foreign patent of a defined and expressed term of years for the same invention, to pay the subsequent annual taxes or to manufacture subsequently within the realm (within that term), as required by foreign law?"

In the decision of this question there are a very large number of American citizens largely interested. They are affected by the decision below, in their position as patentees, assignees and parties complainant and defendant in various litigations now pending in the Circuit Courts, and progress in which will be necessarily delayed, unless this motion can be entertained, until the decision of this Court in the present suit. Such delay will render further litigation by other parties necessary to preserve their rights,

and by all of which the already overburdened courts will be impeded in the disposition of other causes pending before them.

The ways in which the interests of owners of American patents are affected are various. In cases where the failure to pay foreign taxes, etc., has already occurred, that fact is capable of being set up, and is set up in many cases, as a defence; with the necessary effect of suspending any practical enjoyment of the patentee's American rights until such cases shall have reached this Court and been determined; and even if such determination is favorable to the defence, the patent in suit will have been running without avail to its owner, and in many cases will have run out altogether.

In another class of cases where the foreign patents are in force, but are owned (as is almost always the case) by persons other than those who own the American patents, the American owner is obliged, if he wishes to be secure, to search out the foreign owners and tender to them the money needed for compliance with foreign laws. It is well known that this is now being done in many cases and that great confusion and alarm has seized upon the owners of American patents thus related to foreign patents. It is not only conceivable that foreign owners may not always be willing to act for the preservation of American patents in which they have no interest—except on onerous conditions—but it is also conceivable that foreign patents in small countries may be sought and purchased by American infringers for the purpose of suffering them to lapse before the *expiration* of their *terms*, thus producing a failure of the American patent for causes not contemplated by our Statute, viz., the breach of conditions subsequent, rather than the *expiration* of foreign *terms*. This state of things arises not from anything actually decided by this Court in the case of Bate *vs.* Hammond, but from certain expressions contained in the opinion—upon a point not argued by counsel and not involved in the facts of that case—which

it is believed are misunderstood, and have been in fact misinterterpreted and misapplied. The facts in the case of Bate Refrigerator Company *vs.* Gillette, 31 Federal Reporter, p. 809, *did* require a decision of this point of law, and that decision was expressed by Mr. Justice Bradley as follows:

"I do not think that this position is maintainable. The English Patent was granted for a term of fourteen years, subject to be defeated by the nonperformance of a condition subsequent. *I do not think that the American Patent became subject to the same condition.* The term of the English Patent fixed the term of the American Patent—nothing more and nothing less. The subsequent fate of the English Patent had no effect upon the American; the life of each after its inception proceeded independent of the other."

The facts in the case of Bate *vs.* Hammond in this Court not being such as to call for any consideration of the question stated above, some of the terms employed by this Court in expressing its judgment upon the facts actually before it have nevertheless been misapplied and misunderstood so as to bring in doubt a vast number of American patents, whose owners have relied upon the law as stated in the case of Bate Refrigerator Company *vs.* Gillette, above quoted, and other concurring decisions in the Circuit.

It is manifest that the question in this case is so related to the actual question in the case of Bate *vs.* Hammond as to be one case with it, and it is deemed by the petitioner to be within the principle and meaning of Subdivision 4 of Rule 26 of the Supreme Court. The effect attributable to the misunderstanding of the decision of this Court is such as to make the question one of peculiarly grave public importance—justifying some action by the Court to set at rest doubts arising from the misinterpretation of the language of the Court upon points which were not discussed before it; and on which counsel should be heard before any judgment is reached.

The grounds upon which the Court below proceeded are stated in its opinion.

A not dissimilar question arose in the Circuit Court of

the United States for the District of New Jersey, and the decision of such Court thereon is appended hereto.

In view of the antecedent decisions of the Circuit Court referred to in the opinion below in this case, and of the two decisions now called to the attention of this Court, it is respectfully submitted that the question involved is of sufficient general and public importance to permit this Court, in harmony with its rulings, to advance the cause for argument.

If, however, the Court should be of opinion that the motion should be denied, then the appellants respectfully pray that such denial may be coupled with a declaration by this Court, if it should be proper to make it, that the question now presented is open to the Circuit Courts to be decided upon its merits; and that the same was not intended to be embraced in or covered by the decision in Bate Refrigerating Co. *vs.* Hammond (129 U. S., 151).

All of which is respectfully submitted.

GROSVENOR LOWREY,
CLARENCE A. SEWARD,
JOSEPH M. DEUEL,
Of Counsel for Appellant.

Dated, New York, November 22d, 1889.

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

POHL *et al.*

vs.

THE ANCHOR BREWING COMPANY.

J. M. DEUEL, GROSVENOR LOWREY and CLARENCE A. SEWARD for Plaintiffs.

W. J. TOWNSEND and EDMUND WETMORE for Defendant.

WALLACE, J.:

The bill of complaint alleges infringement by the defendant of letters patent of the United States, dated March 18th, 1879, for improvement in barrel and cask scrubbing machines, granted to Carl Pohl of Dresden, Germany, upon an application filed January 3d, 1879, "subject to the limitation prescribed by Section 4887 of the Revised Statutes, by reason of German patent, dated September 6, 1877, and French patent, dated September 3d, 1877."

The defendant has interposed a plea averring in substance that both the German and the French patent were issued to Pohl for the same invention described in, and prior to his application for, the United States patent; and that the German patent lapsed and the French patent became forfeited prior to the commencement of the present suit by reason of the failure of the patentee to pay the annuities and work the invention as required by the laws of Germany and France in force when the foreign patents were granted. The plea alleges that the original term of

each of the foreign patents was for fifteen years. The plea has been set down for argument, and the question for determination is whether by Section 4887, Revised Statutes, the United States' patent expired when the foreign patent, having the shortest term, terminated by lapse or forfeiture, or whether it does not expire until the original term of such foreign patent expires.

By the section in question the patent in suit is to be limited "to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term." Until the decision of the Supreme Court in Bate Refrigerating Co. *vs.* Hammond (129 U. S., 151), it was generally supposed that the time of expiration of this section was the time of expiration of the original term of the foreign patent, and that the duration of the United States patent was independent of the contingency that the foreign patent might cease to be an operative grant prior to the term specified on its face by the breach of a condition subsequent. This was so decided in several adjudged cases (Paillard *vs.* Bruno, 29 Fed. Rep., 384; Bate Refrigerating Co. *vs.* Gillett, 31 Fed. Rep., 809; Holmes Electrical Protective Co. *vs.* Metropolitan Burglar Alarm Co., 21 Fed. Rep., 488). These decisions interpreted the statute upon considerations of public policy and convenience so imperative that it was thought they could not have been disregarded by Congress, and emphasized the effect to be given to the word "term" as used in the section. It was supposed that when Congress referred to the patent having the "shortest term" to define the time of the expiration of the United States patent in case there should be two foreign patents the time of expiration in all cases was the end of the term of the foreign patent; that the term of a patent meant the period of duration expressed in the patent; that in a legal sense a patent does not "expire" until its term expires; and that a construction of the section by which the duration of the United States patent should be fixed when the patent issues, by applying

the rule *id certum est quod certum reddi potest*, was the more reasonable one and the one intended by Congress. And it had been pointed out that unless this was the true construction of the section neither the owner of the patent nor the public would know the duration of the grant, and that the United States patent might expire, if there were two foreign patents, at the same time with the one having the longest term, notwithstanding the language of the section that it is to expire with the one having the shortest term. The decisions of the Circuit Courts, which have been cited, were not referred to in the opinion of the Supreme Court in Bate Refrigerating Co. *vs.* Hammond; but other adjudications of Circuit Courts in construction of the section which proceeded upon the same considerations were distinctly disapproved. These were Henry *vs.* Providence Tool Co. (3 Ban. & A., 501), Reissner *vs.* Sharp (16 Blatchf., 383), Bate Refrigerating Co. *vs.* Gillett (3 Fed. Rep., 553), where it had been held that the time of expiration of the United States Patent was the end of the term expressed in the foreign patent, notwithstanding the prolongation of the original term was a matter of right to the patentee and had actually been obtained by him. It is now urged for the complainants that the decision of the Supreme Court does not overrule or discredit the decisions of the Circuit Court, which were not referred to and distinctly considered in the opinion, and is to be read as merely deciding the precise question in the case, which was whether an extension of the term of a foreign patent, which by the foreign law was a matter of right to the patentee upon complying with certain conditions, prolonged the duration of the United States patent. The opinion does not discuss the reasons for the construction given to the section; but it states that the point in controversy is whether the United States patent expires "at the same time with the term to which the foreign patent was in fact limited when the United States patent was granted," or expires "when the foreign patent expires without reference

to the limitation of the term of such foreign patent in actual force at the time the United States patent was granted"; and it declares that the statute means "that the United States patent shall not expire so long as the foreign patent continues to exist" and "is to be so limited by the Courts, as a matter to be adjudicated on evidence *in pais*, as to expire at the same time with the foreign patent," and "is to be in force so long as the foreign patent is in force." The contention for the complainants would be justified if the opinion had suggested that the term of a foreign patent, within the meaning of the section, may be deemed either the original term expressed in the patent or a period of duration to which its life may be prolonged as a matter of right and law in the country of its origin; or that, although a patent expires when its term expires, Congress did not mean to limit the life of an United States patent to the original term of the foreign patent. But in the absence of any such suggestion, and by the extracts which have been given, it seems plain that the Supreme Court has not acceded to the interpretation adopted in the previous adjudications, as well as those not referred to in the opinion as those that were. The opinion cannot be reconciled with the view that the statute intends that the United States patent shall have a fixed term, ascertainable when it issues, by reference to the term of a foreign patent. It does not attach any significance to the word "term" as defining the period of duration of the foreign patent or of expiration of the United States patent, but treats that period as one to be ascertained *dehors* the foreign patent, by evidence *in pais*, and without reference to any supposed inconvenience or uncertainty to the public or the patentee which may ensue in consequence of their ignorance whether the patent is or is not in life. The statute is capable of the meaning that exclusive right to the invention here is to cease with the exclusive right of the patentee in any foreign country, or of the meaning that it shall continue to exist for such period, not exceeding seventeen years, as coincides with the short-

est term of any foreign patent. The Supreme Court seems to have adopted the first of these meanings. This is the view of the decision expressed in the recent case of Huber *vs.* N. O. Nelson Manufacturing Co. (38 Fed. Rep., 830); and is the construction of the statute adopted by the Commissioner of Patents shortly after the passage of the act of July 6th, 1870, in which the section first appears, in case of Mushet, 2 Com. Dec., 106.

The conclusion thus reached is contrary to the impressions entertained at the argument of the plea; but a careful reading of the opinion of the Supreme Court constrains the conclusion that the plea must be held to be good.

(Filed August 8th, 1889.)

IN U. S. CIRCUIT COURT,

District of New Jersey.

Before McKennan and Wales, JJ.

The Edison Electric Light Company *vs.* Westinghouse, Church, Kerr & Company.	In Equity.

J. C. Tomlinson and Clarence A. Seward, for Plaintiff.

Bakewell & Kerr, for Defendant.

Per Curiam:

The bill filed in this case is for an infringement of Letters Patent, No. 264,642, dated September 19th, 1882, granted to the complainant, as assignee of Thomas A. Edison, who was the original applicant therefor, inventor of the improvement therein described. The defendant has pleaded that a patent for the same invention had been issued to the said Thomas A. Edison by the Austro-Hungarian government, on the 3d day of February, 1881, for the term of one year, and that a subsequent grant was made extending the term of the last-mentioned patent for a new term of one year, which expired on the 3d day of February, 1883; that this extended Austro-Hungarian Patent was existing and unexpired when the patent in suit was granted, and that the term thereof expired on the 3d day of February, 1883, and

before the commencement of this suit, and thereby the said Austro-Hungarian patent then expired within the meaning of Section 4887 of the Revised Statutes, and that by reason of the premises the patent sued on had expired by operation of law prior to the bringing of this suit; and that this Court has no jurisdiction and ought not to entertain jurisdiction of this suit, the plaintiff having a complete and adequate remedy at law. This is the substance of the plea and it has been set down for argument by the plaintiff.

The bill alleges that the Austro-Hungarian patent has not expired, that it was granted for the term of fifteen years from its date and is now in full force and effect.

The question thus presented concerns the proper meaning and construction of Section 4887 of the Revised Statutes, and has recently been decided by the Supreme Court of the United States in the case of *Bate Refrigerating Company* vs. *Hammond*, 129 *U. S.*, 151, where the Court held that "Under Section 4887, although in the case provided for by it, the United States patent may on its face run for seventeen years from its date, it is to be so limited by the Courts, as a matter to be adjudicated on evidence *in pais*, as to expire at the same time with the foreign patent, not running in any case more than the seventeen years; but, subject to the latter limitation, it is to be in force as long as the foreign patent is in force."

This is decisive against the sufficiency of the defendant's plea in this case. Hence it must be ordered that the defendant's plea stand as an answer or part of an answer to the plaintiff's bill.

Filed Oct. 1st, 1889.

(A true copy.)

J. D. OLIPHANT,
Clerk.

[SEAL.]

SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1889.

CARL POHL and CHARLES ZOLLER,
Appellants,

vs.

THE ANCHOR BREWING COMPANY.

No. 1,269.

We hereby consent to motion to be made by appellants to advance this appeal for the earliest possible hearing.

Dated at New York City, November 18th, 1889.

HESS & TOWNSEND,
Solicitors for Appellants.

FILED.
JAN 27 1890
JAMES H. McKENNEY

C. G. Burgoyne's Printing Business, 146-150 Centre St., N. Y.

Supreme Court of the United States.

CARL POHL and CHARLES ZOLLER,
Complainants and Appellants,

vs.

THE ANCHOR BREWING COMPANY,
Defendant and Respondent.

No. 1769

Brief filed by leave of Court on behalf of Nathan L. Heyman.

On the 6th day of January, 1890, counsel for Heyman presented a petition to this Court, setting forth, in substance, that the petitioner, Heyman, was the manufacturer and seller of the alleged infringing machines for washing beer kegs, for the use of one of which by the defendant, the Anchor Brewing Company, this suit was brought, and the guarantor of said defendant; that the plea in the case only set up the expiration of two prior foreign patents, one a German and one a French patent, when, as matter of fact, neither of the said prior foreign patents was the one "having the shortest term," but a preceding Austrian patent had been granted for a shorter term, and had expired before either said German or French patents, and, therefore, the effect of the expiration of said French and German patents was essentially a moot question; that the pe-

titioner, Heyman, had asked the defendant to set up said Austrian patent as a bar to the suit, but defendant had declined, alleging that plaintiffs' counsel had agreed that if this plea be overruled, then the defendant may set up the said Austrian patent, and both parties refused to allow said petitioner to become a party to the suit, and had discontinued a suit formerly pending against himself, in which he had obtained leave to set up said Austrian patent, and that the plaintiffs had refused a tender of all the pecuniary judgment which can be recovered in this suit, and said petitioner asked leave to intervene in this appeal or to file a brief, or for general relief.

On the 13th day of January, 1890, this Court handed down an order permitting the petitioner to file a brief herein. The original motion being merely for leave to file the petition, that being, as counsel supposed, the proper practice, as a preliminary step, before a hearing could be granted, on notice upon the merits of the petition, they are somewhat in doubt whether the present leave is intended to permit the brief to embrace the merits of the petition or is to be confined to the record, as it stands, excluding all consideration of the facts set up in the petition.

If the former, counsel merely refer to the brief already filed when the petition was presented, and submit that, as the proper method of permitting petitioners to intervene, and under the general prayer for relief, the record should be remitted to the Court below in order that the petitioner may there move to intervene and correct the plea by setting up the expiration of said Austrian patent, but do not deem it proper (because of said doubt) to include in this brief any further reference to that branch of the subject. If the latter is the correct interpretation of the permission granted by the Court, then, upon the record as it stands, counsel for Heyman present the following considerations:

First.

As the plea is drawn, it should be overruled because it is fatally defective in not alleging that the German or the French prior foreign patents therein set up were all the foreign patents that had been granted or that either of them was, there being more than one of said prior foreign patents, "the one having the shortest term" of all the prior foreign patents that may have been granted.

The language of Section 4887 of the Revised Statutes, as respects this point, is as follows: "Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, *if there be more than one, at the same time with the one having the shortest term.*"

Where a plea shows that there is more than one foreign patent, it must expressly allege that the patent, the expiration of which is stated to limit the subsequently granted United States patent, under the statute, is not only the one having a shorter term than one or more of said prior foreign patents, but is the one having the "shortest term" of all. Otherwise its expiration might have no effect upon the United States patent.

It is true, then, the present plea alleges, as to the expiration of both the French and the German patents therein set up: "That by reason of the premises and under and in pursuance of the provisions of Section 4887 of the Revised Statutes of the United States the said U. S. Letters Patent" in suit "prior to the time of the commencement of this suit expired, and the term thereof ended" (Rec., pp. 14, 15, fols. 22, 24), but this is not sufficient.

The mere reference to the statute and the statement as to each of said patents that under and in pursuance

of its provisions the patent in suit expired because of the expiration of the German patent, and also because of the expiration of the French patent, may be intended to imply that, as to each of said patents all the facts existed which the statute requires in order that its expiration should limit the American patent, and which, it may be incidentally noted, is an inconsistent implication; but that is not enough.

Where a statutory defense is pleaded to the effect that, by virtue of the existence of certain facts the statute creates a bar to the plaintiff's claim, every fact essential to bring the statute into operaton must be expressly alleged. Every intendment is taken most strongly against a plea, (Heard on Eq. Pl. p. 90 and U. S. vs. Linn, How. 104). The omission, in the case supposed, to distinctly set forth such necessary fact is an omission to state a complete defense.

The same degree of certainty is required in a plea in equity as in pleas at law, (Heard on Eq. Pl., p. 85) and, "all the facts necessary to render the plea a complete equitable bar to the case made by the bill, so far as the plea extends, that the plaintiff may take issue upon it, must be clearly and distinctly averred." Mitford on Pleading, 298 *(m. p.)*

In pleading a statute which creates a bar to the plaintiff's claim, "the substance of the plea consists in the averment of matter necessary to bring the case within the particular statute."

Mitford on Plead., 258 *(m. p.)*
Bogardus's Trinity Church, 4 Paige 178, 197.
Saunders on Pl. and Evid., 830 *(m. p.)*
Curtis vs. Masten, 11 Paige, 15. 17.

Within well established rules therefore, the plea is insufficient. Every fact set forth in the plea may be true and yet *non constat* that either the German patent, or the French patent set up in the plea were either of

them, the patent the expiration of which could, under the statute, limit the duration of the United States patent.

If there was a prior patent having a shorter term than either of those pleaded, and the shortest term of all the prior foreign patents, a fact not inconsistent with the averments in the plea, then neither the French nor the German patent had, by its expiration, any effect upon the patent in suit.

There is a further defect in the plea as relates to the French patent. There is no allegation that it expired by forfeiture or otherwise before this suit was brought and therefore is no answer to the jurisdiction of our Court.

Counsel for Heyman, therefore, submit that the plea is bad upon its face, and should be overruled.

Second.

If, however, the Court shall be of opinion that the plea is sufficient as to its averments to raise the question of the effect of the expiration of either or both the French and German patents set forth therein, and assuming said patents to be the only prior foreign patents, then it is submitted on behalf of said Heyman, that on such assumption, the expiration of said German patent, being the only one of the two alleged to have expired before suit brought, limited the United States patent in suit, so that it expired before this bill was filed, and the equity side of the Court has no jurisdiction.

The point which the appellants seek to make is, that, inasmuch as the said German patent is alleged to have been forfeited and to have ceased to exist before the end of said fifteen years, because of the failure on the part of the patentee to fulfill certain conditions

subsequent upon the fulfillment of which the continuance of said patents depended, a distinction exists between this case and the case of *Bate Refrigerating Company vs. Hammond* (129 U. S., 151), decided by this Court; and that that distinction takes this case out of the scope of the rule of construction upon which that decision was based.

In *Bate vs. Hammond*, the foreign patent had been granted for five years with a privilege of renewal secured to the patentee as matter of right under the Canadian Statute, provided the patentee applied therefor and paid certain fees, which privilege had been availed of and the existence of the patent had continued unbroken after the termination of the said five years; in the present case the patents were granted for fifteen years upon the condition subsequent, expressed in the law under which the patent was granted, that the patentee should make certain payments at stated times, and also work the invention within a certain period, and only ceased to exist because of the failure on the part of the patentee to make said payments or to work the invention within the required period.

It is contended, in answer to this, that there is no difference so far as regards the effect of the United States Statute, whether the foreign patent is granted upon its face for five or fifteen years, if as matter of fact, it expires at the end of a given period, whether for non-payment of fees or any other cause. The date of the actual expiration of said foreign patent limits the duration of the United States patent. That is the only logical and consistent conclusion to be derived from *Bate vs. Hammond*.

The letters patent in suit were expressed to be granted, "subject to the limitation prescribed by Section 4887 of the Revised Statutes, by reason of German patent dated September 6th, 1877, and French patent dated September 3d, 1877."

The plea alleges that, pursuance to the provisions of the German law, the said German letters patent, "in the year 1880," (prior to the commencement of this suit) "became and were forfeited, and the term and time thereof expired, and the rights and the privileges of the complainant Carl Pohl, thereunder then ceased and determined."

This is an allegation of fact, and by the demurrer to the plea is admitted to be true.

The only question, then is, what was the effect of this fact, under Section 4887 of the Revised Statutes, upon the patent in suit.

I.

Three interpretations of Sec. 4887 of the Revised Statutes have been argued for.

First. It has been contended that the words, "Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one at the time, with the one having the shortest term," mean that the United States patent shall literally "expire at the same time with the foreign patent"; that is, shall continue in force so long only as the foreign patent continues in force, so that the monopoly shall cease here at the same time that it ceases abroad. The words, "the one having the shortest term," under this interpretation, mean having the shortest actual term of existence, the word "term" denoting, in accordance with its frequent and correct legal signification, the period during which the patent is actually in force.

This, as counsel for Heyman contend, is the correct interpretation, and the one adopted by this Court in

Bate Co. vs. Hammond.

Second. It has been contended that the words mean that the United States patent shall expire at the expiration of the term of years expressed upon the face of the foreign patent at the time of its grant, without regard to the fact that said foreign patent may actually expire and cease to be in force before or may be prolonged after the end of said period so expressed upon its face.

This was the interpretation adopted in several cases by the Circuit Courts and expressly overruled in

Bate vs. Hammond.

Third. It has been contended that the words mean that the United States patent shall expire at the expiration of the longest period for which it was possible for the foreign patent to last, under the foreign law, without regard to the fact whether it actually continued in force to the end of that period or not.

This interpretation has never received the sanction of any Court.

The said *three* interpretations are all the possible interpretations of said Section 4887, and only one of them can be correct, and the adoption of one necessarily excludes the other two.

The considerations which support the *first* of these constructions are:

1st. It is the one that is in closest conformity to the literal and natural meaning of the language, and that language is so explicit that no other than its literal meaning can be adopted. The words "shall expire at the same time with the foreign patent" are the controlling words of the section and mean exactly what they say.

2d. It is the one that accords with a distinct and in-

telligible policy, viz.: that when an invention is first patented abroad the monopoly here shall last no longer than the monopoly abroad. This policy prevails in most foreign countries, and is provided for in their patent laws. Section 4887, under the construction here considered, may, in view of this fact, be regarded either as retaliatory legislation, or as founded upon the same general policy that has led to the adoption of the like restriction in other countries.

Carpmael Patent Laws of the World, pp. 15, 43, 199, 288, 455.

There is no argument in favor of the *second* construction except the argument *ab inconvenienti*. It was argued that much inconvenience would ensue if the actual duration of the United States patent was unascertainable at the time of its grant, but left dependent upon an uncertain future event. To avoid this uncertainty a forced meaning was given to the language. The literal import of the unqualified language of the first part of the sentence "*every* patent, etc., *shall expire* at the same *time* with the foreign patent," was disregarded, and the word *term* was held to mean in substance "term expressed on the face of the foreign patent," and by retroactive effect to qualify the first part of the sentence, so that the said first part should be construed as if it read "shall expire at the same time with"—not the foreign patent—but the "term expressed on the face thereof." The objection to this interpretation is that it introduces an inadmissible qualification to the language, and, moreover, the actual inconvenience is not, as matter of fact, considerable, and the legislature must be presumed to have regarded it as altogether outweighed by the reasons for the adoption of the policy of not permitting the United States patent to outlast a previously granted foreign patent for the same invention.

The *third* proposed construction has *less* to recommend it than the *second*. It is based solely upon the same argument *ab inconvenienti* and requires greater violence to the language, for by no allowable use of language can the word "term" be held to mean "period for which it is possible the foreign patent may last, if the foreign patentee complies with certain future conditions," and to give the word such a meaning and then construe the first part of the sentence so that it is qualified by that meaning, is to exceed the bounds of legal construction.

This construction has not only not been sanctioned by any adjudicated case, but was expressly repudiated in *Gramme Co. vs. Arnoux* (21 Blatch. 450), which has never been overruled.

II.

The decision of this Court in *Bate Co. vs. Hammond* is only consistent with the adoption of the *first* construction above stated, and is, therefore, inconsistent with the adoption of either of the other two proposed constructions.

This appears from the language of the opinion and from a consideration of the prior cases, which were either expressly or by implication overruled by that decision.

In *Henry vs. Providence Tool Co.* (3 B. & A., 501), *Reissner vs. Sharp* (16 Bl., 383), *Bate vs. Gillett* (13 Fed. Rep., 553), and other cases, the Circuit Courts had adopted the second construction above referred to and had applied that rule to cases where the foreign patent had been prolonged, and held that the original term expressed upon the face of the said foreign patent

limited the United States patent notwithstanding such prolongation, and in *Holmes Co. vs. Metropolitan Co.* (21 Fed. Rep., 458) and *Paillard vs. Bruno* (29 Fed. Rep., 864), they applied the same rule to cases where the foreign patent had ceased to exist before the prescribed end of the term expressed on the face of the instrument, and held, as in the first case, that the term so expressed upon its face determined the duration of the United States patent, notwithstanding the actual determination of the said foreign patent before the end of the term of years named in the original grant.

After this came the case of *Bate Co. vs. Hammond.* In this case a prior Canadian patent had been granted for five years. Under the provisions of the Canadian law, which allowed that right to the patentee upon the payment of an additional fee, the said Canadian patent had been prolonged ten years. The Court below, in accordance with the rule established by the Circuit Courts, held that no notice could be taken of the prolongation and that the United States patent was consequently limited to five years from the date of the Canadian patent. The Supreme Court, overruling this decision, held that the prolongation should be taken into account, and that the United States patent was limited to fifteen years from the date of the Canadian patent.

What are the grounds for this reversal, as stated in the opinion of the Court ?

The opinion (italics not in original) first states the proposition of the appellant to be that the declaration of the statute under consideration "does not mean "that the patent so granted shall expire at the same "time with the term to which the foreign patent was in "fact limited at the time the United States patent was "granted; but that it means it shall expire *when the* "*foreign patent expires*, without reference to the limita- "tion of the term of such foreign patent in actual force "at the time the United States patent was granted,"

and states that the opinion of the Court upon this proposition is that the Bate United States patent does not expire before January 9th, 1892, "the time when the "Canadian patent No. 6938 will expire."

This statement is explicit, and to the effect that the controlling event which limits the United States patent is the actual expiration of the Canadian patent, and the conclusion that such was the meaning of the Court is strengthened by what follows.

After reciting the provisions of the statute the opinion proceeds:

"These provisions of the Act of 1870, and of the Re-"vised Statutes mean that the United States patent "shall not expire so long as the foreign patent shall "continue to *exist* * * * but shall continue in "force * * * *so long as* the foreign patent con-"tinues to *exist*."

This language directly implies that the American patent *shall* expire when the foreign patent *ceases* to exist.

The opinion then states that the view expressed by the Circuit Courts in the cases of *Henry vs. Providence Tool Co.*, *Reissner vs. Sharp*, and *Bate Co. vs. Gillett*, was contrary to the view thus set forth, and proceeds as follows:

"But we are of opinion, that, in the present case "where the Canadian Statute under which the exten-"sions of the Canadian patent were granted was in "force when the United States patent was issued, and "also when that patent was applied for, and where, by "the Canadian Statute the extension of the patent for "Canada was a matter entirely of right, at the option "of the patentee, on his payment of a required fee, "and where the fifteen years term of the Canadian "patent has been continuous and without interruption, "the United States patent does not expire before "the end of the fifteen years *duration* of the Canadian "patent."

The attempt has been made to draw several unwarrantable deductions from this language.

FIRST. It has been argued that the recital of the fact that the Canadian extension was obtainable as a matter of right, means that that is the controlling circumstance, and that the period that was intended to be taken as limiting the United States patent was not the actual "duration" of the Canadian patent, but the extreme period to which the patentee might have procured the patent to be extended, if he chose to pay therefor, without regard to the fact whether or not he actually procured such extension. In other words, that this Court meant to adopt the *third* proposed construction above stated.

This would be flatly inconsistent with the express language of the opinion and the gist of the whole decision. Whatever else may be doubtful, it is certainly clear that the fact that the Canadian Bate patent actually continued in force after the expiration of its first term of five years, is recited as at least, one of the very essential facts upon which the decision is based.

If this were not so, and *only* essential thing was the *right* under the Canadian law to have the patent extended, whether that right was actually exercised or not, then the emphatic recital of the actual and uninterrupted existence of the patent, as one of the essential facts upon which the decision is based, would not only be superfluous but misleading.

The recital that there must not only be an extension in fact of the first term of the patent, but that such extension must be in pursuance of a prior right thereto such as is bestowed by the Canadian law, or be granted under equivalent circumstances, is a *limitation.*

It merely distinguishes the case from one where the extention, by an entirely new exercise of the prerogative power, might be regarded as a grant, equivalent to a new patent.

It had been argued before the Supreme Court, that, under the Canadian law, the extension was, in effect, a new grant. This view the Court met and disallowed. The opinion at pages 165 and 166 discusses the Canadian law and states that under that law the original Canadian patent "has never ceased to exist but has been in force continuously," and that under the Canadian act, what was granted was "'an extension of the patent'—"the same patent—for a further term."

The contention here under consideration, which seeks to support the second construction above stated, is that the so-called "potential" term of the foreign patent limits the term of the United States patent. There are some further considerations showing the utterly untenable nature of this supposition, and its manifest inconsistency with the rule of *Bate Co. vs. Hammond.*

That case directly overrules *Henry vs. Providence Tool Co.* This fact cannot be denied because it is said that the latter case expresses a "contrary view" to that adopted by this Court in *Bate Co. vs. Hammond.*

Now, in what respect does *Henry vs. Providence Tool Co.* express and apply a "contrary view" to what is laid down in *Bates Co. vs. Hammond?* Simply as follows: The British patent in *Henry vs. Providence Tool Co.*, after the expiration of fourteen years, was extended by royal grant for four years.

This extension was granted in pursuance of a provision of the English law whereby a patentee might, before the expiration of his patent, petition for an extension on the ground that he had not received sufficient remuneration, and, if the judicial committee of the privy counsel reported favorably, the Crown might, if it saw fit, grant an extension for any period not exceeding fourteen years.

Upon this state of facts Judge CLIFFORD held that the fourteen years term limited the American patent. Upon what ground?

Upon the ground that in order to avoid *uncertainty,*

the Act of Congress must be construed to mean that Congress did not intend in limiting the United States by the foreign patent "to include any subsequent prolongation or extension of the monopoly beyond what was then vested in the foreign patentee," and "never intended to extend the term of the domestic patent beyond the legal term secured to the foreign patentee when the domestic patent was granted."

This Court in *Bate Co. vs. Hammond*, expresses its own view as to the meaning of the Act of Congress above referred to, and then says: "A contrary view to this," *i. e*, to which the Court has just stated, has been expressed in *Henry vs. Providence Tool Co.*, &c. Now, what is the view which the Court has just stated? It is as already quoted, in the following words:

"These provisions of the Act of 1870, and of the Revised Statutes mean that the United States patent shall not expire so long as the foreign patent," not *may* exist, but "*continues to exist*," and that it "shall continue in force * * * so long as the foreign patent *continues to exist*."

Can stronger language be used to show that not the term of the foreign patent in existence at the date of the United States patent, using that word in the sense of the length of time for which the right to enjoy the monopoly is then vested in the foreign patentee, is the limitation intended by the statute, but the term of the foreign patent in the sense of the period during which that patent shall as matter of fact *continue to exist?*

Observe that if the facts noted later on in the opinion in *Bate Co. vs. Hammond* as one of the circumstances in that case, namely, that the extension of the Bate patent was a matter of right on the payment of a fee, is an essential element in order to make the prolongation included in the limited term, then the decision in *Henry vs. Providence Tool Co.* was correct, because the extension of the foreign patent in that case was not a matter of right, but depended wholly upon the discre-

tion of the Crown, and the foreign patent actually continued to exist up to the full end of the term which the patentee might and did obtain as a matter of right, *viz.:* fourteen years, which was the term adopted by Judge CLIFFORD. It is, therefore, clear that not the *right* to prolongation on the payment of fees is the essential thing, but the continued existence of the patent under a prolongation, which either because it is granted as a matter of right on payment of fees, or by virtue of some other circumstance, must be regarded as a prolongation of the *same* patent. Notwithstanding the absence of a *right* to prolongation in *Henry vs. Providence Tool Co.*, and the fact that the prolongation in that case was evidenced by an additional instrument, this Court would seem to have regarded it as the prolongation of the patent. If they did not so regard it, and intended to hold that the decision in *Henry vs. Providence Tool Co.* was right, but the reasons for it wrong, then the case is still stronger for the view here insisted upon, because Judge CLIFFORD's reason for his decision was that in limiting the American patent the law looked to the right of enjoyment vested in the foreign patentee and not to the actual duration of his patent.

It will be noted that the case of *Gramm. Co. vs. Arnoux* (21 Bl., 450) was not overruled by the Supreme Court. In that case Judge BLATCHFORD, while using language which indicates that he gravely doubts the tenability of the rule he had himself felt constrained to follow in *Reissner vs. Sharp*, states the alternative rule, *viz.*, that the actual life of the foreign patent should control the life of the United States patent, and holds that, whether the former rule is right or not, the patent before him expired because the foreign patent had ceased to exist before suit brought.

In that suit the prior Austrian patent had been granted December 30, 1870, for the expressed term of one year, but had been extended year by year until

December 30th, 1880, when it had been allowed to lapse, although it might have been extended under the general law for five years more.

The Court said:

"It is contended for the plaintiff that the Austrian "patent, though granted 'for the duration of one "year' on its face, was really a patent for fifteen "years.

"It might have been prolonged, year by year or "otherwise, for five years beyond December 30, 1880. "But it was not prolonged beyond that date; and at "most, it cannot be regarded as a patent which, when "granted, had a longer term to run than till December "30, 1880, even if it could be considered as a patent "having, when granted, a longer term to run than one "year.

"A capacity of being prolonged so as to have a dura- "tion of fifteen years is not equivalent to having a term "of fifteen years when the patent is granted for one "year and then is prolonged so as to expire at the end "of ten years. At latest, the Austrian patent expired "December 30, 1880."

And, again:

"It was the manifest intention of Section 25 of the "Act of 1870, that the exclusive privilege under the "patent here should expire with the exclusive privilege "granted abroad to the same inventor having the "shortest term.

"As the Austrian patent expired, at the latest, on "December 30th, 1880, and before the suit was brought, "and No. 120,057 (the patent in suit) continued to ex- "ist no longer, there was no ground for this suit in "equity when it was brought."

Thus, in the Gramme suit the Circuit Court distinctly ruled upon and overruled the proposition of the plaintiff in that case, to the effect that it is the *potential* term of the foreign grant—that is, the maximum period for

which, under the general law of the foreign country, the foreign patentee had the *right* of protection, to be exercised at his option—which constitutes the measure as to duration of the right of protection here.

Another point decided by this Court in *Bate Co. vs. Hammond* leads to the same conclusion. The opinion not only states that, under the view which it adopts, the United States patent "is to be in force as long as the foreign patent is in force," but adds to that the statement that "the time of the expiration of the foreign patent may be shown by evidence *in pais*, either the record of the foreign patent itself, showing its duration, *or other proper evidence*." This necessarily means that it is competent, in determining the life of the domestic patent, to prove facts in the history of the foreign patent which are not part of the technical "record" of the patent, but which when proved will show that the foreign patent has expired, and the proving of which therefore will establish, also, the expiration of the domestic patent.

Such facts, being facts *de hors* the record of the patent, must be facts relating to the abridgement, lapsing or forfeiture of the patent, and facts which, because they have taken place subsequent to the grant of the domestic patent, could not be known at such date. It follows, of necessity, that the right which this Court recognizes, of proving the expiration of the foreign patent by giving evidence of facts pertaining to the lapsing of ferfeiture of such patent, is utterly inconsistent with the theory that Section 4887 must be so interpreted that the term of a patent coming within its purview shall be *fixed and at all times ascertainable*, even at and from the very day when the patent issues.

Second. It is claimed that the words "expire at the same time with the foreign patent" mean to cease to exist because of the completion, by lapse of time, of

a fixed period of years as distinguished from the sooner determination of the patent by forfeiture or the like.

"Expire," it is argued, means to come to an end by reason of the completion of the term of years for which the patent was granted, but does not denote the sooner determination of the patent by forfeiture or the like before the completion of said term. It is urged that *Bate Co. vs. Hammond* sanctions, or at least is not inconsistent with this distinction.

Several observations may be made upon this contention.

1st. It is not in consonance with the proper legal meaning of the language of the statute. The word "expire" is properly used to denote cessation by any means, as well by forfeiture or lapse, as by the mere efflux of time. Webster defines the word: "to come to an end; to cease; to terminate; to perish; to become extinct"—a meaning which obviously applies to the ending of the actual life of a patent by whatever means that end may come. An apt illustration of this meaning is given in *Bowman vs. Foot* (29 Conn., 331), where it is held the words "expire and terminate" were equivalent to the expression, shall become void.

There is nothing inconsistent with this meaning of the word "expire" as used in the phrase "expire at the same time with the foreign patent" in the early part of the sentence in Sec. 4887, here under consideration, and the use of the word "term" in the expression "having the shortest term," used in the last part of said sentence.

"Term" is constantly used to express a period, the end of which depends on an uncertain event, *e. g.*, the common expression "term of his or her natural life." So in real estate law, where it means actual life or duration as distinguished from a fixed period of time.

Says Blackstone:

"The word *term* does not merely signify the time "specified in the lease, but the estate also and interest

" that passes by that lease; and, therefore, the *term* " may expire during the continuance of the *time* as by " forfeiture surrender and the like.

" For which reason, if I grant a lease to A for the " term of three years, and, after the *expiration* of said " *term*, to B for six years, and A forfeits or surrenders " his lease at the end of *one* year, B's interest shall im- " mediately take effect" (Black. Com., Book II., Chap. 9, p. 144; italics in original except the italicizing of " expiration ").

Applying to the section under consideration the appropriate legal signification of its language, as above defined, and its meaning is that the United States patent shall "expire"—*i. e.*, cease to exist—"at the same time with the foreign patent"—*i. e.*, at the same time the foreign patent expires; *i. e.*, ceases to exist, either by the lapse of the *time* for which it was granted, or the end of its *term*, *i. e.*, its actual duration, which may be shorter than the time for which it was granted.

This meaning is in harmony with the decision of the Court. It held that the word "*term*" used in the phrase " the one having the shortest *term*" did not denote the time for which the Bate patent was originally granted, which was five years, but the period of its actual duration, which extended beyond said period of five years.

Moreover, the Court expressly held that where a United States patent was granted for seventeen years it might be shown by evidence *in pais* to have expired under the operation of § 4887 before the lapse of said seventeen years. This clearly shows that the " expiration " referred to in that section includes a sooner determination of the patent than one occurring because of the mere completion by lapse of time of the express term for which it was originally granted.

2ND. It is said that to adopt the rule that the actual cessation of the foreign patent for any cause whatsoever limits the United States patent leads to the inconven-

ience of uncertainty already mentioned, and to put this in a strong light numerous conditions subsequent by which foreign patents may be forfeited, are collected from the existing foreign patent laws.

It was solely this argument from inconvenience which led the Circuit Court to adopt the rule that has been expressly overruled in *Henry vs. Providence Tool Co.; Reissner vs. Sharp, and Bate Co., vs. Gillett;* and it was an argument which must have been deemed subordinate by this Court, to the consideration that it was the intention of the statute that the actual duration of the foreign patent should determine the actual duration of the grant here.

There certainly can be no reasonable doubt that if the Bate patent had not been extended beyond five years, or the foreign patent in *Henry vs. Providence Tool Co.* had not been extended beyond fourteen years, the corresponding United States patents would have expired at the end of said terms of five and fourteen years respectively. This, as already shown, is the obvious and necessary result of the rule of *Bate Co. vs. Hammond.* Yet this involves as much uncertainty as would be produced by limiting the United States patent by the expiration of the foreign patent by forfeiture or lapse for non-fulfillment of a condition precedent. What practical difference does it make as to the certainty of the duration of the United States patent, whether that duration depends upon the renewal of a term of years which may never take place or upon the lapse of the foreign patent at the end of a term of years, unless the foreign patentee shall do some act, which he may never perform. The result can be no more predicted in one case than in the other, and leads to no more inconvenience in one case than in the other.

And as to the inconvenience of being obliged to prove the duration of the United States patent by evidence *in pais*, this Court expressly rules that this may be done, and. moreover, that this evidence *in pais* need not be

simply *record* proof. The opinion states, as already quoted, that " the time of the expiration of the foreign patent may be shown by evidence *in pais*, either the record of the foreign patent itself, showing its duration, or *other proper evidence* " (p. 169).

And this " other proper evidence " as already shown would only be required in case it was necessary to prove a termination of the foreign patent by forfeiture or some similar way.

The argument from inconvenience is always to be applied with caution.

The statute under consideration relates to the same inventor taking out different patents in different countries, and if he does this it is no great hardship or inconvenience shat he should be held to the widely adopted ru.e, that having first patented his invention in one country, he cannot prolong his monopoly in other countries beyond the time when his first monopoly expires, or that the assignee of such an invention should stand in his shoes, or that United States patents for inventions previously patented abroad should have a duration only ascertainable by reference to the foreign patent. If reference is to be made to the foreign patent at all, it is generally no more difficult to ascertain when it was or may be forfeited than to ascertain when it has expired or may expire by reason of the completion of a fixed period.

The statute does not primarily affect American but foreign inventors. It is a restriction upon the privilege given to foreigners who have patented their inventions abroad to come here and patent their inventions as freely as native citizens may do, with this exception, they can get a patent here which is as good as their home patent but no *better*. It expires at the same time, and it is no more uncertain. It merely proceeds *pari passu* with it, and is, therefore, subject to the same uncertainty as to the actual term for which it will last, because all foreign patents are issued subject to condi-

tions subsequet, or with the privilege upon making certain payments of procuring successive terms, whereas the United States patent is issued without conditions subsequent, and for a single fixed term.

This uncertainty is no hardship to the foreign patentee. On the contrary, the provisions in the foreign law which allow him to have successive prolongations of his term on the payment of fees, are for his benefit. He need only pay for a short time, and, if he finds the invention does not pay, he can relinquish his patent and cease paying. Under our law the patentee must pay the whole fee for the whole term in advance.

There is certainly no reason, in view of all this, why such patentee should be permitted to get a longer or better patent here than his previous foreign patent, and thereby give foreign inventors in this country a privi- which is denied American inventors in foreign countries. As to American inventors who may wish to patent their inventions abroad, they may easily avoid the whole difficulty by taking out their patents here first which it was clearly the policy of this law, so far as it affects American inventors, to encourage them to do.

If they neglect this simple precaution and put themselves in the place of foreigners, it is right that they should suffer the disabilities of foreigners.

In brief it comes to this. The American patent is either limited by the term to which the foreign patent *may* last under the foreign law, without regard to its actual life—an hypothesis which is inconsistent with *Bate Co. vs. Hammond;* or it may be limited by the term expressed on the face of the foreign patent without regard to its actual life—which is also inconsistent with *Bate Co. vs. Hammond;* or it may be limited by the actual life of the foreign patent, which is alone consistent with *Bate Co. vs. Hammond*, and this actual life may be terminated by forfeiture as well as in any other way.

3d. But it is not necessary to decide the point last

made in order to decide this plea. Setting aside the forfeiture or lapse of the preceding French or German patents in the case, by reason of failure to work the invention, etc., they both came to an end by virtue of the expiration of their actual terms. Under the French and the German law a patentee may take out a patent for as long a term as he chooses to pay for, and he has the privilege of procuring succesive prolongations of that term, up to a certain prescribed limit, by the payment of certain specified fees. Now, his omission to keep his patent up is not, in its essence, a forfeiture. The fact that the patent is on its face for the whole number of years for which it *may* last, under such a provision of law, does not alter the *substance* of the transaction between the patentee and the government.

A forfeiture means the losing of something a man has already got. Where one, by paying a snm of money, gets the right to the enjoyment of the patent for a year, with the privilege of extending it after that term, if he chooses to pay the fee for such extension, he does not, by omitting to avail himself of that privilege, *forfeit* anything—he does not lose any term he has already had. All he ever got was a term for one year and an option. When he enjoyed the one year and exercised his option he got all he paid for, and it makes no difference whether, in the exercise of his option, he choose to pay a fee and take an additional term, or to pay no fee and not take an additional term. The choice of not taking an additional term, if he did not want to take and pay for it, is not a *forfeiture* but a *privilege*.

When this Court abandoned the theory that the number of years expressed upon the face of the patent when it was originally granted—*e. g.*, five years in the case of the Bate Canadian patent—was the controlling factor to limit the United States patent, and held that an actual duration *different* from that originally

expressed upon the face of the patent limited the United States patent, they adopted a rule of interpretation which must be universal. If the mere faat that a term of years is expressed upon the face of the patent is not conclusive in one case, it cannot be conclusive in any case. Therefore, the mere fact that the French or German patents in this case were expressed on their face to be for fifteen years is not conclusive. If the term thus granted was not an interest having any certain duration for fifteen years, the United States Statute, as now interpreted, looks only to the *fact*, and the fact is, that the patentee paid for an actual term for his foreign patents different from the terms expressed upon their face at the time of the grant, just as in *Bate Co. vs. Hammond* the patentee paid for an actual term different from that expressed upon the face of the Canadian patent at the time of its grant. In the latter case the United States patent was limited by the actual not the nominal term, and it is the natural and logical conclusion from that decision that the patent in this case is limited in like manner.

It is, therefore, submitted on behalf of Heyman that the foreign patent in this case, at all events, expired with the expiration of the terms which had been paid for; that their expiration at the end of those terms was not a forfeiture. If the duration of the foreign patent is to be measured by the terms, thereby meaning fixed periods of years, and disregarding forfeitures, such a rule of measurement, under *Bate Co. vs. Hammond*, applies only to actual, not nominal, terms—to terms during which the foreigh patent is in actual existence, not to terms during which it is *not* in actual existence.

If, therefore, this plea be not overruled because it fails to state that the patents therein mentioned were

either of them, the one having the shortest term, or that the French patent expired before suit brought, then the plea should be sustained and the judgment herein affirmed.

EDMUND WETMORE,
Counsel for H. S. Heyman.

WITTER & KENYON,
Of Counsel.

Office Supreme Court U. S.
FILED
JAN 6 1890
JAMES H. McKENNEY,
CLERK.

C. G. Burgoyne's Printing Business, 146-150 Centre St., N. Y.

Supreme Court of the United States.

CARL POHL and CHARLES ZOLLER,
Appellants,

AGAINST

THE ANCHOR BREWING COMPANY,
Respondents.

Brief in Support of the Petition of Nathan H. Heyman to be made a Party herein or for other Relief.

On the facts set forth in the petition, the petitioner Heyman is the actual, though not the nominal, party in interest in this suit, and the defendant, The Anchor Brewing Company, has no substantial interest therein.

It appears that the Anchor Brewing Company purchased from the petitioner, Heyman, a single infringing machine, which it has used. The said Heyman has manufactured and sold said machines to the public. He is the guarantor of the defendant, the said Anchor

Brewing Company, against the plaintiffs' claim, and has tendered all that the plaintiffs could have received if the machine had been sold by Zoller, the exclusive licensee, including the royalty agreed to be paid by Pohl, the patentee, together with interest and costs.

Under the authority of *Smith vs. Sands* (24 Fed. Rep., 470), it would appear that the plaintiffs are not, under these circumstances, entitled to an injunction, but that the tender of the royalty and profits which Zoller would have made, if he had sold the machine, will, in effect, license the machine and give the plaintiffs a complete remedy.

Allis vs. Stowell, 16 Fed. Rep., 783.
Perigo vs. Spaulding, 13 Bl., 391, 392.

This tender was made because both plaintiffs and defendant refused to permit the petitioner Heyman to intervene in the case for the protection of his interests. He is the only one to be seriously affected by the reversal of the decree, which could not fail to injure his business and cause further expense, even though the conduct of the defendant would preclude it from calling upon the petitioner to make good his guarantee for the sale of the single machine involved in this case. The facts set forth in the petition justify a motion to dismiss this appeal upon the ground that it presents substantially a moot case, but the petitioner can only be placed in a position to make such motion by becoming a party to the cause.

Section 4887 of the Revised Statutes provides that an American patent for an invention patented abroad "shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the *one having the shortest term.*"

The foreign patent "having the shortest term" in this case was an Austrian patent, originally granted for one year, renewed for a year, and expiring at the end

of said renewed term, before either the French or German patents expired, each of which was granted on its face for fifteen years, and expired by virtue of the nonfulfillment by the patentee of certain conditions subsequent.

The American patent in suit, therefore, had expired before the expiration of either the French or the German patent, the only ones set up in the plea. The said plea does not, in terms, state that either of said patents was the one having the shortest term of all the foreign patents, but it in effect so states, because it alleges that there being more than one foreign patent for the same invention the American patent expired by reason of the expiration of the Erench or German patent by virtue of the statute, *i. e.*, because one of said patents pleaded was the "one having the shortest term," whereas, as matter of fact, another patent, not pleaded, *viz.*, the Austrian, was the "one having the shortest term," and the patents pleaded had actually no effect whatever in limiting the American patent, and the question what *would* have been their effect if the patent had not already expired by virtue of the expiration of the Austrian patent is a purely hypothetical question.

In effect, the appellants and respondent herein insist on uniting in presenting this issue to the Court upon a partial statement of the actual facts in the case, for the purpose of obtaining the judgment of the Court upon a question of law which would not arise if the facts were fully stated. The petitioner does not join in this. On a full statement of facts, this litigation would be ended and the public finally and authoritatively advised that it may safely purchase the machine sold by the petitioner, and it would seem no more than just that he should have the opportunity to protect his interests in the premises.

The petitioner is not a necessary party herein, but he is, under the authorities, a proper party.

1 Dan. Ch. Pr., 281.
Shields vs. Barrow, 17 How., 130.
Williams vs. Bankhead, 19 Wall., 563.
Curran vs. St. Charles Car. Co., 32 Fed. Rep., 836.

The general rule is stated by Daniels to be that a person may be joined as party defendant where "in the event of the plaintiff succeeding in his object against the principal defendant, that defendant will thereby acquire a right to call upon him either to reimburse him the whole or part of the plaintiff's demand" (1 Dan. Ch. Pr., 281), *i. e.*, the guarantor of defendant is a proper party, and in the case of *Curran vs. St. Charles Car Company* (*supra*), the Court permitted the manufacturer of an alleged infringing machine to come in and be made a party of record in a suit brought against one of his customers. and it is in the power of the Court in such a case to allow a guarantor to intervene.

If it would not be possible or proper to permit such an amendment of the record in this Court, as would be involved by permitting the intervention of the petitioner and his filing a plea, it is submitted that it would be proper, the case being in this Court, to remand the record to the Court below for the purpose of enabling the petitioner to apply, in that Court, for leave to intervene. When the former petition to intervene was made in the Court below, a suit was pending against the petitioner himself in which it was possible to set up the defense of the Austrian patent and intervention in this suit was not regarded by the Court as necessary, but that suit has been discontinued by the plaintiffs, who thus virtually admit that the Austrian patent is a conclusive defense, and the petitioner has now no opportunity of bringing that defense to the attention of the Court unless by intervening in this cause.

In case the Court should be of the opinion that no other relief is possible, it is submitted that petitioner should be permitted to become a party herein, so far as to entitle him to be heard upon a motion to dismiss the appeal upon the grounds of the existence of the Austrian patent.

It is understood that no objection is made on behalf of plaintiffs to the filing of a brief on behalf of petitioner upon the hypothetical case presented by the pleas, but that is not adequate relief.

EDMUND WETMORE,
W. C. WITTER,
Of Counsel for Petitioner Heyman.

Office Supreme Court U. S.
FILED
JAN 6 1890
JAMES H. McKENNEY,
CLERK

Supreme Court of the United States.

CARL POHL and CHARLES ZOLLER,

v.

ANCHOR BREWING COMPANY.

Please take notice that on Monday, January 6th, 1890, at twelve o'clock noon, or as soon thereafter as counsel can be heard, in the Court Room, in the Capitol at Washington, D. C., we will move this Honorable Court to grant the prayer of the petition of N. H. Heyman heretofore filed, a copy of which is hereto annexed, and for such other and further relief as to the Court may seem meet.

Respectfully,
WITTER & KENYON,
EDMUND WETMORE,
For the Petitioner.

To JAMES M. DEUEL, Esq.,
Appellant's Solicitor;
CLARENCE A. SEWARD, Esq.,
Appellant's Solicitor and of Counsel;
GROSVENOR P. LOWERY, Esq.,
Appellant's Solicitor and of Counsel;
CHARLES A. HESS, Esq.,
Appellee's Solicitor and of Counsel;
WM. J. TOWNSEND, Esq.,
Appellee's Solicitor and of Counsel.

SUPREME COURT OF THE UNITED STATES.

CARL POHL and CHARLES ZOLLER

v.

ANCHOR BREWING COMPANY.

Please take notice that we hereby amend the notice heretofore served upon you so that it shall read as follows:

Please take notice that on Monday, January 6th, 1890, at twelve o'clock noon, or as soon thereafter as counsel can be heard, in the court room, in the Capitol at Washington, D. C., we will move this Honorable Court for leave to file the petition of N. H. Heyman, a copy of which has been heretofore served upon you, and for such other and further relief as to the Court may seem meet.

And you will further please take notice that the petition referred to, copy of which has heretofore been served upon you, has been amended by inserting on the second page thereof, after the words "machine sold," at the end of the first paragraph, the following words: "And the said Zoller is a manufacturer and seller of brewers' supplies, and has used said invention only by making said machines and by advertising and selling them to the public."

New York, Dec. 31, 1889.

Respectfully,

WITTER & KENYON,
EDMUND WETMORE,
For the Petitioner.

To JAMES M. DEUEL, Esq.,
Appellants' Solicitor;
CLARENCE A. SEWARD, Esq.,
Appellants' Solicitor and of Counsel;
GROSVENOR P. LOWERY, Esq.,
Appellants' Solicitor and of Counsel;
CHARLES A. HESS, Esq.,
Appellee's Solicitor and of Counsel;
WM. J. TOWNSEND, Esq.,
Appellee's Solicitor and of Counsel.

Supreme Court of the United States.

CARL POHL AND CHARLES ZOLLER

vs.

ANCHOR BREWING COMPANY.

Petition of N. H. Heyman.

WITTER & KENYON,
EDMUND WETMORE,
For Petitioner.

SUPREME COURT OF THE UNITED STATES.

1

CARL POHL and CHARLES ZOLLER,
Appellants and Complainants,

against

ANCHOR BREWING COMPANY,
Respondent and Defendant.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

2

The petition of Nathan H. Heyman respectfully showeth:

That this suit was brought in the United States Circuit Court for the Southern District of New York, against the defendant, the Anchor Brewing Company, for infringement of Letters Patent of the United States, Number 213,447, dated March 18th, 1879, for a barrel and cask scrubbing machine.

That your petitioner is the manufacturer of the machine, the use of which is claimed to be an infringement of said patent, and sold the same to the defendant above named, which is a brewing company, doing business in the Southern District 3
of New York, and uses the said machine for the cleaning and scrubbing of beer barrels and kegs.

Your petitioner resides in the city of New York and has been engaged in business in the city of New York for a number of years as a manufacturer

4 of brewers' supplies. Among other articles of this kind, he has made and sold for several years the machine in question. The complainant, Carl Pohl, who, as your petitioner is informed, resides near Berlin, Germany, is the patentee and owner of the legal title of said patent, and the complainant, Charles Zoller, is the exclusive licensee under said Letters Patent by virtue of a contract of license on record in the Patent Office, Liber Z 36, page 486, whereby the said Zoller agrees to pay a royalty of twenty-five dollars on each machine sold.

Prior to January 23, 1888, the said Zoller claimed that the machines sold by your petitioner were infringements of the said Letters Patent, and on the
5 last mentioned date began suit against your petitioner in the United States Circuit Court for the Southern District of New York, for the said alleged infringement. Your petitioner answered said suit, issue was joined and the testimony therein partly taken, when your petitioner, after the decision of this Court in the case of *Bate Refrigerating Company* v. *Hammond*, 129 U. S., p. 151, made a motion before his Honor Judge Wallace in the said Circuit Court for leave, by proper amendment of the pleadings, to set up the expiration of two prior foreign patents, to wit, a French and a German patent, as a bar to the suit in equity, upon the ground that by virtue of section 4887 of the Revised Statutes, as
6 construed in said case of *Bate Company* v. *Hammond*, the patent in suit had expired before the bill therein was filed. Upon that motion, as your petitioner is informed, his Honor Judge Wallace stated that he entertained doubts whether the rule laid down in *Bate Co.* v. *Hammond* extended to the case of the expiration of a foreign patent *by forfeiture*, and should be inclined so to hold. Your petitioner's counsel thereafter declined to set up said patents, having received information that there was reason to believe that there had been granted a foreign patent (to wit, an Austrian patent) of prior date to the United States patent, which had not been for-

feited, but had expired because not renewed beyond 7
the first term for which it was originally taken, and
therefore fell apparently directly within the doctrine
of *Bate Co.* v. *Hammond.*

As your petitioner is informed, the doubt expressed by his Honor Judge Wallace, whether the case of *Bate Co.* v. *Hammond* extends to a case of the limitation of an American patent by the expiration of a prior patent for non-fulfillment of the conditions upon which it was granted became known, and was the subject of comment among those engaged in the practice of the patent law in New York and interested in such matters.

At that time one of the Canadian patents of the
Edison Electric Light Company, obtained prior to 8
an American patent for the same invention, had
been judicially declared forfeited in Canada by
virtue of an unlawful importation of the invention
into that country, and when it became evident that
your petitioner would not set up said foreign
patents which had expired by reason of non-
payment of annuities (to wit, the French and the
German patents), in answer to said suit against him,
this suit was instituted against the present defend-
ant, the Anchor Brewing Company, in which the
complainant's solicitor was the same as in the suit
against your petitioner, but in which Messrs.
Seward and Lowery, who are also counsel for the
Edison Company, appeared as counsel for the com- 9
plainant.

The Anchor Brewing Company never bought but one machine from your petitioner, the price of which was three hundred dollars net, and the bill against your petitioner demanded an account for profits and damages for all the machines he had sold, including said machine sold to said Anchor Brewing Company.

Your petitioner guaranteed his customers, and the said Anchor Brewing Company in particular, against any claims which might be made against it

4 of brewers' supplies. Among other articles of this kind, he has made and sold for several years the machine in question. The complainant, Carl Pohl, who, as your petitioner is informed, resides near Berlin, Germany, is the patentee and owner of the legal title of said patent, and the complainant, Charles Zoller, is the exclusive licensee under said Letters Patent by virtue of a contract of license on record in the Patent Office, Liber Z 36, page 486, whereby the said Zoller agrees to pay a royalty of twenty-five dollars on each machine sold.

Prior to January 23, 1888, the said Zoller claimed that the machines sold by your petitioner were infringements of the said Letters Patent, and on the
5 last mentioned date began suit against your petitioner in the United States Circuit Court for the Southern District of New York, for the said alleged infringement. Your petitioner answered said suit, issue was joined and the testimony therein partly taken, when your petitioner, after the decision of this Court in the case of *Bate Refrigerating Company* v. *Hammond*, 129 U. S., p. 151, made a motion before his Honor Judge Wallace in the said Circuit Court for leave, by proper amendment of the pleadings, to set up the expiration of two prior foreign patents, to wit, a French and a German patent, as a bar to the suit in equity, upon the ground that by virtue of section 4887 of the Revised Statutes, as
6 construed in said case of *Bate Company* v. *Hammond*, the patent in suit had expired before the bill therein was filed. Upon that motion, as your petitioner is informed, his Honor Judge Wallace stated that he entertained doubts whether the rule laid down in *Bate Co.* v. *Hammond* extended to the case of the expiration of a foreign patent *by forfeiture*, and should be inclined so to hold. Your petitioner's counsel thereafter declined to set up said patents, having received information that there was reason to believe that there had been granted a foreign patent (to wit, an Austrian patent) of prior date to the United States patent, which had not been for-

And the said Zoller is a manufacturer and seller of brewers' supplies, and has used said invention only by making said machines, and by advertising and selling them to the public.

feited, but had expired because not renewed beyond 7
the first term for which it was originally taken, and therefore fell apparently directly within the doctrine of *Bate Co.* v. *Hammond.*

As your petitioner is informed, the doubt expressed by his Honor Judge Wallace, whether the case of *Bate Co.* v. *Hammond* extends to a case of the limitation of an American patent by the expiration of a prior patent for non-fulfillment of the conditions upon which it was granted became known, and was the subject of comment among those engaged in the practice of the patent law in New York and interested in such matters.

At that time one of the Canadian patents of the Edison Electric Light Company, obtained prior to 8
an American patent for the same invention, had been judicially declared forfeited in Canada by virtue of an unlawful importation of the invention into that country, and when it became evident that your petitioner would not set up said foreign patents which had expired by reason of non-payment of annuities (to wit, the French and the German patents), in answer to said suit against him, this suit was instituted against the present defendant, the Anchor Brewing Company, in which the complainant's solicitor was the same as in the suit against your petitioner, but in which Messrs. Seward and Lowery, who are also counsel for the Edison Company, appeared as counsel for the com- 9
plainant.

The Anchor Brewing Company never bought but one machine from your petitioner, the price of which was three hundred dollars net, and the bill against your petitioner demanded an account for profits and damages for all the machines he had sold, including said machine sold to said Anchor Brewing Company.

Your petitioner guaranteed his customers, and the said Anchor Brewing Company in particular, against any claims which might be made against it

16 Your petitioner was heard by counsel upon the said argument, and thereafter the said plea was sustained, the Court holding that the expiration of the said French and German patents, by reason of the non-fulfillment of conditions subsequent, limited the American patent, as appears by the opinion delivered in said case, reported in 39 Fed. Rep., p. 782.

This appeal was thereupon taken by the complainants to this Court, and the suit in the Court below against your petitioner, in which he had obtained leave to set up and had set up the expiration of said Austrian patent, was discontinued by the complainants therein tendering and paying
17 costs and voluntarily discontinuing the suit. A motion was then made to advance this appeal upon the calendar of this Court, of which motion your petitioner had no notice, which motion was denied.

Your petitioner has been informed that since the denial of said motion to advance, the proposition has been made to submit the cause upon written briefs under the rule by Jan. 14, 1890, to which, as your petitioner is informed, counsel for defendant and appellee propose to assent. That your petitioner, through his solicitors, has tendered to the complainants herein, as guarantor of the defendant, all the profit which the said Zoller would have received if he had sold the
18 said machine to the Anchor Brewing Company, and the royalty payable to the complainant Pohl, and all the damage which the complainants have suffered, together with interest and costs, as appears by the letter of your petitioner's solicitors to the complainant's solicitor in this cause, a copy of which is hereto annexed.

That if the judgment in this case in the Court below is reversed, it will put your petitioner to great expense and will be a far greater injury to him than to the said Anchor Brewing Company, the respondent herein, and your petitioner is desirous of having this cause argued orally.

Wherefore, your petitioner prays: 19

First.—That as the guarantor of the defendant, he may be permitted to intervene as a party respondent in this appeal.

Second.—That if not allowed to intervene, he may be permitted through his counsel to be heard in oral argument herein.

Third.—That if not allowed to intervene or to be heard in oral argument, he may be permitted through his counsel to file a brief herein.

Fourth.—That he may have such other or further relief in the premises as may be just. 20

And your petitioner will ever pray,

N. H. HEYMAN.

N. H.

W. C

21

22 STATE OF NEW YORK, County of New York. } ss.:

N. H. HEYMAN, being duly sworn, deposes and says, that he has read the foregoing petition and knows the contents thereof, and that the same is true of his own knowledge except as to the matters stated to be alleged on information and belief, and as to those matters he believes the same to be true.

N. H. HEYMAN.

Subscribed and sworn to before me, this 28 day of ~~November~~ December, 1889.

23

[SEAL.] Alan D. Kenyon
Notary Public,
N. Y. Co.

STATE OF NEW YORK, County of New York. } ss.

N. H. HEYMAN, being duly sworn, deposes and says that he has read the foregoing petition as amended by inserting the following words on page 2 after the words "machine sold"

"and the said Zoller is a manufacturer and seller of brewers' supplies and has used said invention only by making said machines and by advertising and selling them to the public."

and knows the contents thereof, and that the same is true of his own knowledge except as to the matters stated to be alleged on information and belief, and as to those matters he believes the same to be true.

N. H. HEYMAN.

Subscribed and sworn to before me, this 31st day of December, 1889.

JAMES R. TORRANCE,
Notary Public, Kings Co., N. Y.
[SEAL] Certificate filed N. Y. Co.

32 PARK PLACE,
NEW YORK, May 29th, 1889.

Messrs. HESS & TOWNSEND,
206 Broadway.

Dear Sirs:—We believe you are already informed of the fact that we have, within the past few days, received proof of the existence of an expired Austrian patent, granted for the same invention as the patent upon which suit has been brought by Carl Pohl and Charles Zoller against the Anchor Brewing Company, in which you are solicitors for the defendant. We have a certified copy of the Austrian patent showing that it expired on the 19th day of April, 1879, which is open to your inspection.

We are also informed that the plea already filed in this suit only sets up the expiration by forfeiture of two prior patents, one German and one French, but contains no reference to the Austrian patent above referred to, and that this plea, which does not mention the Austrian patent, is set for hearing on the 4th day of June next.

We represent Mr. Heyman, the maker and seller of the machine, for the use of which the Anchor Company is sued, and his interests would be injuriously affected by the hearing of the plea without the interposition of the Austrian patent. As the Austrian patent in question is the one contemplated by the statute having "the shortest term," and had already expired before the bill was filed, it constitutes a complete answer to the suit, and we accordingly request that immediate steps be taken so that it may presented to the Court at the same with the questions raised by the French and German patents, which have now, as we understand the case, become in effect merely moot questions.

As already stated, we make this request on behalf of our client, Mr. Heyman, who is interested in the result, and we tender you all the assistance in our power to procure the prompt interposition of this defense. As the time for action in this matter is short, we will esteem it a favor if you will return as prompt a reply to this request as is consistent with your convenience.

Respectfully yours,
WITTER & KENYON.

28 MAY 29th, 1889.

Messrs. WITTER & KENYON,

32 Park place.

Gentlemen: Your favor of the present date is just at hand, and in answer we have to say, that we have already had the facts relating to the Austrian patent to which you refer, brought to our attention and have requested the solicitor for the complainant in the case against the Anchor Brewing Company to consent to an amendment of the defendant's plea whereby the facts relating to the Austrian patent could be presented to the Court at the time of the
29 hearing on the 4th day of June, but he refuses to allow such an amendment.

We have, however, made arrangements with him that in case the present plea should not be sustained, we may then plead the Austrian patent and its expiration. This we have concluded would fully protect the Anchor Brewing Company, and we think also the interest of your client, without resulting in the delay which would follow a motion to obtain leave to amend the plea, and which we are satisfied would result in compelling us to be at the expense of a trial when we think the whole question can be decided upon the hearing of the plea.

Yours very truly,

30 HESS & TOWNSEND.

CARL POHL *et al.*,
v.
ANCHOR BREWING CO.

NEW YORK, December 26th, 1889.

MR. J. M. DEUEL,
Solicitor for Complainant,

Dear Sir: Our client, Mr. N. H. Heyman, is interested as the real though not the nominal party in the case of Pohl *et al.* v. Anchor Brewing Co., now pending on appeal before the Supreme Court of the United States, inasmuch as he is the maker of the single machine, the use of which by the Anchor Brewing Co. is the sole subject matter of the controversy in that case, and as the guarantor of the Anchor Brewing Co. to hold it harmless from any charge or suit for infringement of the Pohl patent there sued on.

We hereby tender to you on behalf of Mr. Heyman as such guarantor, the total amount of the profit that Charles Zoller (complainant and appellant) would have received if he instead of Mr. Heyman had sold the machine in controversy to the Anchor Brewing Co., and the total amount of his damage by reason of the fact that he did not make the sale and in addition thereto the full amount of the royalty which Carl Pohl (complainant and appellant) would have received if Charles Zoller instead of Mr. Heyman had sold the machine to the Anchor Brewing Co., together with interest on these sums and costs—this to be of course without prejudice to Mr. Heyman in any action which may hereafter be brought against him or against any other of his customers for infringement of said Pohl patent, and the exact amount of such profits, damages, license fee, interest and costs to be determined by three arbitrators, one chosen by yourself, one by us and the third by those two. As such profits, damages, license fee and interest on same, we hereby tender the sum of three hundred dollars, costs to be determined in the usual way.

Respectfully yours,
WITTER & KENYON.

Office Supreme Court U. S.
FILED.
FEB 16 1900

C. G. Burgoyne's Printing Business, 146-150 Centre St., N. Y.

Supreme Court of the United States.

CHARLES POHL and CHARLES ZOLLER,
Appellants,

vs.

THE ANCHOR BREWING COMPANY,
Respondents.

Brief of Appellants in Response to the Brief filed herein on behalf of one Nathan L. Heyman by special leave of the Court.

I.

By an order of this Court leave was granted to Nathan L. Heyman, who is not a party to the suit, to file a brief in support (as is supposed) of the judgment of the Court below, from which this appeal is taken. This favor was granted because of the great importance of the question involved in the appeal, and the far-reaching consequences of its determination, and the asserted interest therein of Mr. Heyman.

The parties to the record and all other participants in the discussion had purposely waived all questions

of the sufficiency of the pleadings, whether of form or substance, in order to present the vital question of the suit, to wit, the true construction of Sec. 4887 of the Revised Statutes, upon the construction of which all material questions of the case depend. Upon this condition of things the Circuit Court treated the case as all parties desired, by considering the single question submitted, and passing upon that alone.

The record brings up the case precisely as submitted to that Court, and *no party thereto* now raises any question as to the sufficiency of the pleadings or issues, either in form or substance.

But this new comer, permitted *ex gratia* to file a brief supposably in support of the judgment, at once attacks it for divers alleged defects of form or substance in the pleadings, and seeks to reverse the judgment, or rather, perhaps, to prevent the decision of the important question involved, and submitted both here and in the Court below as the sole question by all the parties to the suit.

We respectfully submit that Mr. Heyman's attempt is an abuse of the hospitality of the Court.

Mr. Heyman, who comes here by special grace, has no right to assail the judgment or the record because of any matter or defect, either of substance or form, which the parties thereto have waived. The parties to the record alone have the control of the suit and its appeal so far as relates to all questions of form, regularity or sufficiency, if enough be shown in the pleadings to give the Court jurisdiction of the controversy. Perhaps such an intervenor as Heyman might be heard to assert absolute want of jurisdiction in the Court of the subject matter involved, but even that objection, if curable by consent of the parties to the record, by inserting new or further averments of admitted jurisdictional facts, would not be available to an outsider, because the Court would not

hesitate to allow amendments to be made in the interests of justice.

The parties alone have control of all curable questions of form or sufficiency of pleadings and proceedings, except in cases where the Court sees fit to interfere for their correction. Therefore, the attack upon the pleadings made by Mr. Heyman, whether well or ill taken, should not be regarded by the Court, because it is in excess and abuse of the favor granted to him, and because such questions can only be raised by parties to the suit, and in this case all such parties have waived them.

We do not, therefore, discuss the questions made by Mr. Heyman as to the form and sufficiency of the plea, because, first, we regard the plea as good by intendment after judgment, and at this stage, even if it might have been held insufficient on special demurrer or on presentation of those questions below; second, because the parties to the suit, who alone could have raised such questions, have purposely waived them; and, thirdly, because Mr. Heyman is not at liberty to raise such questions or any question not relating to the one in which alone he has an indirect interest; and, fourthly, because the counsel who now seeks to raise these questions on behalf of Heyman appeared and argued the case at Circuit in behalf of the defendants of record (as appears at fol. 27, page 16, of the Record), without suggesting the alleged defects; and should not now be permitted on behalf of a stranger, to attack the judgment he obtained by asserting that the case presents only "moot questions."

II.

The section of the Revised Statutes (4887) now under consideration is in the following words: "No per-

son shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

By Section 16 of the Act of March 2d, 1861, now embodied in Sec. 4884 of the Revised Statutes, the term of all American patents is fixed at seventeen years, without power of extension (Siemens vs. Sellers, 123 U. S., 2-5).

That being the normal statutory term of all American patents, that section would have applied to patents issued under Sec. 4887, and they would all have had a fixed term of seventeen years under it, if Congress had not applied to some of them another rule for the admeasurement of their terms. It was with that intent only that Congress enacted the provisions of Section 4887 touching the terms of patents when the invention had been first patented in a foreign country. The terms for which such patents should run was the precise subject under consideration. It was seen, of course, that if the statutory term of seventeen years was left to apply in all cases, the American patent would, in most cases, have a longer term than the foreign patent, while in other cases, if the term of the foreign patent was made the universal rule, the American patent issued under this section might exceed the seventeen years of our general statute. How to obviate this result and at the same time provide a rule by which the terms of the American patents issued under Section 4887 should be definitely fixed *by law* at the

time of their issue, as all other American patents are, was the object in view. The *limitation of the terms* was the exact subject occupying the legislative mind, and for the purpose of resolving it Congress adopted the language now under consideration.

"But every patent granted for an invention which has been previously patented in a foreign country shall be *so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term*, and in no case shall it be in force beyond seventeen years."

The phraseology of this provision has precise reference to the subject of fixing the term. And in that sense it declares that every patent issued under this section "*shall be so limited*" as to expire at the same time with the foreign patent.

If this language stood alone it would clearly indicate its reference to the *term* of the foreign patent, for the words "*so limited*" refer to some *existing limit* of the foreign patent then so fixed and ascertainable as to point out the time *when it shall expire* by force of its limit as declared by the instrument itself. The act brings the two patents, the foreign and American, together for the purpose of *limiting* the term of the one by the other, and imposes the limit of the former upon the latter by ascertainment of the actual term it has to run, and thus making the terms *expire* simultaneously. The words "so limited" are not in any just sense referable to forfeitures, penalties, defaults or contingencies that may possibly happen. They refer to a period that is certain or may be reduced to certainty, as this Court held in the Bate case. But when we read this language in connection with the residue of the sentence all doubt seems to disappear—"*Shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.*"

Now, is it not manifest that the limitation by expiration is one and the same thing, whether there be one foreign patent or more than one? Are not the words "shall be so limited as to expire at the same time," applicable where there is more than one patent to the second branch of the sentence with the same force and meaning as when applied to the first? So read, who can doubt their significance and intent?

"*Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire,* * * * *if there be more than one, at the same time with the one having the shortest term.* The whole intent of the provision is couched in these words, and nobody would doubt, it seems to us, if the section so read that the words "so limited as to expire" have reference to the term to be granted to the American patent and its limitation by the term which has been granted to the foreign patent. But if ingenuity can frame a doubt upon the subject is it not at once dispelled by the closing language of the sentence, "*and in no case shall it be in force more than seventeen years.*"

What do these words mean? Clearly they have regard to the general statute which fixes and limits the term of American patents in all cases at seventeen years; and they declare that in fixing a term or limit of a patent issued in a case provided for by Sec. 4887, it shall be so done that in no case shall the maximum term of original American patents be exceeded; but in all cases where the term of the foreign patent is less than such maximum, the term of the American patent shall be *so limited* as to expire with the term of the foreign patent, or with the shortest term, if there be more than one.

But for the restriction of seventeen years the term under Sec. 4887 might exceed the term of the general statute, because a foreign patent may, in some cases, have a term of twenty years, and if the application be

made shortly after its issue, then the provision of Sec. 4887 would give a term perhaps of nineteen years or longer, unless restrained by the last limitation of Sec. 4887.

A careful study of the provisions of the section (4887) in connection with our general statute limiting terms of patents, seems to us to leave no question that the intent of Congress, in enacting that section, was simply to provide that a patent issued under it shall in all cases be limited by the unexpired term of the foreign patent, if but one ; but if more, then by the unexpired term of the shortest, and shall expire therewith—unless in any case such term would give the American patent more than seventeen years, in which case seventeen years shall be the limit.

This construction gives full scope to every portion of the section and introduces nothing foreign to its manifest purpose ; and the settled rules and principles upon which statutes are construed require this to be done.

III.

The *normal term* of patents issued under Sec. 4887 is seventeen years by force of Sec. 4884, unless shortened by the unexpired term of a controlling foreign patent which has less than seventeen years to run ; in in which case such unexpired period becomes the substituted and fixed term of the American patent.

To illustrate : Suppose the foreign patent has been issued by Belgium, where the statutory term is twenty years, and within a year or less the patentee or owner applies under Sec. 4887 for an American patent, which is awarded to him for the full normal term of seventeen years, as limited by Sec. 4884, because the Belgian patent being for more than seventeen years, and having

more than that period yet to run does not at all affect the American patent.

Upon the term of the American patent the term of the foreign patent has no operation whatever; because to so limit the term of the American that it "shall expire with the foreign patent, is to make it nineteen years instead of our *maximum* of seventeen years. We therefore, in the supposed case have an American patent issued by virtue of Sec. 4887, wholly governed by of our own laws and not at all affected in respect of its term by the foregn patent because limited by Sec. 4887 to the normal term of our general statutes (Sec. 4884).

But suppose of the twenty years term of the Belgian patent five years have already run, so that it will expire at the end of fifteen years. On that fact, Sec. 4887, instantly operates, by "*so limiting*" the term of the American patent that it also will expire at the end of fifteen years—that is, *with the Belgian patent.* Here Sec. 4887 has its direct and immediate effect, to wit, the reduction of the American patent from its normal term of seventeen years to the measure of the foreign patent as then existing, to wit, fifteen years. In such a case we insist the language and intention of the section are fully satisfied, because they look only to a thing to be *done and finished* at the time the patent is granted. But Section 4887 also contemplates that there may be another condition of things, and for that condition it also provides. There may be several foreign patents having different terms or issued at different times so that lapse of time has diminished the period of the original term. In that case the section makes inquest to ascertain which of the several patents has the shortest term to run. The sole object of doing this is to fix the term of the American patent at the time of its issue.

It finds, we will suppose, three foreign patents—a Belgian one for twenty years, a French one for fifteen years and an English one for fourteen years. Appa-

rently the English one has the shortest term and controls; but the dates of their issue show that the Belgian patent has already run seven years, the French one but a year and the English patent has just been issued. The mathematics of the statute speedily determine that the Belgian patent is the one having the shortest time to run, and instantly it fixes the Belgian as the one that must measure the term of the American and therefore the American patent is so limited as to expire at the same time with the Belgian patent, because that is the one having the *shortest term*. The statute commits no errors. It ascertains and determines contemporaneously with the issue of its patent and impresses upon that instrument when it is granted the exact period of its term, whether that term be written in it or not; and that done it becomes an American patent for the ascertained term, governed wholly by American laws. Hence, in the case just supposed the Belgian patent is found to be the shortest and the American takes the remaining term and is limited to expire with it.

IV.

If Congress meant to provide a system of forfeitures, penalties and punishments for American patentees by Sec. 4887 it is inconceivable that it should not have so declared in plain and explicit terms. Such a system would operate wholly on the American patent and not at all upon the foreign one. The intention could have been easily expressed in a few words, which would have advised applicants of their dangers and perils. Words like these, "If for any cause the foreign patent shall be forfeited or cease to protect the invention before its term shall expire this patent shall also terminate," or

some similar expression would have been used. Courts never construe doubtful statutes so as to bring within their terms penalties, forfeitures or offenses not clearly embraced in their language.

Bonell vs. Griswold, 80 N. Y., 128.

"It is a universal rule in equity never to enforce either a penalty or forfeiture."

Sec. 1319, Story Eq., 775.
Marshall vs. Vicksburg, 82 U. S., 146, 149.

"Forfeitures are not favored in law. They are often the means of great oppression and injustice (per BRADLEY, J., Insurance Co. vs. Norton, 96 N. Y., p. 242), and slight acts of waiver are accepted as sufficient to avoid them."

Insurance Co. vs. Wolf, 95 U. S., 326.
Insurance Co. vs. Eggleston, 572, 577.

Our Courts will not enforce the forfeitures of foreign laws when their imposition operates in any sense injuriously to our own citizens or residents within our jurisdiction. Our tribunals deal only with the rights and property, in respect of patents, created by our own laws and operating within our own jurisdiction.

In disregard of the spirit of these general rules and principles this Court is asked first to so construe one of our own statutes as to import therein a system of forfeitures and penalties imposed by a foreign country in case of the failure or neglect of a patentee of such foreign country to comply with its laws in respect of payment of taxes or of working the patent in that country, and to declare that an apparent forfeiture or failure under such laws operates to terminate and destroy rights and property in respect of the same invention acquired under our statutes and held in our country. This should never be done except under the most direct and positive injunctions of statutes, regulated by careful protective restrictions and provisions.

VI.

A very labored effort is made to show that this Court in the Bate case passed upon and decided this question of construction.

The sole question of that case was: What was the term of the Canadian patent which Section 4887 adopted and fixed for the American patent?

The Canadian statutes create for patents a term of fifteen years, to which term the patentee acquires a vested legal right. Of that term it permits him to take the whole at once, or an installment of five years and pay proportionally therefor; and at his own will repeat such installment at or before the expiration of the five years until the whole term of fifteen years shall be exhausted.

Bate had taken and paid for the first and second installments, and the question was whether Section 4887 of our statutes limited the term of an American patent for the same invention to the first period of five years taken under the Canadian patent, or extended to and included the whole term of fifteen years to which Bate had acquired a vested legal right.

The Court held that the American patent was measured by the vested legal right of Bate under his Canadian patent—that is, to fifteen years.

In such a case the question involved in this case could not be decided. The judgment of each case decides the law of its own facts. The eminent jurist who pronounced the opinion in the Bate case had no such question as ours present in his mind, and certainly had no intention of prejudging it if he had. His language is to be read in connection with the case before him, and is not to be distorted to apply to cases not within the case before him. The question "What is the term of the Canadian patent to which the limitation of Sec. 4887 applies" did not involve the other ques-

tion : does that section mean to so limit its patent as to expire with the term of the foreign patent, or upon some intervening omission or neglect which may effect temporarily or finally its monopoly in its own country? We insist it means the former and that alone ; for the question before Congress was, how much of the seventeen years given by Section 4884 shall we prescribe for the patent allowed by Section 4887? The answer which we say Congress made is : "So much as remains of the term granted by the foreign patent, or if there be several patents, to the shortest of them ; but not exceeding the term of seventeen years.

Congress may impose upon an American patent such consequences resulting from the defaults or omissions of duty by owners of the foreign patent as it sees fit, but it has not done so by Section 4887.

Respectfully submitted,

GROSVENOR P. LOWREY,
B. F. THURSTON,
CLARENCE A. SEWARD,
J. M. DEUEL,
For Appellants.

NOAH DAVIS,
On behalf of Edison Electric Light Co.

Township 15 N. Range 13 E 6th Prin. Mer.

NEBRASKA.

Township 15 N. Range 14 W 5th Prin. Mer.

IOWA

MISSOURI RIVER

MEANDER Cor. No 10

MEANDER Cor. No 9

NEBRASKA MEANDER Mo RIVER 1856

IOWA MEANDER Mo RIVER 1851

GOVERNMENT LOT 1 63 22/100 Ac

GOVERNMENT LOT 2 63 18/100 Ac

GOVERNMENT LOT 3 69 22/100 Ac.

GOVT LOT 4 47 28/100 Ac

GOVT LOT 1 36 28/100 Ac SEC. 20

GOVT LOT 2 38 18/100 Ac SEC 20

GOVERNMENT LOT 3 - 51 1/100 Ac.

SECTION 20

SECTION 29.

MEANDER Cor. No 8

MEANDER Cor. No 7

MISSOURI RIVER

NEBRASKA MEANDER Mo RIVER 1856

IOWA MEANDER Mo RIVER 1851

MEANDER Cor. No 6

MEANDER Cor. No 5

7 1/10 CH

SECTION 10

SHERMAN AVE.

OMAHA

Exhibit "A"

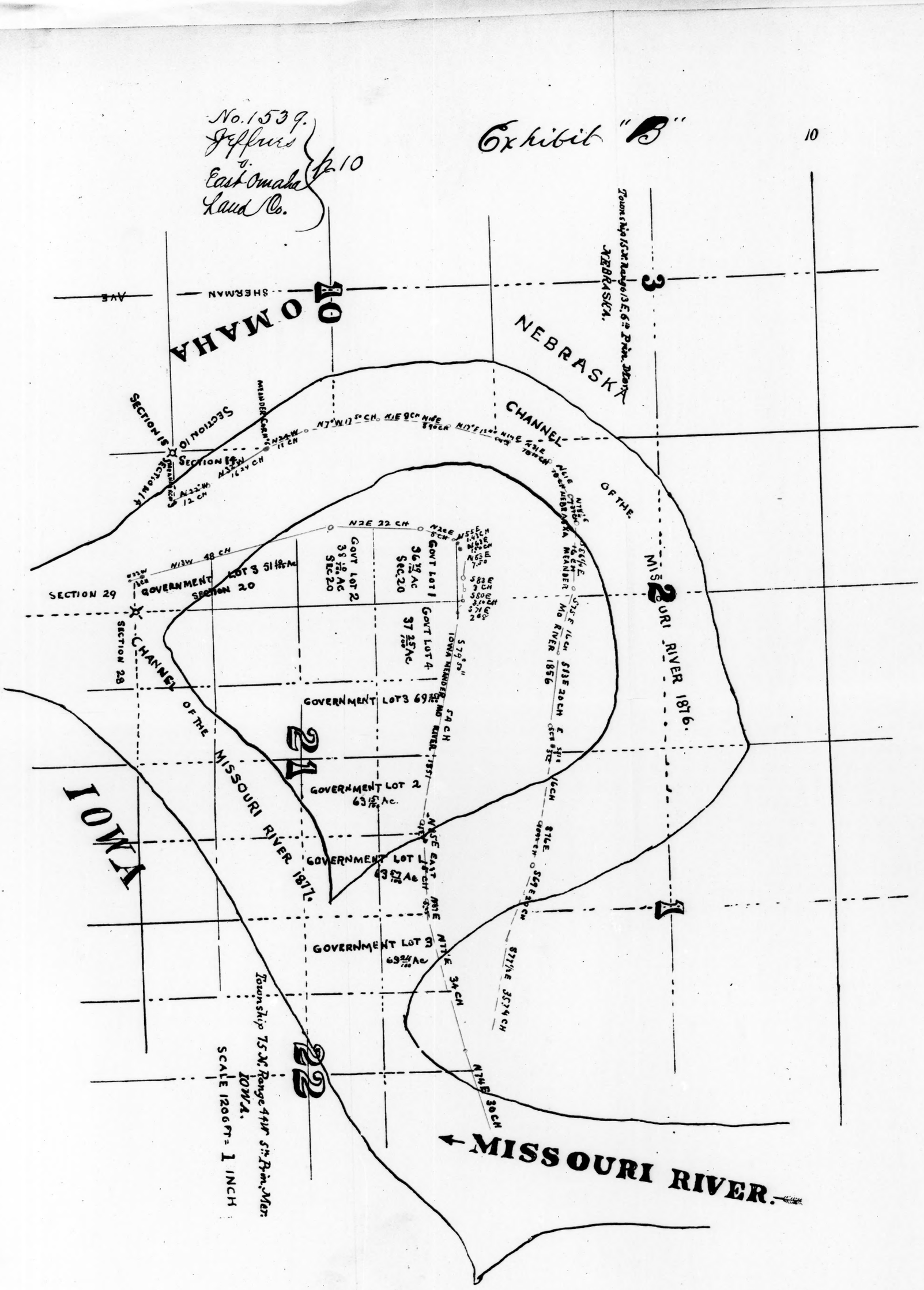
9

No. 1539.
Affidavit
of
Eight Counties
Assn. Co.

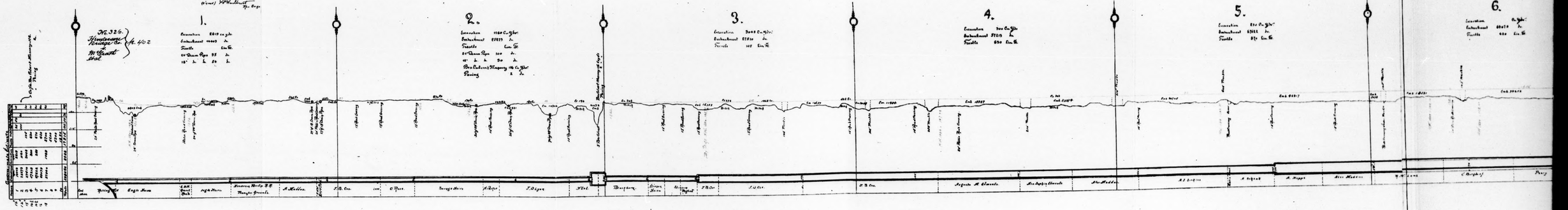
No. 1539.
Jeffries
v.
East Omaha Land Co.
} p. 10

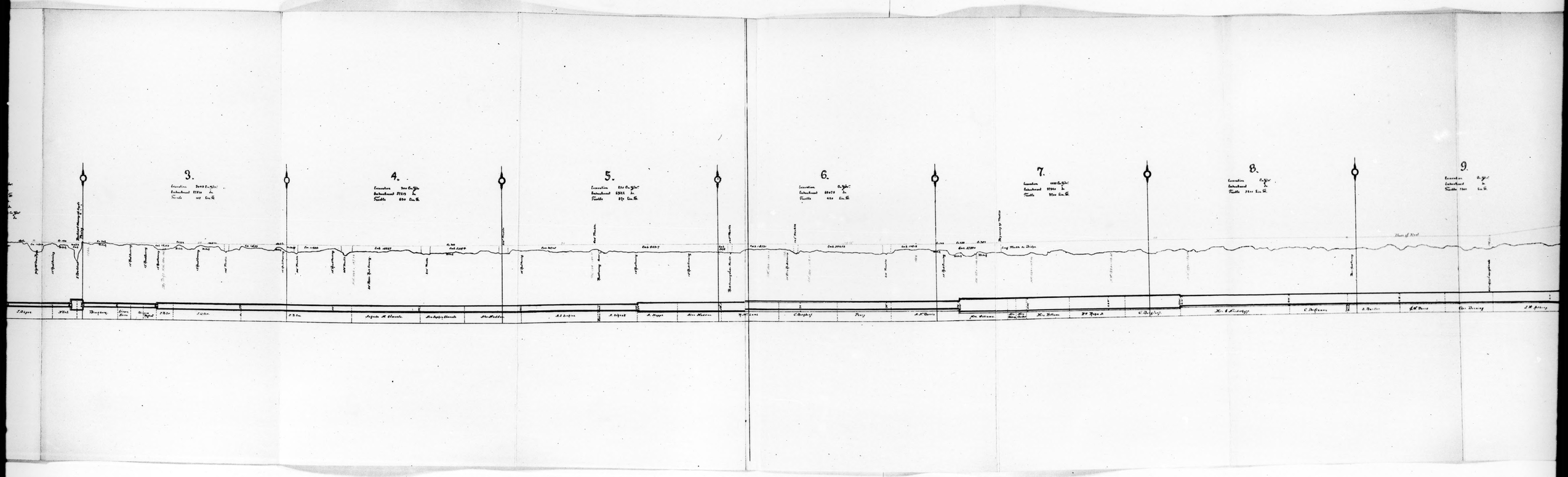
Exhibit "B"

10



Profile of The Henderson Bridge R.R.




3.
4.
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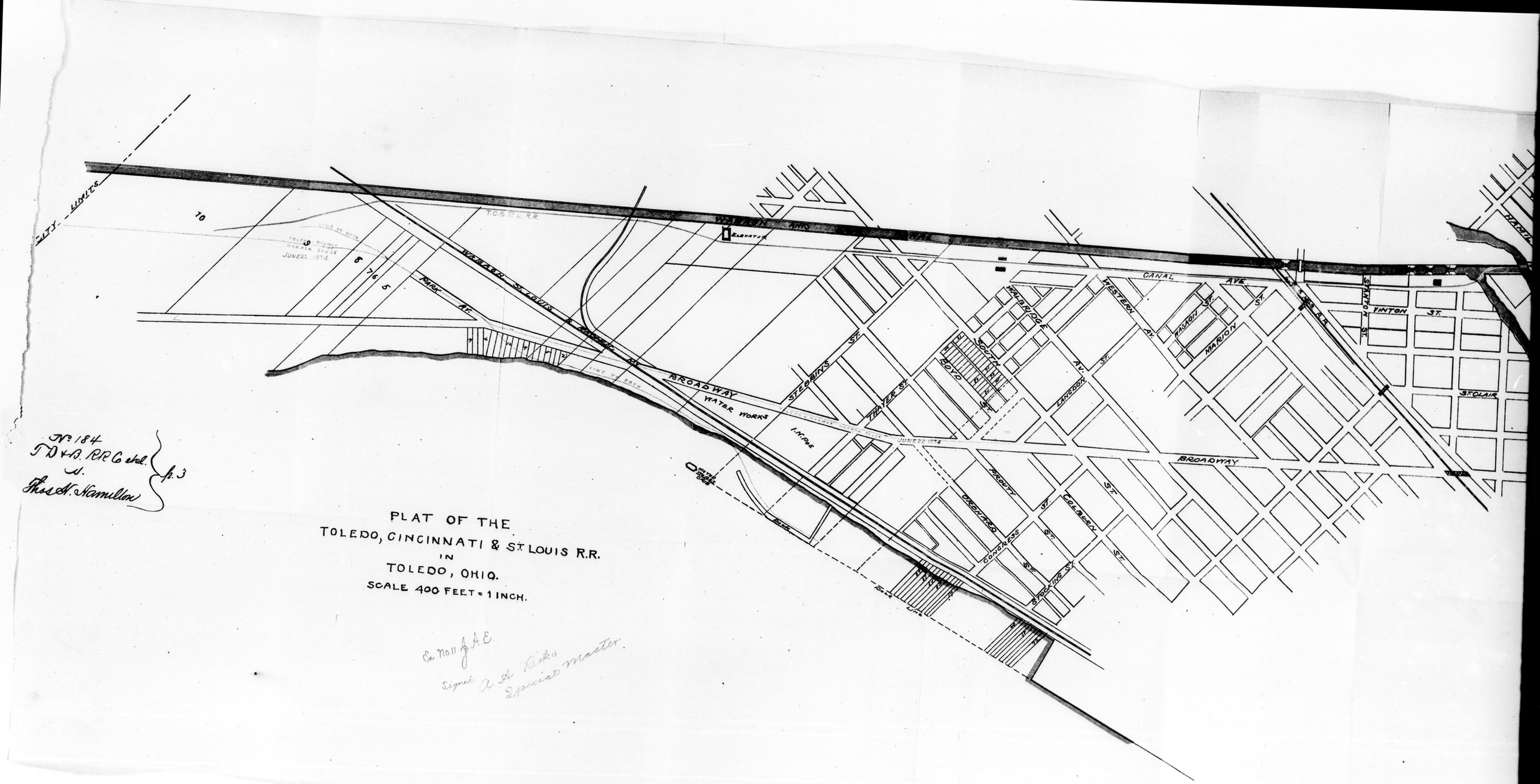
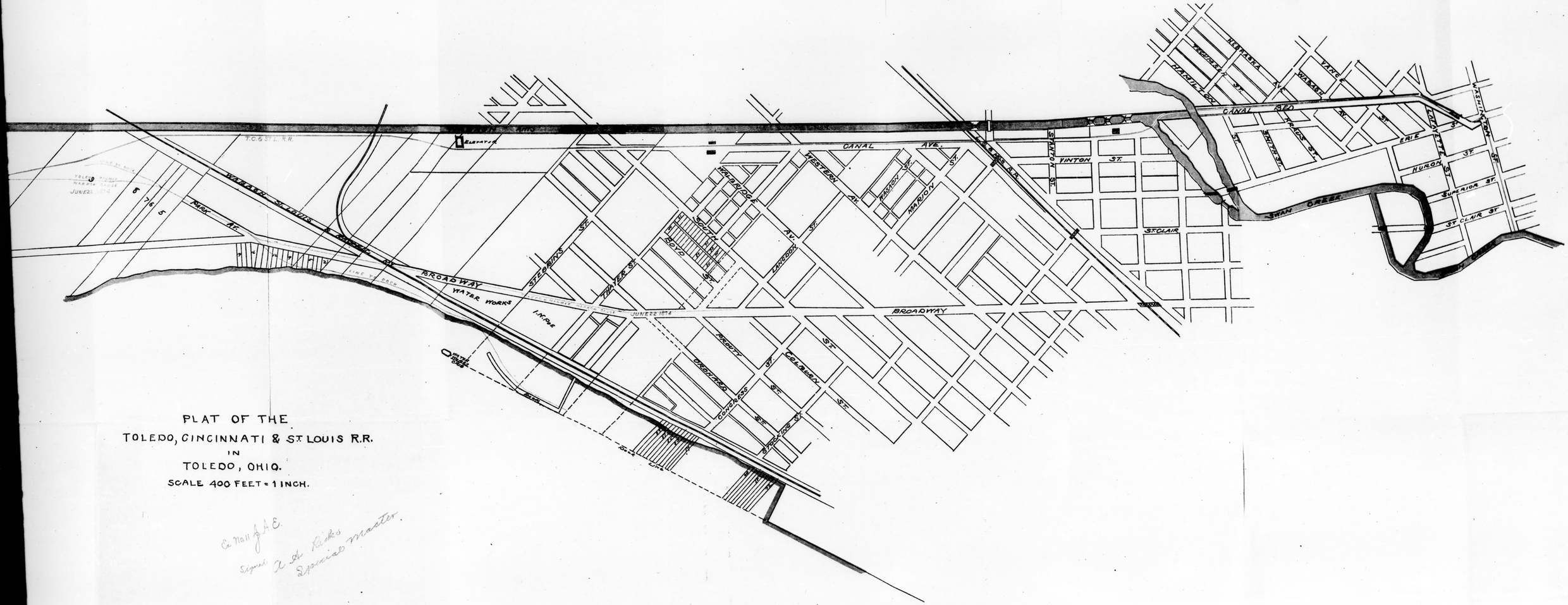
7.
8.
9.

Note by Clerk of Works —
This is a copy of this
irregular field as on Backlink with the Original
Field Book as on page 3 of Book


CITY LIMITS
70
T.C.C.St.L.R.R.
LINE OF WORK
TOLEDO HARBOR GAUGE
JUNE 22, 1874
6
7
6
5
MARK AV.
WABASH St. LOUIS & PACIFIC R.R.
ELEVATOR
WEST END
BROADWAY
WATER WORKS
I.M. PIPE
STEBBINS ST.
THAYER ST.
SOUTH
BOYD
ST.
HALDRIDGE
AV.
LANGDON
WESTERN
CANAL
AVE.
JASON ST.
MARION
ST.
NORTH
ST.
VINTON
ST.
ST. CLAIR
BROADWAY
PROUTY
DIGHTON
CONGRESS
ST.
COLLINGWOOD
ST.
STERLING ST.
ST.
ST.



PLAT OF THE
TOLEDO, CINCINNATI & St LOUIS R.R.
IN
TOLEDO, OHIO.
SCALE 400 FEET = 1 INCH.

Ex Nall Sgt E.
Signed A. A. Ricks
Special master

Exhibit "B"

MAP OF GLENCOE AND VICINITY

Published by
F. A. ROOT
METHODIST CHURCH BLOCK.
CHICAGO.

CHAS. SHOBER & CO. PROP. CHICAGO LITH. CO.

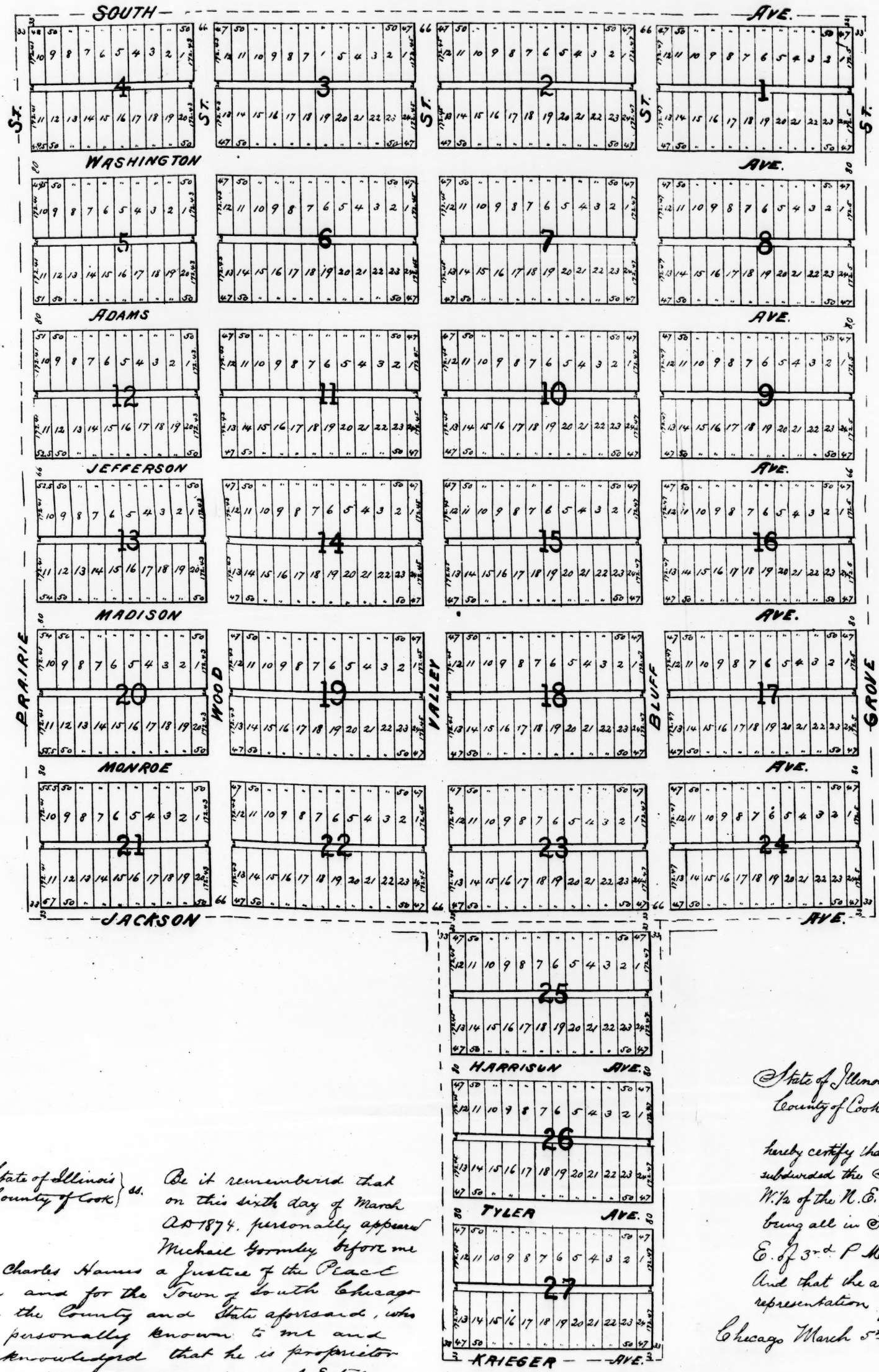
No. 192.
Gormley v. Clark. } p. 24

187

No. 192.
Gormley
vs
Clark
} In Eq.

GORMLEY'S
ADDITION TO GLENCOE

BEING A SUBDN. OF THE
S.W. ¼ OF SEC. 7 AND THE W. ½ OF N.E. ¼ OF
N.W. ¼ OF SEC. 18. BEING ALL IN
T.42.R.13.E.



State of Illinois } ss.
County of Cook }

Be it remembered that on this sixth day of March AD 1874. personally appeared Michael Gormley before me J. Charles Haines a Justice of the Peace in and for the Town of South Chicago in the County and State aforesaid, who is personally known to me and acknowledged that he is proprietor of the forigoing described real Estate designated as "Gormley's Addition to Glencoe" and that the forgoing subdivision is made of his own free will and deed

Given under my hand and seal this 6th day of March AD 1874

J. Charles Haines
J.P.

J. CHAS. HAINES
JUSTICE OF THE PEACE
COOK CO.
132 CLARK ST. CHICAGO

State of Illinois }
County of Cook } S.S.

I Alex. Wolcott do hereby certify that I have surveyed and subdivided the S.W. ¼ of Sec. 7 and the W. ½ of the N.E. ¼ of the N.W. ¼ of Sec. 18 being all in Town 42 North Range 13 E. of 3rd P.M.

And that the annexed plat is a correct representation of said subdivision.

Chicago March 5th 1874

Alex Wolcott
County Surveyor

302a

GORMLEY'S SUB. ADDITION ~~TO~~ GLENCOE

~~BEING A SUBD^N. OF THE~~ of

S.W. 1/4 OF SEC. 7 AND THE W. 1/2 OF N.E. 1/4 OF N.W. 1/4 OF SEC. 18. BEING ALL IN

T. 42 N. R. 13 E.

Showing also the correct location of dwelling House & Out Buildings of Michael Gormley

T.G. Westerfield
Surveyor
Wilmette
Nov. 26. 1894

N

SOUTH AVE.

ST.

WASHINGTON

AVE.

ADAMS

AVE

JEFFERSON

AVE.

MADISON

AVE.

PRAIRE — WOOD — VALLEY — BLUFF — GROVE

MONROE

AVE.

JACKSON AVE.

HARRISON AVE.

TYLER AVE.

KRIEGER AVE.

12 7
13 18

Middle Line Sec. 7

No. 192.
Gormley
to
Clark
} p 302 a